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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	92025859
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In the matter of Trademark Registration No. 1147309
For the mark COHIBA
Date registered: February 17, 1981

AND

In the matter of the Trademark Registration No. 1898273
For the mark COHIBA
Date registered: June 6, 1995

EMPRESA CUBANA DEL TABACO d.b.a.
CUBATABACO,

Petitioner,

Cancellation No. 92025859

v.

GENERAL CIGAR CO., INC.,

Respondent.

PETITIONER'S REPLY TRIAL BRIEF

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STATUTES and CONVENTIONS

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Petitioner Empresa Cubana del Tabaco, d.b.a. Cubatabaco (“CT”) respectfully submits this Reply Brief in further support of its petition to cancel Respondent General Cigar Co., Inc. (“GC”)’s Reg. No. 1147309 (Feb. 17, 1981) and Reg. No. 1898273 (June 6, 1995) of COHIBA for cigars.

ARGUMENT

I. Cancellation of Both Registrations Is Required Under the Pan-American Convention: There Is No Warrant for Disregarding the Federal Circuit’s Mandate That Issue Preclusion Does Not Bar Petitioner’s Convention Claims, and Respondent Does Not Otherwise Contest Cancellation Under the Convention

General Cigar does not contest CT’s showing that the requirements for cancellation under Article 8, Pan-American Convention, are met as to both registrations and that, under Board precedent, Article 8 claims can be asserted under § 17(a), 15 U.S.C. § 1067(a). Petitioner’s Brief (“P. Br.”) 11-18, 365 TTABVUE 13-20. Rather, GC argues only that issue preclusion bars this ground for cancellation, notwithstanding that the Federal Circuit expressly held issue preclusion does *not* bar those claims and that its mandate is “for further proceedings consistent with this opinion.” *Empresa Cubana del Tabaco v. General Cigar*, 753 F.3d 1270, 1277-78; 111 USPQ2d 1058, 1064 (Fed. Cir. 2014). It urges the Board to take the extraordinary step of disregarding the Circuit’s mandate exclusively on the ground that *B&B Hardware v. Hargis*, 575 U.S. 138; 113 USPQ2d 2045 (2015) (“*B&B*”) changed the governing law, notwithstanding that it did not concern § 17, the Convention or treaty claims at all and endorsed the authority the Federal Circuit relied upon in its issue preclusion analysis.

The Federal Circuit held that the issue decided in the Federal Action—whether § 44(h) of the Act incorporated Article 8 claims—is *not* the same as the issue before the Board. It ruled that “[i]ssue preclusion does not apply” because CT “asserts” that “the Board can cancel registrations directly under Article 8 of the IAC [Pan-American Convention], pursuant to the Board’s jurisdiction under 15 U.S.C. § 1067(a) [§ 17(a)],” and therefore:

Unlike in the district court, the Board need not consider the interplay with Section 44(h). And in any event, the Second Circuit certainly did not address whether Cubatabaco could request that the Board cancel the registrations directly under those same IAC provisions [pursuant to the Board’s § 17(a) jurisdiction]. Accordingly, issue preclusion does not bar Grounds 5 and 7 for cancellation of the Registrations.

Empresa, 753 F.3d at 1277-78; 111 USPQ2d at 1064.

In so holding, the Circuit rejected GC's argument on appeal that "[t]here is no relevant legal distinction between a federal action that seeks [cancellation] and a Board proceeding that seeks the same relief," such that the Federal Action's dismissal of the Article 8 claim precludes it here. Brief for General Cigar, 2013 WL 6632194, *39, *55, No. 13-1465 (Fed. Cir.) (ECF 22). Instead, the Circuit held, whatever limitations may apply to CT's Article 8 claim in district court under § 44(h); 15 U.S.C. § 1126(h), § 17(a)'s jurisdictional grant to the Board is distinct and does not contain any such limitations.

As the Federal Circuit's holding that there is no issue preclusion is "within the scope of . . . the mandate," it is "precluded from further adjudication." *Engel Indus., Inc. v. Lockformer Co.*, 166 F.3d 1379, 1383; 49 USPQ2d 1618, 1621 (Fed. Cir. 1999). Controlling authority forecloses GC's nonsensical position that adherence to the mandate is merely "discretionary," GC's Brief ("R. Br.") 24; 367 TTABVUE 26. *Jewelers Vigilance Comm., Inc. v. Ullenberg Corp.*, 853 F.2d 888, 892; 7 USPQ2d 1628, 1630 (Fed. Cir. 1988) (Board "has no option but to comply with th[is court's] mandate"). A lower tribunal "has no power or authority to deviate from the mandate." *Id.* at 892 n.3.¹

GC places exclusive reliance on *B&B* in invoking the exception to the mandate rule for when "controlling authority has since made a contrary and applicable decision of law," *Banks v. United States*, 741 F.3d 1268 (Fed. Cir. 2014).² Under this exception, "[t]hree conditions must be satisfied." *Dow Chem. Co. v. Nova Chem. Corp.*, 803 F.3d 620, 629 (Fed. Cir. 2015): "First, the governing law must have been altered. . . . Second, the decision sought to be reopened must have applied the old law. . . . Third, the change in law must compel a different result[.]" *Id.* These requirements are strictly construed. *Sacramento Mun.*, 566 F. App'x at 996. Far from meeting all three, GC satisfies none.

¹ GC erroneously relies on a decision involving an appellate court's reconsideration of *its own* prior decision, R. Br. 24 (*citing Mendenhall v. Barber-Greene*, 26 F.3d 1573, 31 USPQ2d 1001 (Fed. Cir. 1994) and confuses "law of the case," R. Br. 24, with the mandate rule, which permits none of the flexibility that "law of the case" affords an appellate court revisiting its own prior decision. *Sacramento Mun. Util. Dist. v. United States*, 566 F. App'x 985, 995 (Fed. Cir. 2014) ("[A]n issue . . . decided by an appellate court . . . may not be reconsidered at any subsequent stage . . ., *save on appeal*") (emphasis added).

² GC does not, and cannot, argue that any other exception applies.

GC cannot show *B&B* changed “governing law.” The Circuit applied the rule GC says *B&B* established, R. Br. 19, namely, that district court rulings have preclusive effect before the Board if ordinary issue preclusion standards are met. *Empresa*, 753 F.3d at 1276; 111 USPQ2d at 1063. Indeed, the rule *B&B* purportedly established has been settled in the Federal Circuit for over 50 years.³ Further, *B&B*, contrary to GC’s odd reading, addressed an entirely different issue: “whether the District Court in this case should have applied issue preclusion to the TTAB’s decision.” 575 U.S. at 141; 113 USPQ2d at 2048, not *vice versa*.⁴

Nor did *B&B* change the standards for issue preclusion, as made clear by GC itself describing the Supreme Court’s holding as “rooted . . . in the Restatement (Second) of Judgments,” R. Br. 20 (citing Restatement § 27). The Federal Circuit, as well as the Board, has long relied on and applied Restatement § 27’s standards;⁵ indeed, the Circuit here relied on § 27’s four factors and cited its own precedents expressly applying § 27. *Empresa*, 753 F.3d at 1276; 111 USPQ2d at 1063 (citing *Jet*, 223 F.3d at 1366.) Because *B&B* reaffirmed that the “ordinary elements” of issue preclusion, reflected in the Restatement, apply, 575 U.S. at 153; 113 USPQ2d at 2048, 2053, and because the Circuit here applied the same ordinary elements (derived from the same source), the law governing issue preclusion did not change.⁶

GC also fails to show that *B&B* changed “governing law” regarding whether § 17(a) permits the Board to consider Article 8 claims that the Federal Action held were not incorporated by § 44(h). GC’s argument that *B&B* somehow invalidated the “grounds on which the Federal Circuit’s . . . preclusion

³ See, e.g., *Jet, Inc. v. Sewage Aeration Sys.*, 223 F.3d 1360, 1365-66 (Fed. Cir. 2000); *Midland Co-ops., Inc. v. Midland Int’l Corp.*, 421 F.2d 754, 164 USPQ 579 (CCPA 1970); 6 J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 32:94 (5th Ed. 2017).

⁴ To the extent the Court addressed the situation presented here, it was only to favorably cite the Board’s *existing practice* of giving preclusive effect to district court decisions. *Id.* at 152-53; 2053.

⁵ See, e.g., *Jet*, 223 F.3d at 1366; 55 USPQ2d at 1859; *Gal v. Israel*, 230 USPQ 669, 672 (TTAB 1986).

⁶ GC apparently suggests that *B&B* established a new “test of identity between issues,” under which the court must take a “broad view of what an ‘issue’ is.” R. Br. 21. But *B&B* referred to the “ordinary elements” of issue preclusion no fewer than nine times, see, e.g., *B&B*, 575 U.S. at 160; 113 USPQ2d at 2056 (remanding to apply “ordinary elements of issue preclusion”), and the Board has held that *B&B* embraced, rather than changed, these “ordinary elements.” *In re FCA US LLC*, 126 USPQ2d 1214, 1218 (TTAB 2018) (“*B&B*. . . specifically conditions its holding on ‘the ordinary elements of issue preclusion’ being met.”) *B&B*’s reliance on the ordinary elements—as reflected in § 27 and as applied by the Federal Circuit here—forecloses GC’s argument that *B&B sub silentio* created a new identity of issues test.

analysis rested” by “eliminat[ing] the distinction between Board registration proceedings and court infringement proceedings.” R. Br. 24-25, lacks even facial plausibility: *B&B* did not concern or address the scope of the Board’s jurisdiction under § 17(a), Article 8 or any other treaty-based claims, or § 44.

Rather, *B&B* resolved an issue wholly irrelevant here: whether a Lanham Act section applicable to the Board and another applicable to district courts set the same standard for likelihood of confusion, allowing the Board’s finding likelihood of confusion to have preclusive effect on likelihood of confusion in the district court. Because it found the “operative language” “essentially the same,” the Court held the two sections set the same standard, and preclusion possible. *B&B*, 575 U.S. at 156; 113 USPQ2d at 2055.⁷

GC cannot convert this holding into a sweeping, *sub silentio* rule that “eliminated the distinction,” and established complete parity of authority, between the Board and district courts, R. Br. 25. *B&B* says nothing resembling this, and no issue even remotely that broad was before the Court. GC presented this precise argument to the Federal Circuit, 2013 WL 6632194, *39, No. 13-1465 (Fed. Cir.) (ECF 22), which rejected it; *B&B* provides no warrant for the Board disregarding the Federal Circuit’s decision.

Let alone not changing the law relevant here, the Court’s holding in *B&B* is irrelevant to the Federal Circuit’s holding. The Federal Action held that CT “cannot assert claims under Articles 7 and 8 pursuant to Section 44(h) . . . because Articles 7 and 8 do not relate to the repression of unfair competition” and thus did not fit within § 44(h)’s text (that a treaty national “shall be entitled to effective protection against unfair competition, and the remedies provided in this chapter for infringement of marks shall be available so far as they may be appropriate in repressing acts of unfair competition.”). *Empresa Cubana del Tabaco v. Culbro Corp.*, 399 F.3d 462, 483; 73 USPQ2d 1936, 1952 (2d Cir. 2005). By contrast, § 17(a) does not even reference “unfair competition” and empowers the Board to “determine and decide the respective rights of registration” without any such limitation. Thus, the Federal Circuit held, “[u]nlike in the district court,

⁷ Compare 15 U.S.C. § 1052(d) (registration may be refused if mark “so resembles” registered mark “as to be likely, when used on or in connection with the goods of the applicant, to cause confusion”) with 15 U.S.C. § 1114(a)(1) (liability for infringement if party “use[s] in commerce . . . a registered mark in connection with . . . goods or services” where “such use is likely to cause confusion”).

the Board need not consider the interplay with Section 44(h).” *Empresa*, 753 F.3d at 1278; 111 USPQ2d at 1064. Unlike in *B&B*, the “operative language” is not “essentially the same” but entirely different.

GC also cannot meet the second requirement, that the Federal Circuit “must have applied the old law.” As shown, the Federal Circuit applied Restatement § 27’s preclusion standards, which *B&B* turned to for the “ordinary elements” of preclusion. Thus, even if the law changed, *Empresa* applied the new law.

Nor can GC satisfy the third requirement, that any change in law “must compel a different result.” *B&B* did not address § 17(a) or § 44(h), the Board’s authority to apply Article 8 or other treaty-based claims, or the comparative authority of the Board and the district courts to do so. Thus, even if, as GC suggests, *B&B* newly established a broad interpretation of what constitutes an “issue” for preclusion purposes, this would not “compel” a different result. The absence of language common to § 17(a) and § 44(h) in and of itself forecloses any such notion.

Nothing further need be shown, but it may also be noted that, despite the Federal Circuit citing *B&B* more than 25 times and the Board citing it more than 50, no decision has held or suggested that *B&B* changed the identity of issues test, and both continue to rely on pre-*B&B* precedent in adjudicating the identity of issues prong. *See, e.g., In re FCA US LLC*, 126 USPQ2d at 1218; *Papst Licensing GMBH & Co. KG v. Samsung Elecs. Am., Inc.*, 924 F.3d 1243, 1250 (Fed. Cir. 2019). Moreover, notwithstanding GC’s claim that *B&B sub silentio* established parity of authority in respects relevant here, the Board has seen no conflict with the Second Circuit in continuing to apply Article 8 under § 17(a). *Lacteos de Honduras, S.A. v. Industrias Sula, S. de RL De CV*, No. 91243095, 2020 WL 973178, *4 (TTAB Feb. 28, 2020).

II. Cancellation of Registration No. 1147309 Is Required for Additional Reasons

A. Fraud in Respondent’s Section 15 Declaration

GC does not dispute that 21 months of its declared 5 years’ “continuous use in interstate commerce” was COHIBA’s inclusion in the “trademark maintenance program” described by CT. P. Br. 14-16, 18. Instead, relying on dictum in *Procter & Gamble Co. v. Johnson & Johnson Co.*, 485 F. Supp. 1185, 1207; 205 USPQ 697, 702 (S.D.N.Y. 1979), *aff’d*, 636 F.2d 1203 (2d Cir. 1980) as to what might justify otherwise inadequate use, GC defends its section 15 Declaration on the ground that “[b]etween February 17, 1981

and November 1982,” “GC had ‘reasonably well-formulated plans to use [COHIBA] on a [cigar] under development.’” R. Br. 29. However, *none* of the record cited by GC supports this assertion, and the testimony of its then VP for Marketing cited by CT, P. Br. 15-16, *conclusively establishes the contrary*.⁸ Its President’s testimony that “my intent from the beginning” (that is, from 1978) “was to market COHIBA the same way we marketed our other Cuban-origin brands,” 341 TTABVUE 2, 4, 10, 12 (cited at R. Br. 12, 28) (Cullman, Jr.) is only an expression of the “vague, remote and almost abstract intentions” for a mark that cannot justify otherwise inadequate use. *Procter*, 485 F. Supp. at 1207; 205 USPQ at 716.

As the very authority relied upon by GC shows, inclusion of COHIBA in its trademark maintenance program was inadequate. There is no difference from what the court there held insufficient: annual shipments of 50 units each to 10 states, for nominal sums; no references in catalogs, price lists or other published materials; labels affixed to plain packaging; the item an already existing product. *Procter*, 485 F. Supp. at 1205-06; P. Br. 14-16, 18-19. Further, the Board had made clear that, glaringly unlike here, the purported use must be “with the purpose of establishing goodwill, recognition and association,” *Times Mirror Mags., Inc. v. Sutcliffe*, 205 USPQ 656, 662 (TTAB 1979).

GC tries but cannot escape its outside trademark counsel having informed it (correctly), when GC was confronted with the prospect of defending its registration against a third-party’s application for COHIBA, that its use of the mark could not withstand scrutiny. P. Br. 15. The very same individual who prepared the section 15 Declaration, Charles Sparkes, GC’s internal trademark manager, 346 TTABVUE 172, 410, authored the Feb. 1982 memo to GC’s President and house counsel conveying outside counsel’s communication. 194 TTABVUE 321-323. Later, when no longer faced with the prospect of scrutiny, Sparkes prepared and GC management signed and filed the section 15 Declaration nonetheless.⁹

⁸ Kowalsky testified that it was in 1982 that GC’s sales force identified a “void” in GC products “at the lower priced premium cigars,” “particularly bundled cigars,” that its marketing department was *then* “asked to evaluate how to fill” that void; that GC *then* “developed the product” (“very similar in blend and size to” an existing product); and *then*, after reviewing “the names that we owned,” chose COHIBA in May 1982. 343 TTABVUE 896, 905-08, 921-25. The story on the packaging, 191 TTABVUE 69-70, was developed in 1982. 338 TTABVUE 918 (Cullman, Jr.); 342 TTABVUE 412-13 (Burgh).

⁹ GC relies upon Sparkes’ protestation of good faith, R. Br. 30, but, unsupported by any documents, self-

Finally, GC concedes that CT sought to register COHIBA but decided not to proceed in 1987 after its U.S. counsel learned of GC's section 15 Declaration. R. Br. 13, n.7; 190 TTABVUE 54-56. The Declaration thus worked the harm to third-parties that section 15 was meant to prevent.

CT has met its burden under *In re Bose Corp.*, 580 F.3d 1240; 91 USPQ2d 1938 (Fed. Cir. 2009).

B. Abandonment

GC concedes there was no use in commerce for over 5 years, from 1987-late Nov. 1992, R. Br. 30, shifting to it the evidentiary burden of persuasion of an intent to resume use. P. Br. 19-20. It cannot meet its burden, as the record is devoid of any actual "evidence showing a specific and consistent plan to resume use," *Azeka Bldg. Corp. v. Azeka*, 122 USPQ2d 1477, 1488 (TTAB 2017), in the "reasonably foreseeable future," *Exec. Coach Builders, Inc. v. SPV Coach Co.*, 123 USPQ2d 1175, 1199 (TTAB 2017) and "actions" "that a reasonable businessman would take pursuant to" that plan. *Rivard v. Linville*, 133 F.3d 1446, 1449; 45 USPQ2d 1374, 1377 (Fed. Cir. 1998); P. Br. 20; R. Br. 31-32 (admitting requirements).

Faced with this impossible evidentiary problem, GC: 1) improperly relies on wholly unsupported conclusory testimony, which is belied by the actual record; 2) falsely asserts that CT's argument is "primarily reliant" on the District Court decision; and 3) egregiously mischaracterizes the evidence of its own 5-plus years of inaction.

1. GC ignores the Federal Circuit's explicit warning: "In every contested abandonment case, the respondent denies an intention to abandon its mark; otherwise there would be no contest.... [O]ne must, however, proffer more than conclusory testimony or affidavits." *Imperial Tobacco, Ltd. v. Philip Morris, Inc.*, 899 F.2d 1575, 1581; 14 USPQ2d 1390, 1394 (Fed. Cir. 1990). GC relies heavily on a snippet of the extraordinarily vague, conclusory testimony of its President (Cullman, Jr.), devoid of any specifics (other than the idea of copying the Cuban trade dress, rejected for legal reasons, P. Br. 21-22) and unmoored as to time, to invent a false claim of "numerous" internal meetings or conversations on "repositioning" Cohiba

serving and based upon his not "recall[ing]" advice from outside counsel despite the Feb. 1982 memo, 346 TTABVUE 410-12, it cannot stand against the documented advice of counsel to him, GC's President and house counsel.

cigars during the period of abandonment. R. Br. 33. Even he claims only “a number” of, not “numerous” meetings, and, prior to 1992, concerning only the rejected trade dress copying, 341 TTABVUE 12-13. GC cannot cite a single witness or document from 1987-Aug. 1992 to support this conclusory “repositioning” assertion (again, other than the trade dress copying), in contrast to the extensive documentation of pre-1987 and Fall 1992 communications and meetings. (None of the record citations at R. Br. 13 come close.)

Shockingly, GC not only relies on Cullman’s conclusory, non-specific testimony in the teeth of GC’s marketing chief explicitly recanting his prior testimony that discussions about repositioning Cohiba occurred prior to Fall 1992, P. Br. 24 n.23, but even cites to that explicitly recanted testimony. R. Br. 13 (citing 345 TTABVUE 353-57); *see* P. Br. 25 (prior marketing head’s testimony of “general discussions;” “Cohiba was a topic. Not a specific about whether we would finally end up with it, but it was a topic of conversation.”). However, “discussions concerning the potential use of the mark at some unknown point in the future are insufficient to show an intent to resume use.” *Yazhong Investing Ltd. v. Multi-Media Tech. Ventures, Ltd.*, 126 USPQ2d 1526, 1539 (TTAB 2018). This proceeding is the poster child for the Federal Circuit’s warning against use of conclusory testimony to avoid abandonment.

Tellingly, GC relies extensively on its rejected idea to imitate the Cuban Cohiba trade dress, R. Br. 13, 33-34, but it has no response to CT’s showing that such an idea, rejected for legal reasons, cannot support a claim of intent to resume use, P. Br. 22 (citing to the near-identical situation in *Imperial Tobacco*, 899 F.2d at 1582-83, 14 USPQ2d at 1395-96). GC also does not challenge CT’s showing that GC’s only other minimal activities during the 5-year abandonment period cannot support an intent to resume use in the reasonably foreseeable future: [REDACTED]

2. Contrary to GC’s extended argument that CT’s abandonment arguments and statements of fact are “primarily reliant” on the District Court decision, R. Br. 30-31, CT relied almost exclusively on Federal Circuit and Board case law,¹⁰ and cited the District Court only for undisputed, unchallenged facts

¹⁰ In the three times CT cited the District Court on the law, it noted the court specifically cited or followed the Federal Circuit, and solely for the undisputed propositions that the legal standard is not intent not to abandon and that a party cannot defeat abandonment with conclusory testimony. P. Br. 20 & n.20, 25.

established by the evidence.¹¹ GC's false assertion cannot divert the Board from looking at the actual evidence and controlling case law, which overwhelmingly establishes GC's abandonment.

3. Unable to overcome the presumption of abandonment by its minimal activities or conclusory, disproven testimony, GC pivots to claim market conditions prevented it from selling a COHIBA-branded cigar for over 5 years. GC's claim, however, is based on a serious misunderstanding of the cases it cites and is directly contradicted by the evidence. Dispositively, GC makes no claim and provides no explanation why it was able [REDACTED] premium cigars under other marks, including [REDACTED] Macanudo and Partagas cigars, from 1987-Nov. 1992, yet somehow it was unable to sell *any* COHIBA-branded cigars, or even that it was unable to do so profitably. [REDACTED]

No case comes close to suggesting that a mark is not abandoned when a company withdraws a particular mark from the market for many years, while it continues [REDACTED] of the same goods under different marks. That is not what the "business reason" cases permit, because such a standard would allow the indefinite warehousing of specific marks while the owner continued to traffic in the same goods. Rather, the cases GC cites establish that the issue is the inability or impracticality of selling *the type of goods*, not a specific mark while selling the same goods under other marks.

In *Miller Brewing Co. v. Oland's Breweries (1971) Ltd.*, the opposer, unlike here, faced insurmountable production and legal problems in exporting beer from Canada to the U.S. 548 F.2d 349, 352; 192 USPQ 266, 268 (CCPA 1976). Unlike here, opposer did *not* continue to sell other beer products in the U.S. under other marks while withdrawing one particular beer mark because the appurtenant product performed poorly. In addition, the CCPA analyzed the facts under an "actual intent to abandon" standard, which is no longer the law. *Id.*¹² Finally, the CCPA relied on ongoing advertising that kept the mark before

¹¹ CT cited the District Court only for the undisputed facts that GC had no use of COHIBA from 1987-Fall 1992; GC engaged in only three activities concerning COHIBA during that time; and the timing of GC's activities concerning the launch of its "Temple Hall" Cohiba cigar in Fall 1992. P. Br. 20, 21, 25.

¹² Inexplicably, GC repeatedly relies on a claim of "no GC intent to abandon the COHIBA mark," even though not legally relevant today. R. Br. 34; *id.* 14 n.8. In any event, Cullman's testimony explicitly

consumers, as well as specific, continuing efforts to overcome the production and legal obstacles to resuming sales. In sharp contrast, GC explicitly sought to have consumers “forget” its Cohiba cigar, 342 TTABVUE 1136; it is uncontested that the product had no remaining goodwill in Fall 1992; and GC did absolutely nothing to bring a Cohiba cigar to market until after Fall 1992. P. Br. 23-25.

In *Star-Kist Foods, Inc. v. P.J. Rhodes & Co.*, the court found no abandonment where “Star-Kist's predecessors ceased using the trademarks ... during the period in question due to the unprofitability of importing fish into the [U.S.]” 769 F.2d 1393, 1396; 227 USPQ 44, 46 (9th Cir. 1985). This is far different from discontinuing one particular tuna mark because it fared poorly in a generally weak market, while continuing to import large quantities of fish under different marks. GC, with the burden to overcome the abandonment presumption, has failed to produce a shred of evidence that its importation and sale [REDACTED] [REDACTED] cigars under many different marks during the abandonment period was unprofitable, or that something specific to Cohiba made importation under that mark idiosyncratically impossible or impractical.

GC’s reliance on *Silverman v. CBS Inc.*, 870 F.2d 40; 9 USPQ2d 1778 (2d Cir. 1989), is also misplaced, perhaps explained by GC’s erroneous statement that the Second Circuit found “no abandonment,” when it did. P. Br. 23. Unlike here, CBS had compelling societal and business reasons to stop using the racist AMOS ‘N ANDY mark, and it engaged in far more extensive efforts to explore resumption of the mark than GC. Nevertheless, the Second Circuit held the mark abandoned, *id.* at 46, and rejected the same argument that GC makes here, that it is sufficient to have some inchoate, vague intent to resume use when conditions change, rather than specific plans in the “reasonably foreseeable future,” *id.*, consistent with *Azeka Bldg.*, 122 USPQ2d at 1488, and *Executive Coach*, 123 USPQ2d at 1199.

Crash Dummy Movie, LLC v. Mattel, Inc., 601 F.3d 1387; 94 USPQ2d 1315 (Fed. Cir. 2010), undermines GC’s position, sharply contrasting with GC’s inactivity here. First, neither post-abandonment use or intent to resume use itself rebuts the abandonment presumption. *Cerveceria Centroamericana, S.A.*

acknowledges that “we were *never* passive in these areas. We either continued to sell or we made a decision to abandon.” 342 TTABVUE 1137; P. Br. 19 n.19 (emphasis added). Here, for over 5 years, GC admittedly “discontinued sales of the COHIBA cigar,” R. Br. 13. Thus, GC “made a decision to abandon.”

v. Cervceria India, Inc., 892 F.2d 1021, 1027, 13 USPQ2d 1307, 1309 (Fed. Cir. 1989); P. Br. 20 & n.21. Second, as *Crash Dummy* makes clear, resumed use after the non-use period is relevant only when the new use specifically links to activities during the non-use period that led to the new use, there Mattel’s 2000-2003 research and development, which were “needed” for a new line of CRASH DUMMIES toys; and Mattel’s shipment of such toys in Dec. 2003, which linked to the R&D evidence. *Crash Dummy*, 601 F.3d at 1391-92, 94 USPQ2d at 1317-18; *Peterson v. Awshucks SC, LLC*, Canc. No. 92066957, 2020 WL 7888976, *12 (TTAB 2020) (later use “should temporally and logically link the later use to the prior use ... mere evidence of subsequent use may not suffice to establish that the registrant intended to resume use”).

The facts here are clear: GC’s Cohiba did poorly; GC deliberately ceased sales, while continuing to import and sell [REDACTED] cigars under other marks, as it could have done with Cohiba; unlike Mattel, GC did nothing for over 5 years, other than abandoning the idea of copying the Cuban trade dress for legal reasons; then, and only after *Cigar Aficionado* extolled the Cuban Cohiba as the world’s best cigar, GC “simply began selling [reabeled TEMPLE HALL] cigar[is in [Nov. 1992], as it could have all along.” *Imperial Tobacco*, 899 F.2d at 1582, 14 USPQ2d at 1395. GC falls far short of overcoming the abandonment presumption, and the preponderance of the evidence easily establishes abandonment.

III. Cancellation of Reg. 1898273 Is Required for Additional Reasons

A. Petitioner’s Prior Analogous Use

1. CT’s has shown that [REDACTED]

[REDACTED] P. Br. 27. Not disputing this, GC asserts simply as an *ipse dixit*—without critiquing CT’s evidence or pointing to contrary evidence—that CT’s promotion was not “substantial” enough to create the “level of recognition” required for analogous use. R. Br. 39.

The evidence on recognition ignored by GC is more than enough. As far from a mere “mention . . . in a single magazine,” R. Br. 39, as can be imagined, *Cigar Aficionado*’s premier issue focused upon and lavished extraordinary praise on the Cuban Cohiba throughout the issue as Cuba’s “Finest Cigar,” “perhaps

the world's finest smoke," what "Cigar Lovers Everywhere Dream" about, including in its six-page lead article, separate feature ranking cigars, two other articles, and two full-page advertisements, P. Br. 28-29; 340 TTABVUE 318-24—"more powerful and favorable publicity" than "any product in any category" that CT's preeminent branding expert could recall from his 35-year experience. 340 TTABVUE 306-13, 315 (Siegel). CT showed, without contradiction, that the premier issue had spectacular reach. P. Br. 27-28.¹³ Although nothing more need be shown: GC's own expert acknowledged the premier issue's great impact in promoting the Cuban Cohiba, as did Dunhill, GC's exclusive retailer, P. Br. 28-29, and, in and of itself sufficient, GC itself immediately recognized and decided to "capitalize" on the "good ratings," "notoriety," and "cachet" of the Cuban Cohiba resulting from the premier issue. P. Br. 29-30.¹⁴ Further, GC's Cohiba, off the market for more than 5 years after limited sales, had retained no good will. *See supra*, at 13.

CT's evidence, unacknowledged and unrebutted, easily establishes the required "public identification" of the mark with the Cuban Cohiba prior to GC's claimed first use date. *T.A.B. Sys. v. Pactel Teletrac*, 77 F.3d 1372, 1375; 37 USPQ2d 1879, 1881 (Fed. Cir. 1996).¹⁵

¹³ A U.S. publication, the premier issue's U.S. circulation equaled *twenty-five percent* of U.S. premium cigar smokers (far more with pass-along readership). P. Br. 27-28. *Newsweek* and *N.Y. Times* covered its launch, as did other publications, singling out its praise of Cohiba. 182 TTABVUE 86-87, 98-99.

¹⁴ Prior to *Cigar Aficionado*'s premier issue, the Cuban Cohiba had already been referenced in 46 articles in *N.Y. Times*, *Forbes*, *Newsweek*, and other publications during 1986–1992 (and 11 articles before then), 9 times with the accolades "famous" and "legendary," and was featured in the principal (perhaps only) U.S. cigar book as the "pride of Havana cigars." P. Br. 29. Particularly as the press repeatedly associated the cigar with the powerful and famous (Fidel Castro and numerous U.S. celebrities) and the high interest in Cuban cigars, the press coverage had substantial impact. 340 TTABVUE 306, 315-18, 350-52 (Siegel); 338 TTABVUE 661-62, 669 (Siegel). CT had supported U.S. press coverage throughout this period, 339 TTABVUE 199, 249, 266-67 (Lopez Garcia); 339 TTABVUE 148 (Gonzales Silveria), and collaborated on the Feb. 1992 story on Cohiba featured in the Feb. 1992 *Wine Spectator*. 185 TTABVUE 3, 16.

¹⁵ [REDACTED] P. Br. 27 n.25; *see also* *Cake Divas v. Charmaine Jones*, Opp. No. 91177301, 2011 WL 810224, at *5-6 (Feb. 23, 2011) (non-precedent) (giving interview, distribution of promotional goods to media, coordinating with media to secure coverage). GC does not contest this settled principle. [REDACTED]

[REDACTED] any contrary argument would be frivolous and, indeed, GC concedes the *Cigar Aficionado* premier issue is analogous use. R. Br. 39.

GC absurdly analogizes CT's to the meager showing of public recognition in *T.A.B. Sys.*, 77 F.3d at 1376; 37 USPQ2d at 1882 and *Old Swiss House, Inc. v. Anheuser-Busch, Inc.*, 569 F.2d 1130, 1133, 196 USPQ 808, 810 (CCPA 1978). R. Br. 39. In each, the court emphasized that there was *no* evidence about the reach or impact of the few press mentions relied upon, which could not be further from the undisputed facts here.

GC's argument that "[n]o amount of" analogous use gives CT priority because CT has not sold its cigar in the U.S. nakedly attempts to graft a "use in commerce" requirement into § 2(d), R. Br. 38 (referring to "§ 2(d)'s requirement of prior use in commerce") where there is none and ignores the precedent, which is "clear that . . . prior use of a term . . . not affixed to the goods will establish priority[.]" MCCARTHY § 16:14.¹⁶ Applying this rule, the Federal Circuit has held, contrary to GC's suggestion, that a *foreign* party may show priority based upon "only *use* of its mark in the" U.S., despite a U.S. applicant's use *in commerce*. *First Niagara Ins. v. First Niagara Fin. Grp.*, 476 F.3d 867, 871; 81 USPQ2d 1375, 1378 (Fed. Cir. 2007) (emphasis in original) ("mere use" suffices for "all opposers, regardless of whether they are foreign or domestic").¹⁷

Nor can GC show that CT's analogous use is to be disregarded because CT has not sold Cohiba in the U.S. within a "commercially reasonable period." R. Br. 39. The Board, insofar as it invokes this concept at all,¹⁸ does so to prevent warehousing or to identify use insufficient to maintain a public association.¹⁹

[REDACTED], the strong public association of the mark with the Cuban cigar and CT's undisputed intention to sell Cohiba in the U.S. (as it does everywhere else) as soon as U.S. law allows, P. Br. 27, n.26, 31-35, neither concern applies. Further,

¹⁶ GC's argument based on *Taboca*, R. Br. 40, is premised on a non-existent use-in-commerce requirement.

¹⁷ Any disparate treatment would contravene the U.S.'s treaty obligations. *Brit.-Am. Tobacco v. Philip Morris Inc.*, 55 USPQ2d 1585, 1587 (TTAB 2000) (Pan-American Convention requires Convention nationals be afforded national treatment). GC's reliance on *Mother's Rests. Inc. v. Mother's Other Kitchen, Inc.*, 218 USPQ 1046 (TTAB 1983) and *Adolphe Lafont, S.A. v. Ellera, S.P.A.*, 228 USPQ 589 (TTAB 1985), R. Br. 40, is unavailing. In the reversed Board decision in *First Niagara*, the Board cited and applied *Mother's Rests.* for the exact proposition GC relies on here, which the Federal Circuit rejected.

¹⁸ The Board has noted that this requirement is only applied in "[s]ome cases." *Cent. Garden & Pet Co. v. Doskocil Mfr.*, 108 USPQ2d 1134, 1142 n.19 (TTAB 2013). In GC's lead case for this purported requirement, *Dyneer Corp. v. Automotive Prods.*, the Board did not apply such a rule, reasoning that because "applicant has not, to date, made any technical use of its mark, . . . we modify the test regarding analogous use" so as not to require "technical use," but instead "ask whether applicant engaged in a continuing effort to cultivate an association of the [] mark with itself and its goods, and whether the association. . . continued up until the filing of applicant's intent-to-use application." 37 USPQ2d 1251, 1256 (TTAB 1995).

¹⁹ *Evans Chemetics, Inc. v. Chemetics Int'l*, 207 USPQ 695, 700 (TTAB 1980) (asking if analogous use "was merely an attempt to preempt a mark"); *Westrex Corp. v. New Sensor Corp.*, 83 USPQ2d 1215, 1218 (TTAB 2007) ("insufficient to establish [] the necessary association;" "activities were far too sporadic").

the settled principles concerning excusable nonuse, including its application to § 2(d) and the Cuban embargo, foreclose GC's unsupported suggestion in these circumstances.²⁰

GC's assertion that CT's analogous use must be disregarded because the Board has rejected the well-known marks doctrine, R. Br. 36, ignores that analogous use is based on statute and requires "use[] in the [U.S.]," § 2(d), while the doctrine is a proposed innovation of the common law and does not require activity in the U.S.—only *renown*, which may arise simply from use abroad. 5 MCCARTHY § 29:4 (well-known marks doctrine is proposed "exception to the rule that only U.S. priority of use counts" as it protects a mark "not used" in U.S.).²¹

Finally, it does not appear that GC argues that CT failed to satisfy any requirement of continuing to promote its Cohiba after the premier issue of *Cigar Aficionado* until today, or that its efforts lacked

²⁰ Contrary to GC's assertion, R. Br. 40, excusable nonuse applies in the context of § 2(d) determinations. *Am. Lava Corp. v. Multronics, Inc.*, 461 F.2d 836, 839–40; 174 USPQ 107, 109–10 (CCPA 1972). Further, *Arechabala*, which found the embargo to be excusable non-use, is not, contrary to GC, limited to section 8 but expressly applies to abandonment. *Arechabala v. Havana Rum & Liquors, S.A.*, Canc. No. 22,881, at 17 (TTAB Oct. 19, 1995). The Board has held abandonment principles applicable to analogous use, *L. & J.G. Stickley v. Ronald Cosser, Inc.*, 81 USPQ2d 1956, 1968-69 (TTAB 2007), and the excusable nonuse doctrine encompasses similar considerations as to what is "commercially reasonable." *Double Coin Holdings, Ltd. v. Tru Dev.*, Canc. No. 9206380, 2019 WL 4877349, at *18 (Oct. 1, 2019). It would be incongruous, and lack any rationale, for a Cuban party to be able to obtain and retain priority by § 44(e) registration despite its not using the mark in commerce at the time of registration or thereafter because the embargo is excusable non-use but not be able to invoke analogous use because of the embargo.

No more proper than for rum in *Arechabala* is GC asking the Board to speculate on when it will be possible to sell Cuban cigars in the U.S. In addition to inviting speculation on whether there will be the changes in Cuba specified in LIBERTAD, triggering its mandatory provisions for end of the embargo, or whether embargo-ending legislation will pass, GC is wrong that Executive action is foreclosed. R. Br. 9. The President retains, and has used, authority to license transactions, including imports into the U.S., prohibited by embargo regulations as of March 1, 1996, as LIBERTAD preserved the Executive's licensing authority under those regulations. Nat'l Sec. Council Press Conference (Jan. 5, 1999) (transcript available at https://irp.fas.org/news/1999/01/99010506_lpo.html); OFAC & State Dep't. (Oct. 16, 1998), in CUBAN EMBARGO: SELECTED ISSUES RELATED TO TRAVEL, EXPORTS AND TELECOMMUNICATIONS, GAO/NSID-99-10, at App'x IV (Dec. 1998); 31 C.F.R. § 515.547 (2016 General License for imports of Cuban-origin pharmaceuticals); § 515.578(e)(1) (2015 General License for import of Cuban-origin mobile apps).

²¹ See also, e.g., *Grupo Gigante SA De CV v. Dallo & Co.*, 391 F.3d 1088, 1092; 73 USPQ2d 1258, 1261 (9th Cir. 2004) (well-known marks doctrine applies even though claimant had not "used the mark in the [U.S.].") GC's sometimes lapsing into the suggestion that CT's use "occurred entirely outside of the U.S." and it was that use which accounts for its U.S. renown, R. Br. 37-38, [REDACTED]

requisite success. R. Br. 39. In any event, any such suggestion could not stand. CT has made more than a sufficient showing of a successful “continuing effort to cultivate an association of the [] mark with itself and its goods,” *Dyneer*, 37 USPQ2d at 1256. P. Br. 31-35.²²

2. Board precedent requires finding likelihood of confusion merely on facts GC concedes or does not contest. P. Br. 35, 37-42. GC *concedes* that the marks and goods are identical, R. Br. 46, which makes likelihood of confusion “inevitable,” P. Br. 35, and it intentionally copied the Cuban Cohiba cigar. R. Br. 11-12, 52-53.²³ It *does not contest* that: COHIBA is arbitrary and fanciful, P. Br. 37; the Cuban Cohiba’s recognition and renown in the U.S. is extensive;²⁴ purchasers of non-premium cigars are not discerning or cautious, important here as likelihood of confusion is based on the “least sophisticated potential purchasers,” P. Br. 38-40, R. Br. 10;²⁵ or CT’s showing concerning *du Pont* factors 12, 6, 9, 10 or 11. P. Br. 45-48. GC points to no case denying likelihood of confusion in similar circumstances.²⁶

GC argues all this should be disregarded and the Board’s precedent is “of little value” because of the “practicalities of the commercial world,” R. Br. 42, principally that consumers’ supposed knowledge of

²² Further, in addition to the continuing media coverage [REDACTED] P. Br. 31, 35, the Federal Circuit has explained that “the whole purpose of this [§ 2(d)] inquiry” is to determine if the asserted use has created an “association of the public.” *Nat’l Cable Television Assn. v. Am. Cinema Eds.*, 937 F.2d 1572, 1577-78; 19 USPQ2d 1424, 1428-29 (Fed. Cir. 1991) (holding “even without use directly by the claimant . . . public use by others inures to the claimant’s benefit” such that it can “be deemed use ‘by’ that party in the sense of a use on its behalf”). There is surely such public association here, [REDACTED]. P. Br. 27, 31.

²³ GC learned of the Cuban cigar and copied its name in 1978 because it was a “Cuban-origin name,” 341 TTABVUE 8 (Cullman Jr.), and applied to register COHIBA and put a COHIBA-branded cigar on the market in 1992 to “capitalize” on Cuban cigar’s renown, P. Br. 29-30, not because “Cohiba” was “short and easy to say.” R. Br. 12.

²⁴ GC does not contest CT’s evidence of current reputation and renown, or that the Cuban Cohiba’s reputation and renown dwarfs that of GC’s and its ratings are significantly higher and more frequent than GC’s Cohiba. P. Br. 26-35; R. Br. 47-48. (GC’s claim that its Cohiba is “highly rated,” R. Br. 15-16, is both irrelevant and unsupported by evidence, 365 TTABVUE 84—indeed, GC itself recognizes that [REDACTED])

²⁵ GC’s assumption that the proper metric is potential purchasers of *premium* cigars, R. Br. 47, fails to recognize that neither its registrations nor CT’s application are so limited.

²⁶ CT must only show likelihood of confusion by a preponderance of the evidence, *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 951; 55 USPQ2d 1842, 1848 (Fed. Cir. 2000), *not* a “heavy burden,” R. Br. 36, 41, 53.

the embargo “sharply minimizes” the likelihood of confusion. R. Br. 43-45. GC bears the burden for this argument, P. Br. 51, which it has not met. *See* P. Br. 48-52, and below.²⁷ Further, regardless of burden, CT presents sufficient and compelling evidence of likelihood of confusion, P. Br. 35-48, which GC has done nothing to undermine, and is far stronger than GC’s evidence.²⁸

(a) GC’s claims that CT’s extensive evidence is not indicative of confusion or “admissible,” R. Br. 41, 48, are wholly unwarranted. *See* Appendix B as to admissibility. As CT’s evidence is too voluminous to recount here, P. Br. 37-47, only the following is noted:

i. Willner, GC’s past president, gave important, balanced testimony, 223 TTABVUE 2-14, which GC also relies upon and Willner stood by, even if he could [REDACTED]

[REDACTED]-65. GC’s claim that he testified falsely out of spite, R. Br. 49, is outrageous and without basis.²⁹ Moreover, CT has presented a mountain of evidence showing actual confusion, P. Br. 35-48, including, without fully rehashing its trial brief, [REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]³¹

²⁷ CT’s likelihood of confusion showing among *premium* cigar smokers in the Federal Action, including by survey evidence, *despite more than 40 years of the embargo*, makes GC’s burden even greater to show that the embargo dispels confusion now. P. Br. 48.

²⁸ CT also has shown there would be confusion post-embargo, an alternative ground for finding likelihood of confusion. P. Br. 35-37.

²⁹ The cases GC cites at the top of R. Br. 50 are inapposite because *Hi-Country Foods* concerns self-serving testimony and there is much more evidence of confusion here than in *Nora Beverages, Inc.*

³⁰ In addition to admitting confusion, [REDACTED] not just its “Cuban equities.” R. Br. 51; P. Br. 41, 44 & n.56.

³¹ Evidence of actual confusion “often go[es] unreported or unrecorded,” is “practically almost impossible to secure,” and not required, 4 MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 23:12 (5th ed. 2021), but here it is plentiful and there is still other conclusive evidence of likelihood of confusion.

Because CT has presented evidence of actual confusion, *du Pont* factor 8 is not an issue.

ii. Several U.S. online retailers confuse and engender confusion by selling GC's Cohiba using a Cuban Cohiba image. P. Br. 42. GC does not contest this or that it is actual confusion. Multiplying the impact of this confusion, cigar consumers now get their information primarily from the internet, not, as before, print catalogs or in stores, as GC's expert conceded. 347 TTABVUE 53.

iii. The pervasive false connection of the GC to the Cuban Cohiba by over 20, including all of the top, internet cigar retailers and even GC's sister company, engenders confusion. P. Br. 44-45. There are *not* a "handful" of such retailers and most do *not* "explain that the GC COHIBA cigar originates from GC, not CT," R. Br. 51, as evidenced by the descriptions themselves. P. Br. 44-45. GC's expert testified that even those that may do not dispel confusion for consumers "who didn't know" Cohiba. P. Br. 49. Any such distinction, moreover, would not dispel association confusion.

iv. [REDACTED] identifying consumer confusion are hardly "non-probative" "anecdotal evidence," R. Br. 50, as [REDACTED]
[REDACTED] They are powerful, and admissible both as fact-based lay opinion and admissions against interest. P. Br. 41-42; 223 TTABVUE 11-12; App'x B, at xliii-xlvi. The social media posts are themselves evidence of actual confusion.³² CT presented almost 100 such posts on the main platforms from scores of U.S. consumers with hundreds of thousands of followers, not a "handful." The 100 are representative of still more posts. 219, 220 TTABVUE; R. Br. 50.³³

v. The persistent questioning of cigar store clerks whether GC's Cohiba is from Cuba evidences

³² GC successfully (and correctly) argued that social media posts are admissible evidence of confusion in a related action, P. Br. 42 n.50, and cannot be heard to argue (incorrectly) the opposite here.

³³ The cases cited by GC do nothing to undermine this evidence. *See Reply All Corp. v. Gimlet Media, LLC*, 843 F. App'x 392, 397 (2d Cir. 2021), *id.* at ECF 66, at 180-93 (8 instances of tagging "without more"); *Double Coin Holdings Ltd. v. TRU Dev.*, Canc. No. 92063808, 2019 WL 4877349 (TTAB Oct. 1, 2019) (not tagging case); *Ethika, Inc. v. Hage-Buotros*, Canc. No. 9206368, 2020 WL 6306141, at *9 (TTAB Oct. 26, 2020) (hashtags may be evidence that "Respondent's mark may call to mind Petitioner's or vice versa"); *Starbuzz Tobacco, Inc. v. Starbuds Coop.*, Opp. No. 91224065, 2019 WL 3524389, at *7 (TTAB July 11, 2019) (no "explanation" "about how [evidence] [wa]s probative"). None included, as here, reports and opinions of confusion from the opposing party's own agent.

confusion, their only “common denominator,” *Co. of Am. v. Bankamerica Corp.*, 205 USPQ. 1016, 1035 (TTAB 1979), including confusion that is not dispelled for those who never ask; any response by the clerks that they are not, R. Br. 48, does not dispel association confusion; and it is “illustrative...of how and why confusion is likely,” a point GC does not address. P. Br. 42-43.

vi. Other uncontested evidence of actual confusion and engendering confusion includes online articles about the *Cuban Cohiba* hyperlinking the word “Cohiba” to GC’s Cohiba website and a popular cigar app confusing the GC and Cuban Cohiba cigars. P. Br. 43, 45.

vii. CT need not present testimony from consumers who were actually confused and the Board “will not draw a negative inference from a party’s failure to offer survey evidence,” 6 MCCARTHY § 32:180, contrary to GC, R. Br. 51-52, especially when there is other, extensive evidence of confusion.

(b) GC largely bases its embargo argument on its expert’s testimony.³⁴ Even if Hacker’s testimony were credited, it would be inadequate to outweigh CT’s showing of confusion, and that an appreciable number of even U.S. *premium* cigar consumers do not know Cuban cigars are barred. P. Br. 48-54.

Moreover, Hacker’s testimony that high-end, dedicated premium cigar smokers know about the embargo does not come close to meeting GC’s burden, P. Br. 50 & n.67, 52, and says nothing about the other, more numerous segments of the market. Further, GC’s reliance on Hacker ignores the many important ways in which his testimony *confirms* appreciable confusion even among premium cigar smokers; that Hacker either did not address or had no basis for opining on association confusion; he admittedly was not qualified to opine about confusion on the internet, which he acknowledges is now the primary source of information for cigar consumers; his assertion of lack of confusion not only was contradicted by his other testimony but rested primarily on consumers he encountered simply not asking whether GC’s was a Cuban-origin cigar; and the Board’s precedent that showing knowledge of the embargo is not sufficient since consumers might think there is an applicable exception. P. Br. 48-52.

³⁴ The only other witnesses GC relies upon, R. Br. 44, are Willner, whose testimony supports CT, and witnesses from the Federal Action, where survey and other evidence established confusion despite 40 years of embargo, P. Br. 48; 340 TTABVUE 40-59, 102-155 (survey), as the District Court found.

GC's citation of 16 articles purportedly "explain[ing]" the "inability to buy Cuban cigars in the U.S." R. Br. 43 is hardly sufficient to carry its burden or overcome CT's proof, and, in addition: Hacker acknowledged that the general circulation press has frequently *reflected* and *engendered* confusion, P. Br. 49; most consumers get information about cigars on-line, *supra*, at 20, where CT has shown confusion is substantial; 15 of the 16 articles were in cigar consumer print publications and the 16th in the *Wall Street Journal*; and none dispel association confusion.³⁵

GC's "parallel brands" argument, R. Br. 43, 45, is simply a repetition of its embargo argument (consumers know that Cuban cigars sold under a mark outside the U.S. cannot be sold here because of the embargo), and fails for the same reasons, including GC's failure to meet its burden with sufficient evidence that awareness of parallel brands, whatever it may be, dispels confusion. Indeed, the argument backfires, as any perception that the two cigars are "parallel brands" would engender confusion. P. Br. 53.³⁶

B. Respondent's Misrepresentation of Source

GC does not contest CT's showing that GC sought to capitalize on the reputation and renown of the Cuban Cohiba in the U.S. in launching a COHIBA-branded cigar in 1992. P. Br. 23-24, 29-30. Further, GC gave a national exclusive to Dunhill (except for a retailer in Florida), which promoted the cigar as "the celebrated range of Cuban origin." *Id.* 53. GC bears full responsibility for this misrepresentation, the only promotion of GC's Cohiba from 1992–1996, 345 TTABVUE 386-87 (Rano): it paid Dunhill for the promotion, helped write the Dunhill catalog and made no objections.³⁷ GC also intentionally

³⁵ GC's reliance on articles about the parties' litigation, R. Br. 43, 45, fails for similar reasons and, in addition, because the subsequent, far greater coverage of President Obama's normalization efforts encouraged confusion, which Hacker conceded, P. Br. 49; none from the general media predate April 2013 and only 4 are from 2009-2013, 288 TTABVUE 320-21, 280, 312-13, 367-68; most (2/3) are from consumer cigar or other specialized publications, wire services or non-U.S. publications and predate 2010, R. Br. 45 (citing articles); and what consumers took away from the parties' being in litigation is speculative.

³⁶ For its "parallel brands" argument, GC again principally relies on Hacker and adds a GC employee (Abbot), neither of whom can prove what consumers *understand* about parallel brands and neither of whom say anything about non-premium cigar consumers, and two press articles, which are *de minimis*. P. Br. 50-52

³⁷ 343 TTABVUE 537-38 (Geoghagen); 345 TTABVUE 349-51, 386-88 (Rano); 344 TTABVUE 998, 1021-22 (Dunhill's Perez); 343 TTABVUE 855-857 (Dunhill's Johnson).

designed its cigar box as “practically an exact replica” of the Cuban Cohiba’s. 340 TTABVue 330, 358-60, 559-62 (Siegel); P. Br. 24.

GC claims that retailer misrepresentation today is a “rare occurrence” from a “handful of retailers,” R. Br. 54, but CT has shown they are made by *over 20 different U.S. online cigar retailers*, including the

GC's fault is not only one of permission: GC *links* its Cohiba website to 10 of these retailers. 221 TTABVue 21; 200 TTABVue 575. It takes still additional steps to spread these misrepresentations.⁴¹

³⁹ 221 TTABVUE 3-21, 28-29; 351 TTABVUE 179-81 (Martínez); *id.* at 590-91 (Richter). GC’s sister company, Cigar International, describes the GC product as “[o]riginally crafted in the streets of Havana, Cuba, this is a classic that everyone’s heard of;” and “[t]his line originated from the special blend of tobaccos that Fidel Castro himself used to smoke.” Thompson talks of only one “Cohiba brand” with the “original Cohiba cigar line [] made expressly for Fidel Castro.” 221 TTABVUE 3-5, 9. Gotham states that GC “licensed the Cohiba name.” Cigar.com states that “Cohiba was born in Cuba” *Id.* at 10, 14. GC does not cite to a single online retailer description to support its assertion that “[m]ost” online retailer “make no reference at all” or “clear[ly]” differentiate the CT Cohiba, R. Br. 54. Its citation to 5 *print* catalogs includes GC’s sister company reiterating the misrepresentation it makes on-line. 254 TTABVUE 32.

Two of GC's citations, R. Br. 55, have nothing to do with retailers; the third, 349 TTABVue 1348-1358, at most shows that

Contrary to GC, section 14 covers not only misrepresentations by the respondent, R. Br. 55, but, expressly, also “with the permission of the registrant.”⁴² Here, there is both. Past misrepresentation warrants cancellation “even though [the] marketing may have changed,” *The Coca-Cola Co. v. Meenaxi Enter., Inc.*, 2021 USPQ2d 709; 2021 WL 2681898, *15 (TTAB 2021); here, it has continued.

All this has taken place in the “‘parallel brands’ situation” stressed by GC, R. Br. 9-10, where GC and its competitors use “Cuban-origin name[s]” because they represent “continuity from the pre-Revolution manufacturers to the current products sold in the [U.S.]” and the pre-Revolution manufacturer “standing behind the product.” 338 TTABVUE 898-907 (Cullman, Jr.). There is thus both the misrepresentation of source in using a Cuban brand name for what is not a parallel brand and the misrepresentations by and with the permission of GC that CT has shown. Viewed in combination or even separately, this more than suffices.

Indeed, in a fake “parallel brand” case, *Cuban Cigar Brands N. V. v. Upmann Int’l, Inc.*, 457 F. Supp. 1090, 1101; 199 USPQ 193, 200 (S.D.N.Y. 1978), *aff’d*, 607 F.2d 995 (2d Cir. 1979), whose analysis was adopted by the Board, *E.E. Dickinson Co. v. T.N. Dickinson Co.*, 221 USPQ 713, 715 (TTAB 1984), the court held cancellation warranted by use of a mark nearly identical to a Cuban cigar mark (here, they are identical) and promotion (like here) falsely conveying the product’s Cuban origins. 457 F. Supp. at 1099; 199 USPQ at 201-02. In *Bayer Consumer Care AG v. Belmora LLC*, like here, the “evidence shows that respondent's owner and agents repeatedly invoked the reputation of petitioner's [] mark when marketing respondent's [] product in the United States,” 110 USPQ2d 1623, 1632 (TTAB 2014), *aff’d*, 338 F. Supp. 3d 477 (E.D. Va. 2018), *aff’d in relevant part, vacated on other grounds*, 987 F.3d 284 (4th Cir. 2021).⁴³

Cohiba’s history as its own. P. Br. 44 n.56; 349 TTABVUE 1001-20. It recently strengthened the already “direct familial relationship” of its trade dress with the Cuban Cohiba by adding a color long associated with the Cuban Cohiba on a new line. 287 TTABVUE 25-27, 191. GC’s Cohiba Brand Ambassador (Sean Williams), whose social media accounts GC reviews “to make sure [they were] in line with how [it] wished to be represented.” 276 TTABVUE 3, 5, posted 9 times (with 14 photos) to his GC Cohiba account about his trip to Cuba, 167 TTABVUE 14, 384-413; 308 TTABVUE 20-22, and an image of GC’s Cohiba with a Fidel Castro statue. 308 TTABVUE 19-20. GC sponsors Cuba-themed events where it provides its Cohiba cigar. 353 TTABVUE 1070, 1344, 1347.

⁴² GC’s citation of out-of-context dicta from a case involving no issue of third-party use (with or without permission), R. Br. 55, cannot evade the clear statutory text.

⁴³ In arguing that *Belmora*’s drawing a distinction between section 14(3) and section 2(d) claims stands

GC's intermingling histories, as well as mimicking trade dress and otherwise linking the products, is comparable to the use of similar logos, trade dress, and taglines in *Coca-Cola Co.*, 2021 WL 2681898, *19.

Finally, GC's argument that section 14(3) reaches only GC passing off its product as CT's or as a "version of the CT Cohiba," R. Br. 53, 55, overlooks that the evidence does indeed show passing off GC's as a "version of the CT Cohiba," and also that "[w]e look for ... deliberate misrepresentation of the source of [respondent's] product, blatant misuse of the mark, *or* conduct amounting to the deliberate passing off of [its] goods." *Belmora*, 110 USPQ2d at 1632 (emphasis added). And section 14(3) applies to conduct calculated to "blur whatever distinctions exist between the parties' products, and trade upon the renown and reputation of plaintiff," *Cuban Cigar Brands*, 457 F. Supp. at 1101; *see also E.E. Dickinson Co.*, 221 USPQ at 715; *McConnell Douglas Corp. v. Nat'l Data Corp.*, 228 USPQ 45 (TTAB 1985), surely the case here.

IV. Respondent Has Waived Its Affirmative Defenses Other Than Issue Preclusion

Not briefing them, GC waived its Affirmative Defenses other than issue preclusion. TBMP § 801.01.

CONCLUSION

For the foregoing reasons, Registration Nos. 1147309 and 1898273 should be cancelled.

Dated: October 18, 2021

Respectfully submitted,

On the Brief:
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against CT, R. Br. 54, GC omits this key passage.

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In the matter of Trademark Registration No. 1147309
For the mark COHIBA
Date registered: February 17, 1981

AND

In the matter of the Trademark Registration No. 1898273
For the mark COHIBA
Date registered: June 6, 1995

EMPRESA CUBANA DEL TABACO d.b.a.
CUBATABACO,

Petitioner,

Cancellation No. 92025859

v.

GENERAL CIGAR CO., INC.,

Respondent.

APPENDIX A

Petitioner's Index Of Evidence

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Dated: October 18, 2021

Pursuant to the Board’s September 29, 2018 Order, Petitioner Empresa Cubana del Tabaco, d.b.a. Cubatabaco (“CT”) provides an “index of the evidence” cited in its Reply Trial Brief “with each entry consisting of a description of the item and the TTABVUE entry number ... [and] a reference to the TTABVUE entry for the stipulation that addresses the admissibility.”¹

For ease of reference, CT (1) has organized the Index by TTABVUE Docket No; and (2) includes in this Index evidence relied upon by CT whose admissibility is not based on a Stipulation.

In order to avoid repetition, CT includes below only evidence cited in its Reply Trial Brief that was not covered by the Index of Evidence it had appended to its main Trial Brief (365 TTABVUE 59-78).

TTABVUE No. ²	Description of Item	Stipulation Addressing Admissibility
175 TTABVUE 176-195 ³	CT’s Notice of Reliance Exhibit No. 70: GC’s final 2017 Cohiba Brand Plan, produced by GC	132 TTABVUE 4 (Stipulation, ¶5); 135 TTABVUE. This document is also admissible as document identified and authenticated by its author, Steven Abbot, 349 TTABVUE 89-90, 375-392.
178 TTABVUE 2023-35	Federal Action CT’s Trial Exhibit Nos. PX355-58, PX360: Thompson & Co., Inc. Cigar Catalogs 2000-2001	89 TTABVUE 2-3 (Stipulation, ¶¶2-3); 91 TTABVUE (Stipulation granted)

¹ The Federal Action trial transcript, written direct testimony, and deposition transcripts, identified in the Index below, were designated and filed with the Board pursuant to the procedure approved by the Board in 138 TTABVUE; 136 TTABVUE. The transcripts of the discovery depositions taken in this proceeding and introduced as evidence, identified in the Index below, were designated and filed with the Board pursuant to the procedure approved by the Board in 165 TTABVUE; 157 TTABVUE.

The Parties stipulated that they need not utilize a Notice of Reliance to introduce the above as well as the other Federal Action materials identified in this Index. *Supra* & 132 TTABVUE 3 (¶¶ 1-3); 137 TTABVUE 5 (¶ 6).

² Citations to the Parties’ confidential filings with the Board assume that there is a cover page added to the first page of the docket entry.

³ CT included this entry in the Index of Evidence appended to its Main Trial Brief but inadvertently did not include the final page (175 TTABVUE 195) in this range.

TTABVUE No. ²	Description of Item	Stipulation Addressing Admissibility
179 TTABVUE 507-08	Federal Action CT's Trial Exhibit No. PX673: JR Cigars Online Catalog 2001	89 TTABVUE 2-3 (Stipulation, ¶¶2-3); 91 TTABVUE (Stipulation granted)
182 TTABVUE 86-87, 98-99	Federal Action CT's Trial Exhibit No. PX1124 <i>Newsweek</i> article (Sept. 21, 1992) and <i>N.Y. Times</i> article (Oct. 2, 1992)	89 TTABVUE 2-3 (Stipulation, ¶¶2-3); 91 TTABVUE (Stipulation granted)
190 TTABVUE 54-56	Federal Action CT's Trial Exhibit No. DX212 Response of Empresa Cubana del Tabaco d.b.a. Cubatabaco to Defendants Culbro Corporation and General Cigar Co., Inc.'s Second Set of Interrogatories. Introduced and relied upon by Respondent.	89 TTABVUE 2-3 (Stipulation, ¶¶2-3); 91 TTABVUE (Stipulation granted)
191 TTABVUE 69-70	Federal Action CT's Deposition Exhibit No. 13: GC Cohiba Packaging for product introduced in 1982 and discontinued in 1987 or earlier.	89 TTABVUE 2-3 (Stipulation, ¶¶2-3); 91 TTABVUE (Stipulation granted)
193 TTABVUE 754-60	Federal Action CT's Deposition Exhibit No. 242: GC sales records 1991	89 TTABVUE 2-3 (Stipulation, ¶¶2-3); 91 TTABVUE (Stipulation granted)
276 TTABVUE	Trial Declaration of Victoria McKee Jaworski. Jaworski was GC's Director of Public Relations, Experiential Marketing and Digital Media from 2005-2019	Trail Testimony, 37 C.F.R. § 2.123(a)(1), subject to Evidentiary Objections
342 TTABVUE 390-503	Designated Federal Action Discovery Deposition Transcript of David Burgh, dated November 1, 2000. Burgh held senior executive positions at GC from the 1970s to 1994, and was a GC consultant 1994-2000.	89 TTABVUE 2-3 (Stipulation, ¶¶2-3); 91 TTABVUE (Stipulation granted)
343 TTABVUE 537-38	Designated Federal Action Discovery Deposition Transcript of John R. Geoghegan, dated May 17, 2000. Geoghegan was GC's VP of Strategic Planning and Brand Development, 1994-1999.	89 TTABVUE 2-3 (Stipulation, ¶¶2-3); 91 TTABVUE (Stipulation granted)
343 TTABVUE 791-895	Designated Federal Action Discovery Deposition Transcript of Steven F. Johnson, dated June 6, 2000. Johnson testified as Alfred Dunhill of London's Rule 30(b)(6) witness.	89 TTABVUE 2-3 (Stipulation, ¶¶2-3); 91 TTABVUE (Stipulation granted)
345 TTABVUE 597-647	Designated Federal Action Discovery Deposition Transcript of John Rano. Rano was employed at GC 1984-99, and held the positions of VP of Marketing, Senior VP of Marketing and Senior VP of Sales 1990-1999. Part of his testimony was given as GC's Rule 30(b)(6) witness.	89 TTABVUE 2-3 (Stipulation, ¶¶2-3); 91 TTABVUE (Stipulation granted)

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GENERAL CIGAR CO., INC.,

Cancellation No. 92025859

Respondent.

APPENDIX B

Petitioner's Response To Respondent's Evidentiary Objections

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Dated: October 18, 2021

Respondent General Cigar Co., Inc. (“GC”) presented sixty-three (63) evidentiary objections in a chart covering fifty-six (56) pages, or twice the length of CT’s evidentiary objections. 367 TTABVUE 71-126. Petitioner Empresa Cubana del Tabaco dba Cubatabaco (“CT”) reproduces GC’s chart objections below in the order GC presented them, with CT’s response below each objection.¹

Many of GC’s objections are to the relevance of the evidence. These objections lack merit, since the objected-to evidence is probative of one or more issue in this proceeding, as detailed below. In such situations, as GC agrees, 367 TTABVUE 128, the Board admits the evidence and decides what weight it deserves. *See infra* CT Response to GC’s Evidentiary Objection No. 1.

GC also presents numerous procedural objections, including lack of foundation or authenticity, for the first time in its Trial Brief. Under clear Board precedent, GC has waived these procedural objections. *See infra* CT Response to GC’s Evidentiary Objection No. 11. Indeed, for the vast majority of these procedural objections, GC did not examine the witness at all. *See* CT’s Responses to GC’s Evidentiary Objection Nos. 17-22, 35-36, 38, 40-41, 46, 52, 55-56.²

GC does not object to any specific testimony or evidence from the federal action between the Parties, Case No. 97 Civ. 8399 (S.D.N.Y.). GC only requests that in “the event the Board evaluates CT’s contemporaneous objections to testimony in the Federal Action, GC requests that the Board give the same evaluation to GC’s objections stated therein.” 367 TTABVUE 129 n.2; *see also id.* at 72. For the vast majority of the federal action materials CT cites in its Trial and Rebuttal Briefs, GC does not even present a “contemporaneous objection” or if it did, it was overruled. For example, CT cites to the federal action trial transcript twelve (12) times in its Trial Brief; however, the page ranges in ten (10) of those citations

¹ CT has abbreviated GC’s narrative text to save space.

The last column of GC’s Evidentiary Objections chart purports to identify the pages of CT’s Trial Brief (365 TTABVUE) where CT cites the evidence to which GC objects, 367 TTABVUE 72; however, many of GC entries in this last column are incorrect.

² Twenty-five (25) of GC’s sixty-three (63) objections are directed toward testimony and evidence of CT’s witnesses GC chose not to cross-examine (Brenna Murdock, Miguel Suárez Medina, Gerardo Ruiz, Christina Licata, Annalisa Martini Declaration Nos. 2-3, First Declaration of Susan Bailey, David Girolami, Tom Bailey, Thomas J. Reilly, Kevin A. Gregg and Tahimi Arboleya Delgado).

do not include any “contemporaneous objections” by GC³ and none of GC’s “contemporaneous objections” in the other two (2) cited page ranges were sustained (for several of these objections, GC did not even state a basis for the objection).⁴

1.

Declaration of Enrique Babot Espinosa (“Babot Declaration”)			
GC’s Description	GC’s Citation to TTABVUE No.	GC’s Objection	GC’s Identification of Pages Where CT Cites to Evidence in its Trial Brief
Statements by Babot concerning activities by CT or Habanos S.A. (“Habanos”) in the periods prior to April 2005, between August 2008 and July 2014, and after April 2017.	139 TTABVUE ¶¶ 5, 26-30, generally	a. FRE 602—Lack of Foundation b. FRE 802—Hearsay c. FRE 401—Relevancy	365 TTABVUE 27, 46-47

RESPONSE:

a. FRE 602 – Lack of Foundation

GC argues that Babot does not have personal knowledge regarding his testimony in Paragraphs 5, 26-30 and “generally”⁵ and that this testimony is hearsay for the periods prior to 2005, between August 2008 and July 2014, and after April 2017 because “his responsibility did not include CT’s or Habanos’ marketing efforts as Director for Operational Marketing for Habanos.” 367 TTABVUE 72-74.

Even though Babot was not Habanos, S.A.’s Director for Operational Marketing during these periods, under binding Board precedent, he still had “sufficient knowledge” to testify about these periods as his testimony was about Habanos S.A.’s practices and procedures—including for the periods in which he was not the Director of Operational Marketing—based on his personal experiences as the Director of Operational Marketing, his review of the Operational Marketing Department’s documents concerning its

³ 365 TTABVUE 29, 31, 32 & n.31, 33 n.32, 34 (citing 338 TTABVUE 2, 57-62, 142, 173, 178-79, 212-13, 254-55, 805, 940, 1052-53, 1058, 1060-64).

⁴ 365 TTABVUE 32 & n.31 (citing 338 TTABVUE 147-50, 157-58, 171-72).

⁵ GC does not identify specific testimony or paragraphs “generally” refers to.

practices and procedures and confirmed by exchanges he had, as a required and “vital” part of his job, with: (a) employees in his Department that worked there before his becoming Director; and (b) the outgoing Director. *See Nahshin v. Prod. Source Int’l, LLC*, 107 USPQ2d 1257, 1260 (TTAB 2013) *aff’d*, 112 F. Supp. 3d 383 (E.D. Va. 2015) (hearsay objection overruled where witness’s testimony “was based on knowledge he acquired through his position with the company, and are based on personal knowledge, reports and business records”); *see also First Nat. Bank of Louisville v. Lustig*, 96 F.3d 1554, 1576 (5th Cir. 1996) (upholding denial of FRE 602 objection to testimony about which witness did not have direct knowledge, finding sufficient that witness had been an employee for many years and was “intimately familiar” with certain practices to which he testified) (relied upon by GC).

GC does not dispute that:

- Babot was the Habanos, S.A.’s Director for Operational Marketing between April 2005 and August 2008 and July 2014 and April 2017. 139 TTABVUE 26;
- As Director for Operational Marketing, he “oversaw and led and actively participated in the department that develops and implements strategies and policies related to the promotion, advertising and pricing of Cuban cigars, including COHIBA.” 139 TTABVUE 26;
- When he started as Director for Operational Marketing in both 2005 and 2014, Babot ascertained what the practices and policies of Habanos, S.A.’s Operational Marketing Department were, including in discussions with the outgoing Director and remaining employees and reviewing Department documents concerning its policies and practices. 359 TTABVUE 209-80; *id.* at 216 (“it was vital to verify the prior policies or policies”).
- Babot was an employee of CT and then Habanos from 1986 until 2005, including its Commercial Director and International Sales Representative, and after April 2017 he was Habanos, S.A.’s International Supervisor of Markets. 367 TTABVUE 73; 139 TTABVUE 25-27. Between 2008 and 2014, he was the President of a company that was an importer and distributor of premium Cuban cigars, including the Cuban COHIBA cigars, in France and

distributor in Algeria and Monaco, and during that time he “was in contact with Habanos, S.A., with its directors, and with the activities that Habanos, S.A. was doing in Cuba and in the rest of the other markets.” 139 TTABVUE 26; 359 TTABVUE 60 (59:15-20) (Babot).

GC falsely states that “Babot declined to identify the sources of his information in this direct testimony or cross-examination on written questions,” citing to “259^[6] TTABVUE at 21:13-23:23; 58:13-17.” *GC never asked him their names.* On pages 21-23, Mr. Babot merely acknowledges that, in his declaration, he does not name the people he spoke with about the practices and policies of the Operational Marketing Department. He does not refuse to provide GC with these names. 359 TTABVUE 22-26. In these pages, he also re-affirms that the statements in his declaration are based on personal knowledge. *Id.* On Page 58, lines 13-17, Mr. Babot merely states that he did not work for CT in between 2008 and 2014; he does not decline to identify sources of information.

b. FRE 401 – Relevancy

GC’s relevance objection lacks merit, since the objected-to testimony is probative, *inter alia*, of the public recognition and renown of the Cuban Cohiba in the United States (the fifth *du Pont* factor) and CT’s long-standing intention to sell the Cuban Cohiba cigar in the United States as soon as U.S. law permits, 365 TTABVUE 29 n.26, 49, CT’s prior analogous use of the Cuban Cohiba in the United States (section 2(d), CT’s Sixth Ground for Cancellation) and CT’s Eighth Ground for Cancellation (section 14(3); 15 U.S.C. § 1604(3), misrepresentation of source, or permitting others to misrepresent source, as to which the renown and reputation of the mark in the U.S. is relevant, *see, e.g., The Coca-Cola Co. v. Meenaxi Enter., Inc.*, 2021 USPQ2d 709 (TTAB 2021)), in addition to refuting GC’s claim that [REDACTED] [REDACTED] *See, e.g.,* 367 TTABVUE 48 & n.30.

The relevance objection also should be overruled as it goes to the weight of the testimony. *See, e.g., Hunt Control Sys. Inc. v. Koninklijke Philips Elec. N.V.*, 98 USPQ2d 1558, 1564 (TTAB 2011), *rev’d on*

⁶ CT assumes GC is referring to 359 TTABVUE. 259 TTABVUE are copies of the consumer cigar magazine *Cigar Aficionado* that GC included in its Notice of Reliance.

other grounds, Civ. No. 11-3684, 2017 WL 3719468 (D.N.J. Aug. 29, 2017) (admitting evidence in spite of relevance objection and motion to strike evidence because “the Board is capable of weighing the relevance and strength or weakness of the objected-to testimony and evidence”); *Milwaukee Elec. Tool Corp. v. Freud Am., Inc.*, Canc. Nos. 92059634 & 92059637, 174 TTABVUE 7-8, 2019 WL 6522400, at *4 (TTAB Dec. 2, 2019) (declining to individually address numerous objections that go to weight rather than admissibility, noting that the Board is capable of weighing the relevance or the strength or weakness of the evidence and according it appropriate probative value); *Hanscomb Consulting, Inc. v. Hanscomb Ltd.*, 2020 USPQ2d 10085, at *3 (TTAB 2020) (Board is “capable of weighing the relevance and strength or weakness of the objected-to testimony and evidence, including any inherent limitations”).

2.

Babot Declaration			
<u>GC’s Description</u>	<u>GC’s Citation to TTABVUE No.</u>	<u>GC’s Objection</u>	<u>GC’s Identification of Pages Where CT Cites to Evidence in its Trial Brief</u>
Paragraph 11 “The media articles reporting on COHIBA demonstrate the success of positioning COHIBA as the most exclusive cigar at the pinnacle of Cuban cigar brands and show that the press reported on COHIBA in a way that distinguished it from all other cigars, including by reporting that it is associated with Fidel Castro as the cigar created for and smoked by him, that it is the highest quality and most expensive Cuban cigar and that it is made from the highest quality Cuban tobacco.”	139 TTABVUE 27 at ¶ 11	FRE 403, 602, 701(a) – Prejudice; Lack of Personal Knowledge; Lay Opinion on Legal Issues	N/A ⁷

RESPONSE:

CT does not cite to this testimony in its Trial or Rebuttal Briefs. In any event, GC’s objections are unfounded as this testimony is proper lay opinion. Fed. R. Evid. 701. It is Mr. Babot’s opinion based on his

⁷ GC states that “N/A” indicates that “GC anticipate[d] that CT may try to rely on such evidence in its reply papers.” 367 TTABVUE 72.

position as long-time cigar marketing director who [REDACTED]

[REDACTED]

[REDACTED]

This testimony, [REDACTED]

[REDACTED]

[REDACTED] sale of the Cuban Cohiba cigar at locations outside the United States frequented by U.S. travelers, the frequent awards by *Cigar Aficionado*, the leading U.S. consumer cigar publication, and others given to the Cuban Cohiba, and numerous other evidence, is relevant to show the public recognition and renown of the Cuban Cohiba in the United States (the fifth *du Pont* factor) and CT's long-standing intention to sell the Cuban Cohiba cigar in the United States as soon as U.S. law permits, CT's prior analogous use of the Cuban Cohiba in the United States (section 2(d), CT's Sixth Ground for Cancellation) and CT's Eighth Ground for Cancellation (section 14(3); 15 U.S.C. § 1604(3), misrepresentation of source, or permitting others to misrepresent source, as to which the renown and reputation of the mark in the U.S. is relevant, *see, e.g., The Coca-Cola Co. v. Meenaxi Enter., Inc.*, 2021 USPQ2d 709 (TTAB 2021)), in addition to refuting GC's claim that CT does not promote the Cuban Cohiba in the United States.

3.

Babot Declaration			
<u>GC's Description</u>	<u>GC's Citation to TTABVUE No.</u>	<u>GC's Objection</u>	<u>GC's Identification of Pages Where CT Cites to Evidence in its Trial Brief</u>
Paragraph 13 “At least during the period between May 2003 and the present, the price set for the COHIBA has been significantly higher than for the Cuban MONTECRISTO brand, [[a brand that has sold in far greater quantities. The Cuban COHIBA cigar is sold in Cuba only in the Cuban Convertible Currency (CUC), not the National Cuban Peso in which the vast majority of Cubans are	139 TTABVUE 28 at ¶ 11	FRE 401 – Relevancy	N/A

paid, and it is sold at such a high price in CUC that the major market in Cuba is for foreign visitors.]]”			
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RESPONSE:

CT does not cite to this testimony in its Trial or Rebuttal Briefs. In any event, this objection should be overruled as it goes to the weight of the testimony and, in situations such as this, the Board admits the evidence and decides what weight it deserves. *See* CT’s Response to GC’s Evidentiary Objection No. 1.

4.

Babot Declaration			
<u>GC’s Description</u>	<u>GC’s Citation to TTABVUE No.</u>	<u>GC’s Objection</u>	<u>GC’s Identification of Pages Where CT Cites to Evidence in its Trial Brief</u>
Paragraph 15 “The Cuban COHIBA cigar is sold in Cuba and throughout the world, except in the United States. Attached as Annex A is a list of the countries with Habanos, S.A. authorized distributors. Additionally, Habanos, S.A. authorized distributors outside Cuba also sell the Cuban COHIBA cigar in other countries.”	139 TTABVUE 29 at ¶ 15	FRE 401 – Relevancy	

RESPONSE:

This testimony is relevant as it is probative of CT’s intention to sell the Cuban Cohiba cigar in the United States as soon as U.S. law permits, 365 TTABVUE 29 n.26, 49, the public recognition and renown of the Cuban Cohiba in the United States (the fifth *du Pont* factor), and CT’s Eighth Ground for Cancellation (section 14(3); 15 U.S.C. § 1604(3), misrepresentation of source, or permitting others to misrepresent source, as to which the renown and reputation of the mark in the U.S. is relevant, *see, e.g., The Coca-Cola Co. v. Meenaxi Enter., Inc.*, 2021 USPQ2d 709 (TTAB 2021)).

This objection also should be overruled as it goes to the weight of the testimony and, in situations such as this, the Board admits the evidence and decides what weight it deserves. *See* CT’s Response to GC’s Evidentiary Objection No. 1.

Babot Declaration			
<u>GC's Description</u>	<u>GC's Citation to TTABVUE No.</u>	<u>GC's Objection</u>	<u>GC's Identification of Pages Where CT Cites to Evidence in its Trial Brief</u>
Paragraph 16-17 Babot's statements of CT's sales statistics for markets within and outside Cuba (excluding U.S.).	139 TTABVUE 29-30, 31 at ¶¶ 16-17, 23.	FRE 401, 403 – Relevancy; Undue Prejudice if Considered for the Truth of The Matter Asserted. FRE 602 / 701(a) – Lack of Foundation; Speculative Opinion Testimony.	365 TTABVUE 27, 33, 46-47

RESPONSE:a. FRE 401, 403

Paragraphs 16 and 17, together with Paragraph 15, of Mr. Babot's Declaration is relevant to show CT's intention to sell the Cuban Cohiba cigar in the United States as soon as U.S. law permits, the public recognition and renown of the Cuban Cohiba in the United States (the fifth *du Pont* factor) (Mr. Babot testified, based on, *inter alia*, his experience in Habanos, S.A.'s Commercial Department, as its Director of Operational Marketing, Director of International Markets, International Sales Representative and President of Coprova, a French company that distributes Cuban cigars, including Cuban Cohiba cigars, [REDACTED])

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED] and CT's Eighth Ground for

⁸ [REDACTED]

Cancellation (section 14(3); 15 U.S.C. § 1604(3), misrepresentation of source, or permitting others to misrepresent source, as to which the renown and reputation of the mark in the U.S. is relevant, *see, e.g., The Coca-Cola Co. v. Meenaxi Enter., Inc.*, 2021 USPQ2d 709 (TTAB 2021)).

b. FRE 602 / 701(a)

Mr. Babot’s testimony neither is speculative nor does it lack foundation; rather, he bases his testimony on Habanos, S.A. business records for sales that he accessed on Habanos, S.A. computer system—that is, sales records made at or near the time by someone with knowledge, that were kept in the course of a regularly conducted activity of Habanos, S.A.’s business, and the making these sales records was a regular practice of Habanos, S.A. 359 TTABVUE 282-291 (255:19-264:18). “[S]ales information from Cohiba is part of the daily information that” Habanos, S.A.’s Operational Marketing Department has. *Id.* at 66-67 (65:23-66:19). GC cites to 359 TTABVUE at 21:13-23:23; 58:13-17; 57:3- 58:4; 59:11-60:14; 67:11-69:18 to support its assertion that Mr. Babot “could not even provide rough approximations of CT’s sales at his discovery deposition,” 367 TTABVUE 77, but none of these pages support GC’s claim.

6.

Babot Declaration			
<u>GC’s Description</u>	<u>GC’s Citation to TTABVUE No.</u>	<u>GC’s Objection</u>	<u>GC’s Identification of Pages Where CT Cites to Evidence in its Trial Brief</u>
<p>Paragraph 18-19</p> <p>“From my contacts with both distributors and retailers of COHIBA, I know that COHIBA has been available in the most prestigious and well-known tobacco shops throughout the world.”</p> <p>“...I am therefore able to determine that, currently, the Cuban COHIBA cigar is being sold in the duty-free market in more than 70 countries, including: Germany, Saudi Arabia, Argentina, Austria, Belgium, Brazil, Canada, Chile, China, Colombia, Costa Rica,</p>	<p>139 TTABVUE 30 at ¶¶ 18-19.</p>	<p>FRE 401 – Relevancy</p>	<p>365 TTABVUE 47⁹</p>

⁹ CT assumes this is another typographical error and GC intended to cite 365 TTABVUE 49 n.59, as that is the only page in which CT relies upon this portion of Babot’s Declaration.

Denmark, United Arab Emirates, Spain, France, Italy, Japan, Mexico, Portugal, the Dominican Republic, Russia, Sweden and Switzerland.”			
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RESPONSE:

This testimony, together with the other testimony in 139 TTABVUE 30-41 (cited on 365 TTABVUE 47 n.59), is relevant to show CT’s intention to sell the Cuban Cohiba cigar in the United States as soon as U.S. law permits. 365 TTABVUE 29 n.26, 49. It is also relevant to show the public recognition and renown of the Cuban Cohiba in the United States (the fifth *du Pont* factor), CT’s prior analogous use of the Cuban Cohiba in the United States (CT’s Sixth Ground for Cancellation) and CT’s Eighth Ground for Cancellation (section 14(3); 15 U.S.C. § 1604(3), misrepresentation of source, or permitting others to misrepresent source, as to which the renown and reputation of the mark in the U.S. is relevant, *see, e.g., The Coca-Cola Co. v. Meenaxi Enter., Inc.*, 2021 USPQ2d 709 (TTAB 2021)).

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

This objection also should be overruled as it goes to the weight of the testimony and, in situations such as this, the Board admits the evidence and decides what weight it deserves. *See* CT’s Response to GC’s Evidentiary Objection No. 1.

7.

Babot Declaration			
<u>GC’s Description</u>	<u>GC’s Citation to TTABVUE No.</u>	<u>GC’s Objection</u>	<u>GC’s Identification of Pages Where CT Cites to Evidence in its Trial Brief</u>
Paragraph 20-22	139 TTABVUE	FRE 401 – Relevancy	365 TTABVUE 27, 33, 46, 47

<p>“In Paragraphs 20-22 Babot provides general testimony that Cuban Cohibas are sold at La Casa del Habano or Punto Oficial de Venta locations in Cuba and that those locations, including near the airports, [REDACTED]”</p>	<p>30-31 at ¶¶ 20-22.</p>		
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RESPONSE:

CT’s citation to 139 TTABVUE 30 at 365 TTABVUE 48 n.59 is a reference to Paragraph 19, not Paragraphs 20-21. Paragraph 19 is testimony about the widespread sale of the Cuban Cohiba in duty free stores throughout the world and is relevant to show CT’s intention to sell the Cuban Cohiba cigar in the United States as soon as U.S. law permits. 365 TTABVUE 29 n.26, 49. However, Mr. Babot’s testimony in Paragraphs 20-22, which concerns sales of the Cuban Cohiba in places [REDACTED] is also relevant to show CT’s intention to sell the Cuban Cohiba cigar in the United States as soon as U.S. law permits, the public recognition and renown of the Cuban Cohiba in the United States (the fifth *du Pont* factor), and CT’s Eighth Ground for Cancellation (section 14(3); 15 U.S.C. § 1604(3), misrepresentation of source, or permitting others to misrepresent source, as to which the renown and reputation of the mark in the U.S. is relevant, *see, e.g., The Coca-Cola Co. v. Meenaxi Enter., Inc.*, 2021 USPQ2d 709 (TTAB 2021)).

[REDACTED], Mr. Babot’s testimony, based on his personal knowledge (including personal knowledge in his professional positions within Habanos, S.A., *see supra* CT’s Response to GC Evidentiary Objection No. 5) [REDACTED]

[REDACTED] is entitled to substantial weight.

This objection should be overruled as it goes to the weight of the testimony and, in situations such as this, the Board admits the evidence and decides what weight it deserves. *See* CT’s Response to GC’s Evidentiary Objection No. 1.

CT’s citation to 139 TTABVUE 31 at 365 TTABVUE 29 is a reference to Paragraphs 24-25 *et*

seq., not Paragraphs 21-22. Paragraphs 24-25 *et seq.* are relevant to show CT’s intention to sell the Cuban Cohiba cigar in the United States as soon as U.S. law permits, the public recognition and renown of the Cuban Cohiba in the United States (the fifth *du Pont* factor), and CT’s Eighth Ground for Cancellation (section 14(3); 15 U.S.C. § 1604(3), misrepresentation of source, or permitting others to misrepresent source, as to which the renown and reputation of the mark in the U.S. is relevant, *see, e.g., The Coca-Cola Co. v. Meenaxi Enter., Inc.*, 2021 USPQ2d 709 (TTAB 2021)).

CT’s citation to 139 TTABVUE 31 at 365 TTABVUE 35, 48 and 49, is a reference to Paragraph 25 *et seq.*, not Paragraphs 21-22. Paragraph 25 *et seq.* is relevant to show CT’s intention to sell the Cuban Cohiba cigar in the United States as soon as U.S. law permits, the public recognition and renown of the Cuban Cohiba in the United States (the fifth *du Pont* factor), CT’s prior analogous use of the Cuban Cohiba in the United States (CT’s Sixth Ground for Cancellation) and CT’s Eighth Ground for Cancellation (section 14(3); 15 U.S.C. § 1604(3), misrepresentation of source, or permitting others to misrepresent source, as to which the renown and reputation of the mark in the U.S. is relevant, *see, e.g., The Coca-Cola Co. v. Meenaxi Enter., Inc.*, 2021 USPQ2d 709 (TTAB 2021)).

8.

Babot Declaration			
<u>GC’s Description</u>	<u>GC’s Citation to TTABVUE No.</u>	<u>GC’s Objection</u>	<u>GC’s Identification of Pages Where CT Cites to Evidence in its Trial Brief</u>
Paragraph 25 Assertion by Babot that “Since at least May 2003, the Cuban COHIBA cigar was so well-known and had built up such fame in the U.S....”	139 TTABVUE 31-32 at ¶ 25.	FRE 602 – Lack of Personal Knowledge / Foundation. FRE 401 – Relevancy	365 TTABVUE 27, 32, 33, 46, 47

RESPONSE:

Mr. Babot did not “testif[y] on cross-examination that his statement is speculation,” as GC claims. 367 TTABVUE 78. GC cites 359 TTABVUE 68:15-69:18, 70:17-74:23 and 78:13-93:18 to support this false characterization; however, on these pages, Mr. Babot merely acknowledges that he is not in charge of

sales of the Cuban Cohiba and [REDACTED]

[REDACTED] That is not an acknowledgement that his testimony as to the fame of the Cuban Cohiba in the United States is speculation.

Indeed, this testimony is well-founded, contrary to GC's assertion otherwise. [REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

GC's relevancy objection is not well-founded. First, this testimony is probative of CT's intention to sell the Cuban Cohiba cigar in the United States as soon as U.S. law permits, the public recognition and renown of the Cuban Cohiba in the United States (the fifth *du Pont* factor), CT's prior analogous use of the Cuban Cohiba in the United States (section 2(d), CT's Sixth Ground for Cancellation) and CT's Eighth Ground for Cancellation (section 14(3); 15 U.S.C. § 1604(3), misrepresentation of source, or permitting others to misrepresent source, as to which the renown and reputation of the mark in the U.S. is relevant, *see, e.g., The Coca-Cola Co. v. Meenaxi Enter., Inc.*, 2021 USPQ2d 709 (TTAB 2021)).

Second, GC does not contest in its Trial Brief that the Cuban Cohiba is famous for purposes of the fifth *du Pont* factor; GC only asserts that the Board has rejected the "well-known marks" doctrine in *Sun Hee Jung v. Magic Snow*, 124 USPQ2d 1041 (TTAB 2017), in which the Board only held that the party in that case could not establish priority based on fame in Korea and efforts taken in Korea.

GC's objections also should be overruled as they go to the weight of the testimony and, in situations such as this, the Board admits the evidence and decides what weight it deserves. *See* CT's Response to GC's Evidentiary Objection No. 1.

9.

Babot Declaration			
<u>GC's Description</u>	<u>GC's Citation to TTABVUE No.</u>	<u>GC's Objection</u>	<u>GC's Identification of Pages Where CT Cites to Evidence in its Trial Brief</u>
Paragraph 27 [REDACTED]	139 TTABVUE 32-33 at ¶ 27	FRE 403 – Irrelevant and Prejudicial Evidence.	365 TTABVUE 27, 32, 33, 46, 47

RESPONSE:

[REDACTED]

[REDACTED]

[REDACTED].

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

This testimony is relevant to show CT's intention to sell the Cuban Cohiba cigar in the United States as soon as U.S. law permits, the public recognition and renown of the Cuban Cohiba in the United States (the fifth *du Pont* factor), CT's prior analogous use of the Cuban Cohiba in the United States (section 2(d), CT's Sixth Ground for Cancellation) and CT's Eighth Ground for Cancellation (section 14(3); 15 U.S.C. § 1604(3), misrepresentation of source, or permitting others to misrepresent source, as to which the renown and reputation of the mark in the U.S. is relevant, *see, e.g., The Coca-Cola Co. v. Meenaxi Enter., Inc.*, 2021 USPQ2d 709 (TTAB 2021)).

These objections also should be overruled as they go to the weight of the testimony and, in situations such as this, the Board admits the evidence and decides what weight it deserves. *See* CT's Response to GC's Evidentiary Objection No. 1.

10.

Babot Declaration			
<u>GC's Description</u>	<u>GC's Citation to TTABVUE No.</u>	<u>GC's Objection</u>	<u>GC's Identification of Pages Where CT Cites to Evidence in its Trial Brief</u>
Paragraph 32 Babot's assertions as to press mentioned arising from XVIII Festival	139 TTABVUE 35-36 at ¶ 32	FRE 401 – Relevancy	365 TTABVUE 27, 33, 46

RESPONSE:

GC mischaracterizes Babot's testimony in its objection. It is not true that Mr. Babot "could not identify how many among the Cohiba press mentions he cites were in publications read by US cigar consumers," as GC claims. 367 TTABVUE 79. GC never asked him whether he could identify this figure.

In any event, it is obvious from his declaration itself, [REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED].

This testimony is relevant to show CT's intention to sell the Cuban Cohiba cigar in the United States as soon as U.S. law permits, the public recognition and renown of the Cuban Cohiba in the United States (the fifth *du Pont* factor), CT's prior analogous use of the Cuban Cohiba in the United States (section 2(d), CT's Sixth Ground for Cancellation) and CT's Eighth Ground for Cancellation (section 14(3); 15 U.S.C. § 1604(3), misrepresentation of source, or permitting others to misrepresent source, as to which the renown and reputation of the mark in the U.S. is relevant, *see, e.g., The Coca-Cola Co. v. Meenaxi Enter., Inc.*, 2021 USPQ2d 709 (TTAB 2021)).

This objection also should be overruled as it goes to the weight of the testimony and, in situations such as this, the Board admits the evidence and decides what weight it deserves. *See* CT's Response to

11.

Babot Declaration			
<u>GC's Description</u>	<u>GC's Citation to TTABVUE No.</u>	<u>GC's Objection</u>	<u>GC's Identification of Pages Where CT Cites to Evidence in its Trial Brief</u>
Paragraph 42 Statement that Habanos, S.A. "developed a website, www.habanos.com , to promote Cuban cigars, including most prominently the Cuban COHIBA cigar"	139 TTABVUE 38-39 at ¶ 42	FRE 701/801(d)(1)(A) Unsupported and Contradicted Opinion Testimony FRE 802/901 Hearsay; Authenticity	365 TTABVUE 46, 47

RESPONSE:

Babot's testimony that Habanos, S.A. "developed a website, www.habanos.com, to promote Cuban cigars, including most prominently the Cuban COHIBA cigar" is not unsupported or contradicted, as GC claims. 367 TTABVUE 79-80. First, contradicted testimony is not inadmissible. If anything, it goes to the weight of the evidence.

Furthermore, it is not unsupported or contradicted. In his declaration, Mr. Babot testified that the Cuban Cohiba "is featured prominently on this website's homepage, [with the Cuban Cohiba] being one of only six Cuban brands of cigars mentioned on the homepage; there is a link on the homepage to the www.cohiba50.com website; there is detailed information on the COHIBA brand on the www.habanos.com website; and there are numerous articles and videos about COHIBA on the website as well. Habanos, S.A. created this website (www.habanos.com) [REDACTED]

[REDACTED] 139 TTABVUE 38.

Even though the www.habanos.com website also shows five other trademarks on the homepage, the Cuban Cohiba was placed “in first place” which “states the prominence and mark positioning of the Cohiba trademark,” as Babot testified on cross-examination. 359 TTABVUE 116 (116:11-20); *see also id.* at 112:18-116:20 (repeating that placing Cohiba trademark first represents the prominence and positioning of the mark). Mr. Babot did not testify that each of these marks is “give ‘equal’ prominence,” as GC claims, 367 TTABVUE 79-80; rather, he merely recognized that each mark is the same size on the website. 359 TTABVUE 114-15113:19-114:9).

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED] *see The Travelers Indem. Co.*, Cancellation No. 9206739, 2020 WL 3971247, at *5 (July 10, 2020) (objection to Google Analytics report overruled; “objection to foundation or authentication raised for the first time in a trial brief is untimely because the party offering the testimony (whether by deposition, affidavit or declaration) does not have the opportunity to cure the alleged defect.”) (non-precedential); *Chase Manhattan Bank, N.A. v. Life Care Servs. Corp.*, 227 USPQ 389, 391 (TTAB 1985); *accord Moke Am. LLC v. Moke USA, LLC*, 2020 USPQ2d 10400, at *5 (TTAB 2020) (sales records admitted as hearsay exception under Fed. R. Evid. 803(6) because lack of foundation objection was an untimely procedural objection only raised in brief); *Nahshin v. Prod. Source Int’l, LLC*, 107 USPQ2d 1257, 1259 (TTAB 2013) *aff’d*, 112 F. Supp. 3d 383 (E.D. Va. 2015) (“We find that all of respondent’s objections to responses and documents based on asserted lack of authentication are untimely and waived.”).

[REDACTED]

[REDACTED] *See, e.g., Website Broker, Inc. v. Legalguru, LLC*, Cancellation No. 92057736, 2016 WL 247201, at *6 (TTAB Jan. 4, 2016).

[REDACTED]

[REDACTED]

12.

Babot Declaration			
<u>GC's Description</u>	<u>GC's Citation to TTABVUE No.</u>	<u>GC's Objection</u>	<u>GC's Identification of Pages Where CT Cites to Evidence in its Trial Brief</u>
Paragraph 43 Babot's direct testimony concerning [REDACTED]	139 TTABVUE 39 at ¶ 43	FRE 401, 403, 602 – Relevance; Unduly Prejudicial; Lack of Foundation FRE 802, 901 – Hearsay; Authenticity.	365 TTABVUE 27, 46, 47

RESPONSE:

GC has waived its lacks foundation and hearsay/authenticity objections because GC never raised these objections during cross-examination of Mr. Babot and so CT has had no ability to cure. [REDACTED]

[REDACTED] see CT's
Response to GC's Evidentiary Objection No. 11.

[REDACTED]. See, e.g., *Website Broker, Inc. v. Legalguru, LLC*, Cancellation No. 92057736, 2016 WL 247201, at *6 (TTAB Jan. 4, 2016).

As to GC's relevance and prejudice objections, Mr. Babot testified that the Cuban Cohiba features more "notably" than other brands on the Habanos Twitter account. 259 TTABVUE 136 (136:6-13); see also 226 TTABVUE 6-8 (testimony of Christina Licata detailing prominence of the Cuban Cohiba on this

Twitter account). [REDACTED]

[REDACTED]

[REDACTED]

This testimony is relevant as probative of CT's intention to sell the Cuban Cohiba cigar in the United States as soon as U.S. law permits, the public recognition and renown of the Cuban Cohiba in the United States (the fifth *du Pont* factor), CT's prior analogous use of the Cuban Cohiba in the United States (section 2(d), CT's Sixth Ground for Cancellation) and CT's Eighth Ground for Cancellation (section 14(3); 15 U.S.C. § 1604(3), misrepresentation of source, or permitting others to misrepresent source, as to which the renown and reputation of the mark in the U.S. is relevant, *see, e.g., The Coca-Cola Co. v. Meenaxi Enter., Inc.*, 2021 USPQ2d 709 (TTAB 2021)).

GC's objection that some of these followers may be fake accounts or "bots" is pure speculation, unsupported by any evidence in this case.

These objections should be overruled as they go to the weight of the testimony and, in situations such as this, the Board admits the evidence and decides what weight it deserves. *See* CT's Response to GC's Evidentiary Objection No. 1.

13.

Babot Declaration			
<u>GC's Description</u>	<u>GC's Citation to TTABVUE No.</u>	<u>GC's Objection</u>	<u>GC's Identification of Pages Where CT Cites to Evidence in its Trial Brief</u>
Paragraph 44 Testimony concerning [REDACTED]	139 TTABVUE 39-40 at ¶ 44	FRE 401, 403, 602 – Relevancy; Unduly Prejudicial; Lack of Foundation FRE 802, 901 – Hearsay; Authenticity.	365 TTABVUE 27, 34, 46, 47

RESPONSE:

GC has waived its lacks foundation and hearsay/authenticity objections because GC never raised

these objections during cross-examination and so CT has had no ability to cure. *See* CT's Responses to GC's Evidentiary Objection Nos. 11 and 12.

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED] *See, e.g., Website Broker, Inc. v. Legalguru, LLC*, Cancellation No. 92057736, 2016 WL 247201, at *6 (TTAB Jan. 4, 2016).

[REDACTED]

[REDACTED]. 139 TTABVUE 39, ¶ 44.

As to GC's relevance and prejudice objections, Mr. Babot testified that "many" of these posts on the Habanos Instagram account are of the Cuban Cohiba, even if all of them are not. 259 TTABVUE 139 (139:1-7); *see also* 226 TTABVUE 8-9 (testimony of Christina Licata detailing prominence of the Cuban Cohiba on this Instagram account). [REDACTED]

[REDACTED]

[REDACTED]

This testimony is relevant as probative of CT's intention to sell the Cuban Cohiba cigar in the United States as soon as U.S. law permits, the public recognition and renown of the Cuban Cohiba in the United States (the fifth *du Pont* factor), CT's prior analogous use of the Cuban Cohiba in the United States (section 2(d), CT's Sixth Ground for Cancellation) and CT's Eighth Ground for Cancellation (section 14(3); 15 U.S.C. § 1604(3), misrepresentation of source, or permitting others to misrepresent source, as to which the renown and reputation of the mark in the U.S. is relevant, *see, e.g., The Coca-Cola Co. v. Meenaxi Enter., Inc.*, 2021 USPQ2d 709 (TTAB 2021)).

GC's objection that some of these followers may be fake accounts, "bots" or non-smokers is pure speculation, unsupported by any evidence in this case. Moreover, one can be a non-smoker and still a cigar consumer, purchasing cigars as a gift. Indeed, GC's Cohiba is a "heavily gifted cigar brand." 223

TTABVUE 14 (¶ 49).

These objections should be overruled as they go to the weight of the testimony and, in situations such as this, the Board admits the evidence and decides what weight it deserves. *See* CT's Response to GC's Evidentiary Objection No. 1.

14.

Babot Declaration			
<u>GC's Description</u>	<u>GC's Citation to TTABVUE No.</u>	<u>GC's Objection</u>	<u>GC's Identification of Pages Where CT Cites to Evidence in its Trial Brief</u>
Paragraph 47 Assertion that [REDACTED] [REDACTED]	139 TTABVUE 39-40 at ¶ 44	FRE 401 – Relevancy	365 TTABVUE 27, 34, 46, 47

RESPONSE:

This testimony is relevant to show CT's intention to sell the Cuban Cohiba cigar in the United States as soon as U.S. law permits, the public recognition and renown of the Cuban Cohiba in the United States (the fifth *du Pont* factor), CT's prior analogous use of the Cuban Cohiba in the United States (section 2(d), CT's Sixth Ground for Cancellation) and CT's Eighth Ground for Cancellation (section 14(3); 15 U.S.C. § 1604(3), misrepresentation of source, or permitting others to misrepresent source, as to which the renown and reputation of the mark in the U.S. is relevant, *see, e.g., The Coca-Cola Co. v. Meenaxi Enter., Inc.*, 2021 USPQ2d 709 (TTAB 2021)).

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

This objection also should be overruled as it goes to the weight of the testimony and, in situations such as this, the Board admits the evidence and decides what weight it deserves. *See* CT's Response to

15.

Babot Declaration			
<u>GC's Description</u>	<u>GC's Citation to TTABVUE No.</u>	<u>GC's Objection</u>	<u>GC's Identification of Pages Where CT Cites to Evidence in its Trial Brief</u>
Paragraphs 49-62 Babot's testimony "summarize[s] some elements of damage" to CT and contains legal conclusions concerning the fame of CT's Cohiba, the confusion that might occur if the embargo ended, speculations about what U.S. consumers would believe if the embargo ended concerning the likelihood of confusion.	139 TTABVUE 41-45 at ¶¶ 49-62	FRE 701(a) – Speculative Opinion Testimony On Likelihood of Confusion and Legal Conclusions	365 TTABVUE 27, 33, 34

RESPONSE:

Contrary to GC's objection, Mr. Babot only explains his lay opinion of some of CT's damages caused by GC's Cohiba registrations at the USPTO. He explicitly testifies that he does "not attempt to discuss" "legal matters." 139 TTABVUE 41, at ¶ 49.

Mr. Babot does not need to provide survey, studies or data to support his lay opinion, as GC asserts.

This testimony is rationally based [REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

Lightning Lube, Inc. v. Witco Corp., 4 F.3d 1153, 1175 (3d Cir. 1993) (lay opinion on damages allowed because of witness's "knowledge and participation in the day-to-day affairs of" business); 2000 Advisory Comm. Notes, Fed. R. Evid. 701 ("most courts have permitted" officer "to testify" as to damages (projected profits of the business) "because of the particularized knowledge that the witness has by virtue of his or her position in the business") (citing *Lightning Lube*).

None of the cases cited by GC stand for the proposition that a company's officer cannot provide

lay opinion as to damages based on his or her knowledge and participation in the business. Indeed, in *Innovation L. Grp., Ltd.*, relied on by GC, the Board *rejected* applicant's inadmissibility objection and *admitted* the testimony as lay opinion, without considering any legal conclusion contained therein. Opposition No. 91202418, 29 TTABVUE 5, 2013 WL 11247273, at *2 (TTAB June 10, 2013).

In addition, GC never identifies how Mr. Babot's testimony as to damages, Paragraph 50, is speculative opinion or a legal conclusion.

This objection also should be overruled as it goes to the weight of the testimony and, in situations such as this, the Board admits the evidence and decides what weight it deserves. *See* CT's Response to GC's Evidentiary Objection No. 1.

16.

Declaration of Lisset Garcia Fernandez			
<u>GC's Description</u>	<u>GC's Citation to TTABVUE No.</u>	<u>GC's Objection</u>	<u>GC's Identification of Pages Where CT Cites to Evidence in its Trial Brief</u>
Paragraphs 28-D, 28-E, 28-F, 28-G. 28-H	141 TTABVUE 35-36 at ¶¶ 28(d)-(h)	FRE 401 – Relevancy	365 TTABVUE 47

RESPONSE:

This testimony concerning the multiple opposition and trademark infringement proceedings CT has brought over the years to protect its valuable COHIBA trademark and trade dress is relevant to show CT's intention to sell the Cuban Cohiba cigar in the United States as soon as U.S. law permits, the public recognition and renown of the Cuban Cohiba in the United States (the fifth *du Pont* factor), CT's prior analogous use of the Cuban Cohiba in the United States (section 2(d), CT's Sixth Ground for Cancellation) and CT's Eighth Ground for Cancellation (section 14(3); 15 U.S.C. § 1604(3), misrepresentation of source, or permitting others to misrepresent source, as to which the renown and reputation of the mark in the U.S. is relevant, *see, e.g., The Coca-Cola Co. v. Meenaxi Enter., Inc.*, 2021 USPQ2d 709 (TTAB 2021)).

This objection also should be overruled as it goes to the weight of the testimony and, in situations

such as this, the Board admits the evidence and decides what weight it deserves. *See* CT’s Response to GC’s Evidentiary Objection No. 1.

17.

Declaration of Brenna Murdock			
<u>GC’s Description</u>	<u>GC’s Citation to TTABVUE No.</u>	<u>GC’s Objection</u>	<u>GC’s Identification of Pages Where CT Cites to Evidence in its Trial Brief</u>
Paragraph 13-14 and Annexes 4-5. Annex 4 provides the results of a Google search for the word Cohiba. Annex 5 provides the Google results for the term “cohiba cigar.”	167 TTABVUE 5-6, 229-304	FRE 401, 602, 802 – Relevancy; Lack of Foundation; Hearsay	365 TTABVUE 42, 44, 46

RESPONSE:

GC has waived its objection that this testimony lacks foundation because GC chose not to cross-examine the witness. HC has also waived its hearsay objection, as that objection is based on its lack of foundation objection. GC has never raised these objections, either during cross-examination or otherwise. Therefore, CT has not been able to cure. *Supra* CT’s Response to GC’s Evidentiary Objection No. 11.

GC’s argument that “Google search results are generally inadmissible without providing the complete articles” is mislaid. The witness did *not* just submit her Google search results; rather, she downloaded and submitted as evidence the webpage for each hit from her search results, therefore providing “greater context” making such evidence of “greater probative value.” *In re Thomas*, 79 USPQ2d 1021, 1026 (TTAB 2006); 167 TTABVUE 6 (¶14), 254-304.

Even Google search results themselves without the “greater context” provided here are admissible. *In re Bayer Aktiengesellschaft*, 82 USPQ2d 1828, 1833 (Fed. Cir. 2007) (Google search results not excluded).

The Board did not, as GC asserts, hold that “Google hits without any context for the hits are irrelevant” in *In re Thomas*, 79 USPQ2d 1021, 1026 (TTAB 2006). It held that, in order to show “number and nature of similar marks *in use* on *similar* goods” “[t]he number of Google hits for [a term for a product], without any context for the hits, is irrelevant.” Here, CT is not relying on the number of hits resulting from

a search for Cohiba. It relies on these results to show that there is likelihood of confusion, because here, unlike the cases GC cites, persons searching for “cohiba” will be directed to websites about both the GC and Cuban Cohiba and shown images of both the GC and Cuban Cohiba indicating a potential for confusion and engendering confusion, in addition to showing that both the GC and Cuban Cohiba are promoted in the same channels (third and twelfth *du Pont* factors).

They show that U.S. consumers searching for the term “Cohiba”: are directed to online cigar retailers some selling the Cuban Cohiba and others selling the GC Cohiba, 167 TTABVUE 255-56 (Google results), 262-67, 286-94, 3001-01 (three retailers selling Cuban Cohiba), 268-75, 276-79, 295-99, 302-04 (four retailers selling the GC Cohiba); are shown images of both the GC and Cuban Cohiba (and only images of these two cigars or cigar designs), even though images of the Cuban Cohiba are far more prevalent, 167 TTABVUE 239-253; and are shown “People also ask” questions such as “Are Cohiba cigars from Cuba?” (which response does not dispel any association confusion between GC and the Cuban Cohiba) and “What kind of cigars does Fidel Castro smoke?” (responding that “Cohiba is the flagship brand of Cuban cigars ...” 167 TTABVUE 230-31.

This evidence also is consistent with other evidence submitted in this proceeding. *See* 308 TTABVUE 2, 37-50, 309 TTABVUE 132-259, 310 TTABVUE 1-60 (Second Declaration of Susan Bailey showing search results, including linked websites, for search for “cuban cohiba” on Bing and Yahoo search engines, but linking to websites selling only GC’s Cohiba cigars).

There is no requirement that a witness must provide her or his search history, nor does GC cite to any authority supporting such a position. If GC thought that the witness’s search history affected her results, it could have cross-examined Ms. Murdock on this point or submitted testimony or evidence from another witness showing that it does. However, GC chose to do neither.

This testimony is also relevant to show the public recognition and renown of the Cuban Cohiba in the United States (the fifth *du Pont* factor) and CT’s Eighth Ground for Cancellation (section 14(3); 15 U.S.C. § 1604(3), misrepresentation of source, or permitting others to misrepresent source, as to which the renown and reputation of the mark in the U.S. is relevant, *see, e.g., The Coca-Cola Co. v. Meenaxi Enter.,*

Inc., 2021 USPQ2d 709 (TTAB 2021)).

GC's relevancy objection also should be overruled as it goes to the weight of the testimony and, in situations such as this, the Board admits the evidence and decides what weight it deserves. *See* CT's Response to GC's Evidentiary Objection No. 1.

18.

Declaration of Brenna Murdock			
<u>GC's Description</u>	<u>GC's Citation to TTABVUE No.</u>	<u>GC's Objection</u>	<u>GC's Identification of Pages Where CT Cites to Evidence in its Trial Brief</u>
Annex 16 provides the results of a Google search for the words "jay-z" and "cuba."	167 TTABVUE 375-383	FRE 401, 602, 802 – Relevancy; Lack of Foundation; Hearsay	N/A

RESPONSE:

CT does not cite to this testimony in its Trial or Rebuttal Briefs.

Nonetheless, this evidence is relevant, *inter alia*: to show the extent of potential confusion and GC's bad faith (twelfth and thirteenth *du Pont* factors) and CT's Eighth Ground for Cancellation (section 14(3); 15 U.S.C. § 1604(3), misrepresentation of source, or permitting others to misrepresent source, as to which the renown and reputation of the mark in the U.S. is relevant, *see, e.g., The Coca-Cola Co. v. Meenaxi Enter., Inc.*, 2021 USPQ2d 709 (TTAB 2021)). The famous musician Jay-Z co-developed a GC Cohiba-branded cigar that was launched a matter of months after Jay-Z and his equally famous musician wife, Beyonce, made a well-reported on trip to Cuba. *Compare* 167 TTABVUE 330-81 (articles reporting on Jay-Z and Beyonce's Spring 2013 trip to Cuba) *with* 217 TTABVUE 37-38, 612-45 (GC Cohiba brand co-developed with Jay-Z released in December 2013). Indeed, Jay-Z's much publicized travel to Cuba right before the release of the co-developed GC Cohiba cigar caused actual confusion. *See* 365 TTABVUE 47 (citing numerous U.S. consumers commenting on Jay-Z's post announcing the release of his co-developed GC Cohiba cigar by stating "that's why" Jay-Z went to Cuba).

In any event, GC has waived its objection that this testimony lacks foundation or is hearsay because

GC chose not to cross-examine the witness. It has never raised these objections, either during cross-examination or otherwise. Therefore, CT has not had ability to cure. *Supra* CT's Response to GC's Evidentiary Objection No. 11.

These objections also should be overruled as they go to the weight of the testimony and, in situations such as this, the Board admits the evidence and decides what weight it deserves. *See* CT's Response to GC's Evidentiary Objection No. 1.

Also, GC's objections are otherwise unfounded. *See* CT Response to GC's Evidentiary Objection No. 17.

19.

Declaration of David Girolami			
<u>GC's Description</u>	<u>GC's Citation to TTABVUE No.</u>	<u>GC's Objection</u>	<u>GC's Identification of Pages Where CT Cites to Evidence in its Trial Brief</u>
Declaration and Annex A thereto	167 TTABVUE 433-436	FRE 602, 701(a), 802 – Lack of Foundation; Hearsay; Unqualified Opinion Evidence	365 TTABVUE 42

RESPONSE:

GC has waived its objections that this testimony lacks foundation because GC chose not to cross-examine the witness. It has never raised this objection, either during cross-examination or otherwise, nor does GC explain how this testimony lacks foundation. *Supra* CT's Response to GC's Evidentiary Objection No. 11.

In any event, this testimony is admissible under either the state of mind or the present sense impression exception to the hearsay rule. The statements of specialty cigar store sales associates are not being offered for the truth of the matter, that is, that the GC Cohiba cigar are Cuban or the Cuban Cohiba brand, but rather for whether U.S. consumers frequently ask this question. *See, e.g.*, Fed. R. Evid. 803(1), (3); *Dan Foam Aps v. Sleep Innovations, Inc.*, 106 USPQ2d 1939, 1943-44 (TTAB 2013) (transcripts of

conversations between unidentified third-party representative and customers allowed as evidence of actual confusion under present sense or state of mind hearsay exceptions, even though neither the representative nor the customers testified); *Levi Strauss & Co. v. R. Josephs Sportswear Inc.*, 28 USPQ2d 1464, 1466 (TTAB 1993) (testimony that presidents of various other companies believed a term was the trademark of the other party and they were concerned about being sued allowed under the state of mind exception, as it was not offered for the truth of the matter); *Edom Laboratories, Inc. v. Llichter*, 102 USPQ2d 1546, 1552 (TTAB 2012) (testimony from employee that she received 10-15 calls where caller either asked for the opposing party's mark or ask about the relationship, allowed under state of mind hearsay exception to show actual confusion; evidence used to "buttress" likelihood of confusion finding); *Posi Lock Puller, Inc. v. Swenco Products, Inc.*, Opposition No. 108697, 2001 WL 1345042, at *6 (TTAB Oct. 29, 2001) ("opposer's employees' testimony is not so vague as to be inadmissible, we overrule applicant's hearsay") (non-precedential); *Tiger Electronics, Ltd. v. Marlene Davis*, Cancellation No. 31336, 2001 WL 1256353, at *6 (TTAB Oct. 17, 2001) (allegation of double hearsay overruled; not offered for the truth of the matter).

Although GC has argued that CT is obligated to produce the consumers themselves to show actual confusion, there is no such requirement when, as here, instances of confusion "occur and in such large numbers and frequency that there can be no common denominator for them other than the similarities between the marks themselves." *The Finance Company of America v. Bankamerica Corporation*, 205 U.S.P.Q. 1016, 1035 (TTAB 1979). As the Board went on to explain in *The Finance Company of America*:

with the many occurrences of misdirected mail, telephone calls, and the like testified to and documented by opposer's witnesses, a question arises as to whether applicant would have been satisfied with the calling of a representative few individuals as witnesses or would applicant have charged opposer with calling only those individuals who would support its position. . . . No matter how these matters occurred, whether from listings in the telephone directories, errors by Postal Service employees, or the like, the fact is that they did occur and in such large numbers and frequency that there can be no common denominator for them other than the similarities between the marks themselves.

Id. Similarly here, there are so many instances of actual confusion, including those reported by GC's own former President and long-time Vice-President of Marketing, GC's own Cohiba marketing managers, GC's own outside marketing agency as well as in various internal GC documents over many years, including

immediately before trial, that the only common denominator can be that there is actual confusion between the two marks. 365 TTABVUE 43-48. And, just as the Board thought might be the case for the applicant in *The Finance Company*, GC no doubt would have not been satisfied with CT's calling only a handful of witnesses.

The logical inference the Board can and should draw from such frequent questions by U.S. cigar consumers about whether GC's Cohiba cigar is the Cuban Cohiba cigar is that there are U.S. cigar consumers that: are actually confused between the Cuban and GC Cohiba; and do not know that the U.S. embargo prohibits the sale of Cuban cigars in the United States.

Neither case cited by GC is relevant. In *Rocket Trademarks Pty Ltd. v. Phard S.p.A.*, the party offered the hearsay testimony—whether certain items were actually for sale or in stock based on statements from store employees—for the truth of the matter asserted. The Board explicitly contrasted that case with one in which testimony is merely offered for what a party heard and not the truth of the matter. 98 USPQ2d 1066, 1072 (TTAB 2011). In *Collegepath, Inc. v. Christine L. Sylvain*, No. 91248169, 2021 WL 3784236, at *19 (TTAB 2021) (non-precedential), the Board excluded an undated letter “To whom it may concern”, introduced as an exhibit to the testimony of an individual unconnected to the letter, because it was offered for the truth of the matter asserted.

Additionally, GC is judicially estopped from asserting this objection as GC itself relied on similar testimony in obtaining a permanent injunction in a separate trademark infringement action concerning its COHIBA registrations that it prosecuted against a third party. 169 TTABVUE 12-13 (¶¶ 30-31) (evidence from *General Cigar Co., Inc. vs. Cohiba Caribbean's Finest, Inc., et al.*, Case No. 2006-cv-00575, U.S. District Court for the District of Nevada, in which GC asserted actual confusion based on testimony by a cigar store owner that his sales staff received questions from consumers about whether yellow band COHIBA cigars were related to General Cigar's COHIBA).

Additionally, the statement by one specialty cigar store sales associate that “there is confusion between” the GC and Cuban Cohiba is proper lay opinion, under Fed. R. Evid. 701, rationally based on the sales associate's perception.

Mr. Girolami does not provide opinion evidence; he merely recounts his experience interacting with specialty cigar store salespersons in the United States, helpful to clearly determining a fact in issue and not based on scientific, technical, or other specialized knowledge within the scope of Fed. R. Evid. 702.

20.

Declaration of Tom Bailey			
<u>GC's Description</u>	<u>GC's Citation to TTABVUE No.</u>	<u>GC's Objection</u>	<u>GC's Identification of Pages Where CT Cites to Evidence in its Trial Brief</u>
Declaration and Annex A thereto	167 TTABVUE 462-465	FRE 602, 701(a), 802 – Lack of Foundation; Hearsay; Unqualified Opinion Evidence	365 TTABVUE 42

RESPONSE:

GC has waived its objection that this testimony lacks foundation because GC chose not to cross-examine the witness. It has never raised this objection, either during cross-examination or otherwise, nor does GC explain how this testimony lacks foundation. *See* CT's Response to GC's Evidentiary Objection No. 11.

This testimony is also admissible for the same reasons stated in CT's Response to GC's Evidentiary Objection No. 19, *supra*—namely, it is admissible under either the state of mind or the present sense impression exceptions to the hearsay rule. The statements of specialty cigar store sales associates are not being offered for the truth of the matter, that is, that the GC Cohiba cigar is the Cuban Cohiba cigar, but rather for whether U.S. consumers frequently ask this question. Additionally, GC is judicially estopped from asserting this objection.

Mr. Bailey does not provide opinion evidence; he merely recounts his experience interacting with specialty cigar store salespersons in the United States.

Additionally, the statement by one specialty cigar store sales associate that “other people do get confused” about whether the GC Cohiba was Cuban “from time to time” is proper lay opinion, under Fed.

R. Evid. 701, rationally based on the sales associate's perception.

In addition to stating that U.S. cigar consumers entering these stores ask whether GC's Cohiba cigar is from Cuba or the Cuban Cohiba cigar, 365 TTABVUE 44, one of the clerks also informed Mr. Bailey that if he wanted to buy Cuban cigars in the United States, he could do so online. Another clerk informed Mr. Bailey that the same company made the Cuban, Dominican and Nicaraguan Cohiba cigars. 167 TTABVUE 465. These statements are not offered for the truth of the matters—in fact, it is illegal for someone in the United States to purchase Cuban cigars online and GC does not make the Cuban cigar—but rather for the issue of consumer confusion as to U.S. embargo restrictions and the potential for actual confusion.

As with CT's Response to GC's Evidentiary Objection No. 19, the logical inference the Board can and should draw from such frequent questions by U.S. cigar consumers about whether GC's Cohiba cigar is the Cuban Cohiba cigar as well as the cigar store salespersons' responses is that there are U.S. cigar consumers that: are actually confused between the Cuban and GC Cohiba; and do not know that the U.S. embargo prohibits the sale of Cuban cigars in the United States.

21.

Declaration of Thomas Reilly			
<u>GC's Description</u>	<u>GC's Citation to TTABVUE No.</u>	<u>GC's Objection</u>	<u>GC's Identification of Pages Where CT Cites to Evidence in its Trial Brief</u>
Declaration and Annex A thereto	167 TTABVUE 466-472	FRE 602, 701(a), 802 – Lack of Foundation; Hearsay; Unqualified Opinion Evidence	N/A

RESPONSE:

CT does not cite to this testimony in its Trial or Rebuttal Briefs.

In any event, GC has waived its objection that this testimony lacks foundation because GC chose not to cross-examine the witness. It has never raised this objection, either during cross-examination or

otherwise, nor does GC explain how this testimony lacks foundation. *See* CT's Response to GC's Evidentiary Objection No. 11.

GC's objections also are unfounded for the reasons states in CT's Response to GC's Objection Nos. 19 and 20.

22.

Declaration of Kevin A. Gregg, Esq.			
<u>GC's Description</u>	<u>GC's Citation to TTABVUE No.</u>	<u>GC's Objection</u>	<u>GC's Identification of Pages Where CT Cites to Evidence in its Trial Brief</u>
Declaration and Annex A thereto	167 TTABVUE 473-476	FRE 602, 701(a), 802 – Lack of Foundation; Hearsay; Unqualified Opinion Evidence	365 TTABVUE 42

RESPONSE:

GC has waived its objection that this testimony lacks foundation because GC chose not to cross-examine the witness. It has never raised this objection, either during cross-examination or otherwise, nor does GC explain how this testimony lacks foundation. *See* CT's Response to GC's Evidentiary Objection No. 11.

This testimony is admissible for the same reasons stated in CT's Response to GC's Evidentiary Objection Nos. 19 and 20—namely, it is admissible under either the state of mind or the present sense impression exceptions to the hearsay rule. The statement of the specialty cigar store employee is not being offered for the truth of the matter, that is, that the GC Cohiba cigar is the Cuban Cohiba cigar, but rather for whether U.S. consumers frequently ask this question. Additionally, GC is judicially estopped from asserting this objection.

As with CT's Response to GC's Evidentiary Objection Nos. 19 – 21, the logical inference the Board can and should draw from such frequent questions by U.S. cigar consumers about whether GC's Cohiba cigar is the Cuban Cohiba cigar is that there are U.S. cigar consumers that: are actually confused between

the Cuban and GC Cohiba; and do not know that the U.S. embargo prohibits the sale of Cuban cigars in the United States.

Mr. Gregg does not provide opinion evidence; he merely recounts his experience interacting with a specialty cigar store salesperson in the United States.

23.

Notice of Reliance			
<u>GC's Description</u>	<u>GC's Citation to TTABVUE No.</u>	<u>GC's Objection</u>	<u>GC's Identification of Pages Where CT Cites to Evidence in its Trial Brief</u>
Exhibits 39-41 of CT's Noitce of Reliance ("NOR") In Paragraphs 39-41 of CT's NOR and the exhibits connected thereto, CT seeks to enter into evidence: (1) opposition / cancellation proceedings it has initiated; and (2) its current USPTO registrations. CT submits this evidence to show an intention to use the COHIBA mark in the U.S. in the future.	169 TTABVUE 18-21 (¶¶ 39-41); 170 TTABVUE 99-185	FRE 401, 401 – Relevancy; Prejudice	365 TTABVUE 47

RESPONSE:

This testimony is relevant to show CT's intention to sell the Cuban Cohiba cigar in the United States as soon as U.S. law permits, the public recognition and renown of the Cuban Cohiba in the United States (the fifth *du Pont* factor), CT's prior analogous use of the Cuban Cohiba in the United States (section 2(d), CT's Sixth Ground for Cancellation) and CT's Eighth Ground for Cancellation (section 14(3); 15 U.S.C. § 1604(3), misrepresentation of source, or permitting others to misrepresent source, as to which the renown and reputation of the mark in the U.S. is relevant, *see, e.g., The Coca-Cola Co. v. Meenaxi Enter., Inc.*, 2021 USPQ2d 709 (TTAB 2021)).

CT has not "registered [the Cohiba] trade dress and design only in connection with the mark BEHIKE in the US," as GC claims. 367 TTABVUE 89. CT has registered the Cohiba design both in connection with its Behike mark and, separately, to protect its Cohiba design independent of the Behike mark. 357 TTABVUE 233, 240, 242. The very testimony GC relies on confirms this. 367 TTABVUE 89-

90 (*citing* 343 TTABVUE 476-481; CT’s testimony at 343 TTABVUE 477 (261:5-13) is that CT registered the Cohiba design without any lettering or denomination to protect the Cohiba design).

CT has obtained five (5) trademark registrations from the USPTO related to the Cuban Cohiba cigar—in addition to four (4) other registrations for non-Cohiba-related marks—and has initiated seven (7) legal actions in the United States—in both the TTAB and federal court—to protect its trademark rights in the Cuban Cohiba mark, including the Cuban Cohiba design, as well as one (1) legal action in the Dominican Republic against a GC subsidiary for cigars produced in the Dominican Republic and shipped to the United States to be sold as General Cigar COHIBA cigars. 141 TTABVUE 26-27, 35-37.

GC objects to this testimony as prejudicial but never explains why, nor is there any prejudice.

This objection also should be overruled as it goes to the weight of the evidence and, in situations such as this, the Board admits the evidence and decides what weight it deserves. *See* CT’s Response to GC’s Evidentiary Objection No. 1.

24.

Notice of Reliance			
<u>GC’s Description</u>	<u>GC’s Citation to TTABVUE No.</u>	<u>GC’s Objection</u>	<u>GC’s Identification of Pages Where CT Cites to Evidence in its Trial Brief</u>
Paragraph 53, Exhibit 53 to CT’s NOR These documents are printouts from US cigar retailer websites included in Exhibit A to the Declaration of David Goldstein from April 19, 2004. In its NOR, CT claims that these documents support its §2(d) cancellation claim.	174 TTABVUE 25; 171 TTABVUE 714-21	FRE 401 – Relevancy	365 TTABVUE 45

RESPONSE:

This testimony is relevant to show that U.S. online cigar retailers, including the largest U.S. online cigar retailers, have misrepresented the source of GC’s Cohiba cigar, falsely connecting it to the Cuban Cohiba cigar, and have done so consistently for many years. It is also relevant to CT’s Eighth Ground for Cancellation (section 14(3); 15 U.S.C. § 1604(3), misrepresentation of source, or permitting others to

misrepresent source, as to which the renown and reputation of the mark in the U.S. is relevant, *see, e.g., The Coca-Cola Co. v. Meenaxi Enter., Inc.*, 2021 USPQ2d 709 (TTAB 2021)); to show the public recognition and renown of the Cuban Cohiba in the United States (the fifth *du Pont* factor); and GC’s bad faith (thirteenth *du Pont* factor) in its refusal to stop these internet retailers from falsely making this association even though GC recognized back in 2004 that this association was inappropriate and that it would “immediately communicat[e] to its customers that unless they cease advertising its COHIBA as having any association with the Cuban COHIBA, General Cigar will stop shipping them any more COHIBA cigars.” 365 TTABVUE 49, *citing* 171 TTABVUE 680-82, 685.

This objection also should be overruled as it goes to the weight of the evidence and, in situations such as this, the Board admits the evidence and decides what weight it deserves. *See* CT’s Response to GC’s Evidentiary Objection No. 1.

25.

Notice of Reliance			
<u>GC’s Description</u>	<u>GC’s Citation to TTABVUE No.</u>	<u>GC’s Objection</u>	<u>GC’s Identification of Pages Where CT Cites to Evidence in its Trial Brief</u>
Paragraph 54 Exhibit 54 to CT’s NOR These documents are GC advertisements from a 2004 magazine included in Exhibit B to the Declaration of David Goldstein from April 19, 2004. In its NOR, CT claims that these documents support its §2(d) cancellation claim.	174 TTABVUE 25; 171 TTABVUE 722-727	FRE 401 – Relevancy	N/A

RESPONSE:

CT does not cite to this testimony in its Trial or Rebuttal Briefs.

26.

Notice of Reliance			
<u>GC’s Description</u>	<u>GC’s Citation to TTABVUE No.</u>	<u>GC’s Objection</u>	<u>GC’s Identification of Pages Where CT Cites to Evidence in its Trial Brief</u>
Paragraph 55, Exhibit 55 to CT’s NOR	174	FRE 401 –	N/A

CT submits two advertisements of CT's Cohiba cigar in <i>Smoke</i>	TTABVUE 25; 171 TTABVUE 722-727	Relevancy	
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RESPONSE:

This testimony is relevant to show CT's intention to sell the Cuban Cohiba cigar in the United States as soon as U.S. law permits, the public recognition and renown of the Cuban Cohiba in the United States (the fifth *du Pont* factor), CT's prior analogous use of the Cuban Cohiba in the United States (section 2(d), CT's Sixth Ground for Cancellation) and CT's Eighth Ground for Cancellation (section 14(3); 15 U.S.C. § 1604(3), misrepresentation of source, or permitting others to misrepresent source, as to which the renown and reputation of the mark in the U.S. is relevant, *see, e.g., The Coca-Cola Co. v. Meenaxi Enter., Inc.*, 2021 USPQ2d 709 (TTAB 2021)), [REDACTED]

See, e.g., 367 TTABVUE 48 & n.30..

This objection also should be overruled as it goes to the weight of the evidence and, in situations such as this, the Board admits the evidence and decides what weight it deserves. *See* CT's Response to GC's Evidentiary Objection No. 1.

27.

Notice of Reliance			
<u>GC's Description</u>	<u>GC's Citation to TTABVUE No.</u>	<u>GC's Objection</u>	<u>GC's Identification of Pages Where CT Cites to Evidence in its Trial Brief</u>
Paragraph 60, Exhibit 60 to CT's NOR. These are excerpts from GC's 2006 marketing plan for Cohiba. In its NOR, CT claims that these documents support its §2(d) cancellation claim.	174 TTABVUE 27; 175 TTABVUE 125-131	FRE 401: Relevancy	N/A

RESPONSE:

CT does not cite to this evidence in its Trial or Rebuttal Briefs.

Notice of Reliance			
<u>GC's Description</u>	<u>GC's Citation to TTABVUE No.</u>	<u>GC's Objection</u>	<u>GC's Identification of Pages Where CT Cites to Evidence in its Trial Brief</u>
Paragraph 61, Exhibit 61 to CT's NOR CT seeks to admit "Excerpts from "Transcript of Jury Trial" from October 11, 2006 at 9:30am in U.S. v. Penton, Case No. 2006-cr-20169 (S.D. Fla. 2006) (Docket Entry 152). CT claims these documents support its § 2(d) cancellation claim.	174 TTABVUE 27; 171 TTABVUE 850-872	FRE 401: Relevancy	365 TTABVUE 49

RESPONSE:

This document is relevant to refute GC's argument that U.S. consumers are aware of the U.S. embargo and that that awareness dispels confusion. It is also relevant to refute GC's argument that the purported differences in the designs between the GC and Cuban Cohiba dispel confusion. (Note that CT has also refuted GC's claim that there are differences in the designs and, in any event, GC's registrations are not for a design mark and so it is free to change its design at any time, *see* 308 TTABVUE 59-60).

GC's Vice-President of Marketing testified that U.S. consumers do *not* know about the U.S. embargo against Cuban cigars or that Cuban Cohiba cigars cannot legally be sold in the United States. 171 TTABVUE 854 (identification of witness), 559 (beginning of cross-examination), 868 (testimony). He further testified that "there is a large quantity of Cuban cigars, whether they are real or counterfeit, that are being consumed in the United States..." 171 TTABVUE 862-63.

This testimony comes from a 2006 criminal counterfeiting trial concerning, in part, cigars bearing the Cohiba word mark (together with the Cuban Cohiba trade dress); it is completely consistent with all of CT's other evidence that U.S. consumers *still* do not know about the U.S. embargo against Cuban cigars or that Cuban Cohiba cigars cannot legally be sold in the United States. *See* 365 TTABVUE 50-54.

This evidence shows, without limitation, that it cannot be assumed from there being an embargo that there is no substantial part of U.S. cigar consumers who do not know Cuban cigars cannot be legally

sold in U.S. and are not confused between the GC and Cuban Cohiba.

Additionally, the GC executive's testimony provides further support that it is *GC's burden* to show that, unlike in 2006, U.S. cigar consumer are *now* aware of the embargo. Clearly, that was not the case when GC's executive testified at trial in 2006, despite more than forty-five (45) years of the U.S. embargo against Cuba. Given its prior testimony, GC's burden is even greater now to show what has changed and that that change affects the awareness and likelihood of confusion of U.S. consumers.

Even if not estopped from arguing that the embargo dispels confusion, GC has not come forward with *any evidence* that the least sophisticated cigar consumer who buys cigars for a buck at a liquor or convenience store or gas station, the only relevant metric here, knows of the embargo and certainly not enough evidence to overcome GC's testimony from 2006 that they do not.¹⁰

¹⁰ GC maintains that there is a sufficient foundation for one of its employees, Steven Abbot, to testify about the non-premium cigar market, 367 TTABVUE 129-32, but fails to identify a single piece of evidence or testimony that establishes such a foundation.

The *only* mention of the non-premium cigar market in Mr. Abbot's testimony is his testimony that he has knowledge of the fact that there is a "segmentation of the [cigar] market into premium and non-premium categories." 367 TTABVUE 130. He does *not* testify, nor does GC point to any testimony or other evidence, that he has worked in, or otherwise has personal knowledge of, the non-premium cigar market or that he has had any interactions with consumers, retailers or anyone else that works within the non-premium cigar market.

Indeed, there is no evidence or testimony that GC works in the non-premium cigar market at all or, if so, to what degree—such as how much of its business is dedicated to the non-premium cigar market, how many employees work in that sector, how long it has worked in that sector.

Mr. Abbot testifies that "nonpremium cigars [are] sold at gas stations" and "conveniences stores", but "typically [are] not sold in cigar stores," 355 TTABVUE 49 (47:5-7, 18-22), *but he has had no interactions with consumers at gas stations or convenience stores. Id.* at 98-101 (96:16-19, 96:23-97:1, 98:7-99:2, 99:10-13).

Mr. Abbot testifies that he has only worked with GC's premium cigar brands. 287 TTABVUE 3 (¶1). Such experiences provide no basis for testimony concerning the non-premium sector. Abbot's testimony as to the nonpremium market is, therefore, speculative, lacks foundation and is opinion not "rationally based on the witness's perception." 365 TTABVUE 79-84.

Additionally, CT objected to Mr. Abbot's testimony about U.S. premium cigar consumers' knowledge of the U.S. embargo, *inter alia*, because "there is no evidence that Abbot had any conversations with U.S. premium cigar consumers about their awareness of the restrictions of the U.S. embargo against Cuba." 365 TTABVUE 79. GC maintains that there is sufficient basis for Mr. Abbot to testify about U.S. premium cigar consumers' knowledge of the U.S. embargo, 367 TTABVUE 130, but cites to no evidence that he has ever had a single conversation with U.S. premium cigar consumers about the embargo or the

This evidence is also relevant to estop GC from arguing that purported differences in its trade dress dispel confusion. 367 TTABVUE 46. When asked whether, “[i]n his experience as [GC’s] vice-president of marketing,” the general public “interested in buying . . . Cohiba . . . , look at where it’s made or do they look for the source of the production, that is the words Cohiba or the artwork associated with it?”, GC’s Vice-President of Marketing responded that they look “primarily” at the “brand name” and then after that the design or packaging, which can change. 171 TTABVUE 869, 872. This testimony is consistent with GC’s position in other litigation it brought against third parties using the COHIBA mark. *See* 169 TTABVUE 571, 583 (*General Cigar Co., Inc. v. Cohiba Caribbean’s Finest, Inc.*, Case No. 06-cv-575, ECF 264 (D. Nev. June 11, 2008): “the fact that [defendants] use distinct artwork [that mimics the Cuban Cohiba] is irrelevant, does nothing to assist the consumer in assuming this Cohiba is not the Cohiba they know to be a legal product sold in the United States . . . General Cigar itself is using the Cohiba mark, the word mark Cohiba, has different styles of trade dress and different colors, the same way products such as Coca-Cola . . . has different cans not all the traditional red and white.”)

This objection also should be overruled as it goes to the weight of the evidence and, in situations such as this, the Board admits the evidence and decides what weight it deserves. *See* CT’s Response to GC’s Evidentiary Objection No. 1.

29.

Notice of Reliance			
<u>GC’s Description</u>	<u>GC’s Citation to TTABVUE No.</u>	<u>GC’s Objection</u>	<u>GC’s Identification of Pages Where CT Cites to Evidence in its Trial Brief</u>
Paragraphs 3-5, Exhibits 3 to CT’s NOR Partial Moosylvania slide decks sent to GC in 2015/2016 which include some statements relating to UGC (“User Generated Content”) on social media during that time.	174 TTABVUE 4, 40-162	FRE 403, 602, 802 – Irrelevant and Prejudicial; Lack of Foundation; Hearsay	365 TTABVUE 42

legality of: selling Cuban cigars in the United States whether online or at retail locations; or association confusion.

RESPONSE:

Moosylvania’s statements as to confusion are not hearsay, as GC asserts. 367 TTABVue 91-92. They are statements “offered against an opposing party” and” “made by the party’s agent . . . on a matter within the scope of that relationship and while it existed.” Fed. R. Evid. 801(d)(2)(D).

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

Even if Moosylvania did not specifically “track” or “make documentation” of user-generated content concerning the Cuban Cohiba cigar or engage with consumers posting and linking that content to GC’s Cohiba social media accounts, which GC focuses on in its objection, [REDACTED]

[REDACTED]

Moreover, there is ample corroborating evidence, even though none is needed. As shown in the Declaration of Annalisa Martini No. 2, there are numerous social media posts to GC’s Cohiba social media accounts by U.S. persons showing the Cuban Cohiba or referencing the Cuban or the Cuban Cohiba. 218-219 TTABVUE.

There is no support in the record, nor does GC cite to any, for its unfounded claim in its objection that Moosylvania had to “perform any surveys, consider any data or provide any analysis to GC on this subject” in order to opine about actual confusions based on its daily experiences within the scope of its work for GC. Nor is there any evidence, nor does GC cite to any, that Moosylvania did *not* “consider whether the UGC [user generated comments] stemmed from non-US persons or from actual cigar smokers,” as GC claims 367 TTABVUE 91-92, in forming its opinion.

In addition, GC has waived its lack of foundation objection and hearsay objection (based on a lack of foundation) by not raising them when these documents were introduced in the testimony of GC’s Director

of Marketing, Augustin Martínez III, 351 TTABVUE 195-99 (224:12-228:5) (introducing and questioning Martínez and GC's Cohiba Senior Brand Manager, Andres Maturen Maal, 349 TTABVUE 1304-06 (205:17-207:7) on the document later introduced as Notice of Reliance Exhibit No. 3, 174 TTABVUE 4, 39 *et seq.*), and further identified as business records by the Declaration of Michael Harris. 167 TTABVUE 485 (Harris Decl. demonstrating that records produced by Moosylvania, which are Bates labelled starting with "MS," satisfy the business records exception). *See* CT's Response to GC's Evidentiary Objection No. 11.

GC has also waived its lack of foundation and hearsay objections by not raising them "promptly" when these documents were introduced in CT's Notice of Reliance. *See id.* Promptly raising such an objection would have allowed CT an opportunity to extend or reopen its testimonial period to cure these objections, if needed.

In addition to being a statement against interest, they also satisfy the present sense hearsay and the state of mind hearsay exceptions, Fed. R. Evid. 803(1), (3), to show that Moosylvania repeatedly reported to GC that there was actual confusion.

GC never identifies the basis of its relevance objection. In any event, this evidence is relevant to show likelihood of confusion including, *inter alia*, actual confusion, the extent of potential confusion and GC's bad (seventh, eighth, twelfth and thirteenth *du Pont* factors) and CT's Eighth Ground for Cancellation (section 14(3); 15 U.S.C. § 1604(3), misrepresentation of source, or permitting others to misrepresent source, as to which the renown and reputation of the mark in the U.S. is relevant, *see, e.g., The Coca-Cola Co. v. Meenaxi Enter., Inc.*, 2021 USPQ2d 709 (TTAB 2021)).

This objection should be overruled as it goes to the weight of the evidence and, in situations such as this, the Board admits the evidence and decides what weight it deserves. *See* CT's Response to GC's Evidentiary Objection No. 1.

Notice of Reliance			
<u>GC's Description</u>	<u>GC's Citation to TTABVUE No.</u>	<u>GC's Objection</u>	<u>GC's Identification of Pages Where CT Cites to Evidence in its Trial Brief</u>
Paragraphs 6-7, Exhibits 6-7 to CT NOR Draft internal brand plans from March 2016. Not shown to any customers or in GC's sales action plans.	174 TTABVUE 5, 163-197	FRE 401, 403 – Relevancy and Prejudicial.	365 TTABVUE 44

RESPONSE:

These documents are relevant to show likelihood of confusion including, *inter alia*, actual confusion, the extent of potential confusion and GC's bad faith (seventh, eighth, twelfth and thirteenth *du Pont* factors) and CT's Eighth Ground for Cancellation (section 14(3); 15 U.S.C. § 1604(3), misrepresentation of source, or permitting others to misrepresent source, as to which the renown and reputation of the mark in the U.S. is relevant, *see, e.g., The Coca-Cola Co. v. Meenaxi Enter., Inc.*, 2021 USPQ2d 709 (TTAB 2021)). Even if they were not shown to the public or directly incorporated into GC's advertising, as GC claims in its objection, they reveal: [REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

For these reasons, even if documents were never shown to the public or parts were not ultimately included in the final brand plan, as GC claims in its objection, that does not make them irrelevant.

GC does not state how they are prejudicial and, therefore, this objection should be overruled.

This objection also should be overruled as it goes to the weight of the evidence and, in situations such as this, the Board admits the evidence and decides what weight it deserves. *See* CT's Response to GC's Evidentiary Objection No. 1.

31.

Notice of Reliance			
<u>GC's Description</u>	<u>GC's Citation to TTABVUE No.</u>	<u>GC's Objection</u>	<u>GC's Identification of Pages Where CT Cites to Evidence in its Trial Brief</u>
Paragraph 9-11 and Exhibit 9-11 of CT's NOR Draft internal brand plans from October 2014. Not shown to any customers or in GC's sales action plans.	174 TTABVUE 207-232	FRE 401: Relevancy; FRE 403 Prejudicial	N/A

RESPONSE:

CT does not cite to this evidence in its Trial or Rebuttal Briefs. In any event, this objection should be overruled as it goes to the weight of the evidence and, in situations such as this, the Board admits the evidence and decides what weight it deserves. *See* CT's Response to GC's Evidentiary Objection No. 1.

32.

Notice of Reliance			
<u>GC's Description</u>	<u>GC's Citation to TTABVUE No.</u>	<u>GC's Objection</u>	<u>GC's Identification of Pages Where CT Cites to Evidence in its Trial Brief</u>
Paragraph 68, Exhibit	173	FRE 401:	N/A

68 to CT's NOR	TTABVUE 115-	Relevancy	
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RESPONSE:

CT does not cite to this evidence in its Trial or Rebuttal Briefs. In any event, this objection should be overruled as it goes to the weight of the evidence and, in situations such as this, the Board admits the evidence and decides what weight it deserves. *See* CT's Response to GC's Evidentiary Objection No. 1.

33.

Notice of Reliance			
<u>GC's Description</u>	<u>GC's Citation to TTABVUE No.</u>	<u>GC's Objection</u>	<u>GC's Identification of Pages Where CT Cites to Evidence in its Trial Brief</u>
Paragraph 70-73, 82 and Exhibits 70-73, 82 of CT's NOR	174 TTABVUE 207-232	FRE 401, 403 – Relevancy and Prejudicial.	N/A

RESPONSE:

These paragraphs of the NOR and exhibits thereto are merely clearer copies of documents properly introduced during depositions. GC does *not* object to the copies of the documents introduced *during deposition*, and therefore, it has waived its objection.

In any event, the objection should be overruled because GC's final 2017 Cohiba Brand Plan (Exhibit 70) and these additional draft iterations of GC's 2017 Cohiba Brand Plans (Exhibits 71-73) and an earlier draft brand launch presentation for a new GC Cohiba cigar (Exhibit 82) are relevant to show likelihood of confusion including, *inter alia*, the public recognition and renown of the Cuban Cohiba in the United States, actual confusion, the extent of potential confusion, same channels of trade and GC's bad faith (third, fifth, seventh, eighth, twelfth and thirteenth *du Pont* factors) and CT's Eighth Ground for Cancellation (section 14(3); 15 U.S.C. § 1604(3), misrepresentation of source, or permitting others to misrepresent source, as to which the renown and reputation of the mark in the U.S. is relevant, *see, e.g., The Coca-Cola Co. v. Meenaxi Enter., Inc.*, 2021 USPQ2d 709 (TTAB 2021)). Even if these documents were not shown to the public or directly incorporated into GC's advertising, as GC claims in its objection,

they reveal: [REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

GC does not state how these documents are prejudicial and, therefore, this objection should be overruled.

This objection also should be overruled as it goes to the weight of the evidence and, in situations such as this, the Board admits the evidence and decides what weight it deserves. *See* CT's Response to GC's Evidentiary Objection No. 1.

34.

Declaration of Shkumbin Mustafa			
<u>GC's Description</u>	<u>GC's Citation to TTABVUE No.</u>	<u>GC's Objection</u>	<u>GC's Identification of Pages Where CT Cites to Evidence in its Trial Brief</u>
	200-201 TTABVUE	<ul style="list-style-type: none">• FRE 401, 403, 602, 701(a)• Fed. R. Civ. P.	365 TTABVUE 45, 46

		26 – Untimely Expert Disclosures	
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RESPONSE:

GC completely mischaracterizes Mr. Mustafa’s testimony. As evident from a simple review of his testimony and exhibits attached thereto, he was never “engaged by CT’s counsel . . . [to] provide expert testimony on social media and internet evidence,” as GC claims, 367 TTABVUE 95; he does *not testify as an expert*, nor does he claim to do so; he does not provide survey evidence or claim to do so; he does not even provide *lay* opinion, nor does he claim to do so; nor does he testify as to what cigar consumers think or believe.

His testimony is merely to demonstrate visually to the Board what he, as an individual social media/internet user, viewed when he took certain actions on social media or the internet. His testimony is relevant to show likelihood of confusion including, *inter alia*, the recognition and renown of the Cuban Cohiba, channels of trade, actual confusion, the extent of potential confusion and GC’s bad (third, fifth, seventh, eighth, twelfth and thirteenth *du Pont* factors) and CT’s Eighth Ground for Cancellation (section 14(3); 15 U.S.C. § 1604(3), misrepresentation of source, or permitting others to misrepresent source, as to which the renown and reputation of the mark in the U.S. is relevant, *see, e.g., The Coca-Cola Co. v. Meenaxi Enter., Inc.*, 2021 USPQ2d 709 (TTAB 2021)).

These actions included:

- A review of photos that other users have posted to GC’s Cohiba social media accounts, including many user posts showing only the *Cuban* Cohiba cigar, user posts showing the GC and Cuban Cohiba cigars together, and user posts that GC “liked”—
[REDACTED]
[REDACTED]
[REDACTED]
- The steps for making a post on social media, which shows that Mr. Mustafa was shown an icon of the GC Cohiba and trade dress *before* tagging his post of a Cuban Cohiba to GC’s Cohiba social

media account, 201 TTABVUE 104-138—from which the Board may infer that users tagging images of the Cuban Cohiba to GC’s Cohiba social media account were not doing so by inattention;

- How GC links its Cohiba website to retailers that misrepresented the source of GC’s Cohiba cigar, falsely connecting it to the Cuban Cohiba cigar, 200 TTABVUE 565-600;
- What happens if you tap on “tags” in Instagram—it took Mr. Mustafa to the tagged social media account, 200 TTABVUE 221-275;
- What GC’s Milestone section looks like on the internet and showing that GC included one “Milestone” for its Cohiba noting that in “1982—Cohiba cigars are introduced worldwide with the exception of the United States”—showing an image of a GC Cohiba, even though 1982 was the year *CT* began exporting Cuban Cohiba cigars and GC has never exported its Cohiba, 200 TTABVUE 366-400; *see also* 365 TTABVUE 46 & n.56;
- A review of searches for “#cohiba” on social media, showing that the hashtag “#cohiba” is used for both GC and the Cuban Cohiba, even though most posts with the hashtag “#cohiba” and showing images of the Cuban Cohiba are from individual consumers, while most posts with the hashtag “#cohiba” and showing images of the GC Cohiba are made by GC, 200 TTABVUE 401-564; and
- A review of a popular cigar app (Cigar Boss)’s description of different Cohiba cigars, which lists under “Cuban Cigars” several different Cuban Cohiba cigars with a description of GC’s “Red Dot” Cohiba cigars, identifying the cigar’s “Country” as the “Dominican Republic” where GC’s Cohiba cigars are produced; it also lists a GC Cohiba cigar as a “Cuban Cigar” whose “Country” is “Cuba” and includes a description and image of the Cuban Cohiba cigar, 200 TTABVUE 601-663, 201 TTABVUE 1-3; *see also* 347 TTABVUE 150, 153, 157 (GC’s expert, Hacker, identifying Cigar Boss as an app cigar consumers rely on).

His testimony does not lack foundation or personal knowledge, as GC claims. He both describes and shows, step-by-step, each action that he took through a video and still-images of same.

Mr. Mustafa reviewed carefully his testimony, exhibits attached thereto, and each and every statement contained in the exhibits, before signing his declaration and confirmed that each was true and correct. 363 TTABVUE 223-225 (221:1-223:25). That Mr. Mustafa had someone assist with technical issues related to putting together the video (synching the audio and video) and PDFs is of no import, as he checked the final videos and PDF slides to make certain that they accurately reflected his experience. *Id.*

If GC thought that the user posts included in his exhibits were too selective or not representative of users posts on GC's Cohiba social media accounts or that his cache affected his search results, as GC claims, 367 TTABVUE 94-100, it could have provided its own evidence, but chose not to.

GC claims that Mr. Mustafa's testimony lacks foundation and relevancy because "[h]e was unaware about whether an embargo [against the commercial importation of Cuban cigars into the United States] existed and what the rules are." 367 TTABVUE 97. However, Mr. Mustafa did not testify as to the embargo at all in his direct testimony, nor does GC cite to any passage in his direct testimony where he does. If anything, Mr. Mustafa's cross-examination testimony, that GC solicited, provides further evidence that cigar consumers in the U.S. do not know about the embargo. 363 TTABVUE 9-10 (7:4-8:10) (Mustafa responded to GC's questioning that he was "not sure" if the embargo prohibits the commercial importation of Cuban cigars into the U.S. or if the Cuban Cohiba can legally be sold in the United States); 93-94 (91:24-92:8) (Mustafa smokes cigars, but not regularly).

Mustafa does not "identif[y] social media users from outside the US," as GC claims, 367 TTABVUE 99, nor do the passages GC cites to in Mustafa's cross-examination indicate as much.

That Mr. Mustafa was paid for his time is not grounds for excluding his testimony and exhibits, as GC claims.

Even though Mr. Mustafa does not opine on confusion or what consumers think or believe when they post images of the Cuban Cohiba cigar but tag them to GC's Cohiba social media account, the Board may infer from his testimony that there is actual confusion, including the engendering of confusion amongst the social media users' followers, and the potential confusion between the GC and Cuban Cohiba on social media based on this testimony. This is the only "common denominator" that can explain the frequency of

such posts. *See* CT Response to GC Evidentiary Objection No. 19 (citing *The Finance Company of America*, 205 U.S.P.Q. at 1035).

GC's relevance and prejudice objections should be overruled as they go to the weight of the testimony and, in situations such as this, the Board admits the evidence and decides what weight it deserves. *See* CT's Response to GC's Evidentiary Objection No. 1.

35.

Declaration of Gerardo Ruiz			
<u>GC's Description</u>	<u>GC's Citation to TTABVUE No.</u>	<u>GC's Objection</u>	<u>GC's Identification of Pages Where CT Cites to Evidence in its Trial Brief</u>
Paragraphs 1-4 and Annexes 1-5 and Annexes 1-11 Thereto (summaries of searches on social media)	205 TTABVUE	FRE 401, 602, 802, 901, 1006 – Relevance, Lack of Foundation; Hearsay; Lack of Authenticity; Inadmissible Summaries	365 TTABVUE 39, 42

RESPONSE:

GC has waived its objections as it failed to cross-examine Mr. Ruiz or otherwise object promptly to the admissibility of his testimony. *See supra* CT's Response to GC's Evidentiary Objection No. 11.

Moreover, GC's objections are without foundation. Mr. Ruiz provides a detailed analysis of search results for a search he did on Twitter for references to GC's Cohiba account name (handle)—"@Cohiba"—during a random one week date range right before trial. His analysis showed that nearly half (41%) of these Tweets that showed an image and included a link to GC's Cohiba Twitter account, showed an image of the *Cuban* Cohiba cigar. 205 TTABVUE 3-5. Mr. Ruiz also included supporting documentation of his search, the search results, and the location of the users whose Tweets he analyzed. 205 TTABVUE 21-163.

Contrary to GC's claim, 367 TTABVUE 100, the underlying materials upon which Mr. Ruiz's summaries are based *are* 'independently admissible'; they are internet materials, independently admissible because they include the date and URL of the website from which Mr. Ruiz downloaded them, 37 C.F.R. §

2.122(e), TBMP § 704.08(b). Mr. Ruiz also provided detailed testimony about how he downloaded these materials. They are not offered for the truth of the statements included in them, but only for what they show on their face, in addition to the fact that each time Mr. Ruiz clicked on the Twitter account name (handle)—@Cohiba—contained in these Tweets, he was directed to GC’s Cohiba Twitter account. 205 TTABVUE 4 (¶ 2(c)) & 164-74 (Annex 4).

Mr. Ruiz was not required to only analyze CT’s business records, as GC strangely claims without foundation or citation to any authority. 367 TTABVUE 101-02. Mr. Ruiz was also not required to limit himself to a “separate analysis of Twitter posts limited to a verified universe of U.S. persons,” as GC also strangely claims without foundation or citation to any authority. 367 TTABVUE 101. He provides a complete analysis of all of the Tweets in a random one week period included in his search results.

His analysis is *not* “inherently unreliable” because it “appears” that some of the users whose Tweets were analyzed were non-U.S. persons. *Id.* Mr. Ruiz systematically determined the location of the users whose Tweets he was analyzing, finding that 60% of the users whose Tweets included a link to GC’s Cohiba Twitter account but showed an image of a Cuban Cohiba cigar were users located in the United States, and it was unclear for 20% whether the user was located in the United States. 205 TTABVUE 5. His methodology and analysis is clear and well-founded and shows that a significant percent of these users were located in the United States.

If GC cared to question or challenge him on how he selected or downloaded these materials or analyzed the data, it could have during cross-examination, but chose not to examine him at all.

Contrary to GC’s claim, 367 TTABVUE 100-01, such searches are *not* “routinely found inadmissible.” 367 TTABVUE 100-01. None of the cases GC relies upon concern the kind of detailed testimony, including supporting materials, included here. *See also* CT Response to GC Evidentiary Objection No. 44 (contrasting cases GC relies upon to factual presentation here). Given the frequency of these posts by U.S. cigar consumers linking the GC and Cuban Cohiba, the logical inference the Board can and should draw from such posts is that there are U.S. cigar consumers that: are actually confused between the Cuban and GC Cohiba; and do not know that the U.S. embargo prohibits the sale of Cuban cigars in the

United States. This is the only “common denominator” that can explain the frequency of such posts. *See* CT Response to GC Evidentiary Objection Nos. 19 & 44 (citing *The Finance Company of America*, 205 U.S.P.Q. at 1035). Even if the Board finds that they do not show actual confusion or a lack of awareness of the embargo, they clearly show how confusion is likely engendered among the hundreds of thousands of followers of these social media users as well as “how and why confusion is likely.” 365 TTABVUE 45-47.

It is unclear how GC’s objections to Paragraphs 3-4, Annex 5, of Mr. Ruiz’s Declaration are the “same” as its objections to Paragraph 2, Annexes 1–4, as GC asserts. In Paragraphs 3-4, Annex 5, Mr. Ruiz only testifies about his downloading certain webpages, without analysis. In any event, to the extent applicable, CT’s Response regarding Paragraphs 3-4, Annex 5 is the same as its Response to Paragraph 2, Annexes 1–4.

Mr. Ruiz’s testimony is relevant to show likelihood of confusion including, *inter alia*, the recognition and renown of the Cuban Cohiba, channels of trade, actual confusion and the extent of potential confusion (third, fifth, seventh, eighth and twelfth *du Pont* factors), and CT’s Eighth Ground for Cancellation (section 14(3); 15 U.S.C. § 1604(3), misrepresentation of source, or permitting others to misrepresent source, as to which the renown and reputation of the mark in the U.S. is relevant, *see, e.g., The Coca-Cola Co. v. Meenaxi Enter., Inc.*, 2021 USPQ2d 709 (TTAB 2021)).

GC’s relevance objection also should be overruled as it goes to the weight of the testimony and, in situations such as this, the Board admits the evidence and decides what weight it deserves. *See* CT’s Response to GC’s Evidentiary Objection No. 1.

36.

Declaration of Tahimi Arboleya Delgado			
<u>GC’s Description</u>	<u>GC’s Citation to TTABVUE No.</u>	<u>GC’s Objection</u>	<u>GC’s Identification of Pages Where CT Cites to Evidence in its Trial Brief</u>
Testimony from <i>OnCuba</i> Magazine Representative regarding circulation of its magazine.	206 TTABVUE	FRE 602 – Lack of Foundation	N/A

RESPONSE:

GC has waived its objections as it failed to cross-examine Ms. Arboleya Delgado or otherwise object promptly to the lack of foundation of her testimony. *See* CT’s Response to GC’s Evidentiary Objection No. 11.

Also, the objection should be overruled because the witness, as the editorial director of the *OnCuba* magazine, familiar with its distribution and advertisement, clearly has established a foundation for her testimony as to the circulation of the *OnCuba* magazine in the United States. *See* CT’s Response to GC’s Evidentiary Objection No. 1 (*citing Nahshin v. Prod. Source Int’l, LLC*, 107 USPQ2d 1257, 1260 (TTAB 2013) *aff’d*, 112 F. Supp. 3d 383 (E.D. Va. 2015) (hearsay objection overruled where witness’s testimony “was based on knowledge he acquired through his position with the company, and are based on personal knowledge, reports and business records”); *see also First Nat. Bank of Louisville v. Lustig*, 96 F.3d 1554, 1576 (5th Cir. 1996) (upholding denial of FRE 602 objection to testimony about which witness did not have direct knowledge, finding sufficient that witness had been an employee for many years and was “intimately familiar” with certain practices to which he testified) (relied upon by GC)).

In any event, CT does not cite to this testimony in its Trial or Rebuttal Briefs.

37.

Declaration No. 3 of Annalisa Martini			
<u>GC’s Description</u>	<u>GC’s Citation to TTABVUE No.</u>	<u>GC’s Objection</u>	<u>GC’s Identification of Pages Where CT Cites to Evidence in its Trial Brief</u>
Paragraphs 1-8, Annexes 1-25	215 TTABVUE (1-16, 83-278	FRE 401, 403 – Relevancy; Prejudicial Evidence	365 TTABVUE 39

RESPONSE:

There is absolutely no truth to GC claim that a “significant portion” of this testimony and evidence “dates back to 1998” and therefore “should be excluded since likelihood of confusion is determined based on facts existing at time at trial.” 367 TTABVUE 102.

Only one of eight pieces of evidence in Paragraphs 1-8 concerns 1998, not a “significant portion.”

This testimony and evidence is to show the recognition and renown of the Cuban Cohiba in the United States in popular movie and television programs throughout the years, including at the time of trial—the fifth *du Pont* factor. They are also relevant to CT’s Eighth Ground for Cancellation (section 14(3); 15 U.S.C. § 1604(3), misrepresentation of source, or permitting others to misrepresent source, as to which the renown and reputation of the mark in the U.S. is relevant, *see, e.g., The Coca-Cola Co. v. Meenaxi Enter., Inc.*, 2021 USPQ2d 709 (TTAB 2021)).

They date from:

- 2017 (release date) – the popular movie *Downsizing*, 215 TTABVUE 12-13
- July 16, 2016 (first air date) – the popular television show *Keeping Up with the Kardashians*, *id.* at 4;
- May 2016 – multiple social media posts of the Cuban Cohiba by the extremely influential social media titans—Kim Kardashian West and Khloé Kardashian, *id.* at 4-7;
- November 20, 2014 (first air date) – comedian Jerry Seinfeld’s Netflix series *Comedians in Cars Getting Coffee*, *id.* at 9-10;
- 2010 – the popular Marvel movie *Iron Man 2*, *id.* at 15-16
- February 6, 2006 (first air date) – the popular CBS sitcom *How I Met Your Mother*, *id.* at 11-12;
- 2004 (release date) – the critically-acclaimed movie *Hotel Rwanda*, *id.* at 13-15; and
- June 6, 1998 – premier episode of the popular HBO series *Sex in the City*, *id.* at 7-9.

Moreover, even though these movies and television shows were released on the dates identified above, they are all either syndicated or still available for viewing, rental or purchase. *Id.* at 4-15. In the case of *Sex in the City*, it is still viewable on HBO, where it is listed as an “Essential Series,” as well as on numerous other popular platforms. *Id.* at 9.

GC claims, without citation to authority, that because the references to the Cuban Cohiba in these movies and television shows are “very short” and not focused on cigar issues, they are prejudicial. There is

no such prejudice. If anything, the fact that the Cuban Cohiba is referenced in so many popular U.S. movies and television shows unrelated to cigars, only *underscores* the fame of the Cuban Cohiba in the United States.

Moreover, these references, even if short in duration, are not to be undercounted. For example, the Cuban Cohiba is featured in a 40 second clip of a July 2016 episode of the television show *Keeping Up with the Kardashians*, itself a major promotional victory desired by any company, but then Kim Kardashian posted an image of herself and her sisters with the Cuban Cohiba and the words “Viva Cohiba” on her Twitter and Instagram accounts, which have 88.9 million and 49.3 million followers respectively and was Liked almost a million times (in addition to still other social media posts by her sister, Khloe Kardashian, herself with tens of millions of followers, and a news article about same). Such promotion by this important social media influencer usually costs hundreds of thousands of dollars. 217 TTABVUE 4-7. In the 2017 popular movie *Downsizing*, a movie about a couple that shrink their bodies to start a new life in an experimental community, one of the characters tells the main character, played by Matt Damon, “why the people they become small? To help the environment? Please. They become small to have the things which until now were only for the rich . . . why not bring very special items, luxury items, to the small consumer?” Then holding up a Cuban Cohiba, he says “COHIBA Esplendido, Cuba. The best cigar in the world . . .” *Id.* at 11-12.

That CT does not maintain these documents as their business records, as GC complains, is of no import.

Similarly, GC’s complaint that CT “cannot identify the number of U.S. viewers” falls flat. CT has provided distribution information for the programs and movies in the United States. 217 TTABVUE 4-16.

In any event, these objections should be overruled as they go to the weight of the testimony and, in situations such as this, the Board admits the evidence and decides what weight it deserves. *See* CT’s Response to GC’s Evidentiary Objection No. 1.

Declaration No. 3 of Annalisa Martini			
<u>GC's Description</u>	<u>GC's Citation to TTABVUE No.</u>	<u>GC's Objection</u>	<u>GC's Identification of Pages Where CT Cites to Evidence in its Trial Brief</u>
Paragraphs 9, 11-12, Annexes 27, 32	215 TTABVUE (16-19 279-333, 350-392)	FRE 401, 403, 602 – Relevancy; Prejudicial Evidence; Lack of Foundation	N/A

RESPONSE:

GC has waived its lack of foundation objection as it failed to cross-examine Ms. Martini or otherwise object promptly to the admissibility of her testimony. *See* CT's Response to GC's Evidentiary Objection No. 11.

This testimony and evidence is relevant to show the recognition and renown of the Cuban Cohiba cigar in the United States, both at the time of trial and including over the years—the fifth *du Pont* factor. They are also relevant to CT's Eighth Ground for Cancellation (section 14(3); 15 U.S.C. § 1604(3), misrepresentation of source, or permitting others to misrepresent source, as to which the renown and reputation of the mark in the U.S. is relevant, *see, e.g., The Coca-Cola Co. v. Meenaxi Enter., Inc.*, 2021 USPQ2d 709 (TTAB 2021)).

There is absolutely no truth to GC claim that a “significant portion” of this testimony evidence “dates back to 2003” and therefore “should be excluded since likelihood of confusion is determined based on facts existing at time at trial.” 367 TTABVUE 102.

Nineteen (19) of the twenty-three (23) articles or books identified in Paragraphs 9, 11-12 and Annexes 27, 32 are from 2016 or after, one (1) is from 2015, two (2) are from 2012 and one (1) is from 2005.

To the extent GC argues there is a lack of foundation for the evidence in Paragraph 13, GC waived that argument, as indicated above. In any event, Paragraph 13 is merely Ms. Martini's identification of the universe of news articles in Westlaw's U.S. News database that include the terms “Cohiba” and “cigar” and

were published between September 16, 2002 and December 6, 2016. All of these articles were produced to GC (which it does not contest). These articles were separately analyzed and summarized by Christina Licata in her declaration. *See* 226 TTABVUE 61-69.

Such articles (or a summary under FRE 1006 of same) are *not* inadmissible under the caselaw GC relies upon, which concerns the admissibility of Google search results without producing the resulting materials themselves.

These objections also should be overruled as they go to the weight of the testimony and, in situations such as this, the Board admits the evidence and decides what weight it deserves. *See* CT's Response to GC's Evidentiary Objection No. 1.

In any event, CT does not cite to this testimony in its Trial or Rebuttal Briefs.

39.

Declaration No. 3 of Annalisa Martini			
<u>GC's Description</u>	<u>GC's Citation to TTABVUE No.</u>	<u>GC's Objection</u>	<u>GC's Identification of Pages Where CT Cites to Evidence in its Trial Brief</u>
Paragraphs 10, 28-29	215 TTABVUE 19-27, 78-82	FRE 1006 – Inadmissible Summaries Duplicative of Evidence in the Trial Record	N/A

RESPONSE:

GC incorrectly states that the evidence Ms. Martini summarizes has “already submitted as part of the trial record through the Declarations of Brenna Murdock and Miguel Suarez Medina. (215-217, 225 TTABVUE).”

As Ms. Martini testified, Ms. Murdock and Mr. Suarez Medina testified that they *downloaded and printed* the evidence she is summarizing—consisting of thousands of pages—and that that evidence was provided to GC. Ms. Murdock and Mr. Suarez Medina did not include that evidence in their declarations, nor does Ms. Martini testify that they did.

This evidence consists of thousands of pages of documents and therefore is the proper subject of Fed. R. Evid. 1006 summary.

Ms. Martini showed in this testimony that even *Cigar Aficionado*, the premier U.S. premium cigar consumer magazine, describes the GC and Cuban Cohiba cigar in such a way on its website as to engender confusion. Specifically, there is a page on *Cigar Aficionado*'s website dedicated to the GC Cohiba cigar but which links to one thousand one hundred twenty-eight (1,128) articles whose titles or short descriptions included the words "Cuba", "Havana", "Habana" or "Fidel Castro" and/or showed an image of the yellow/orange and black and white checkered pattern or Indian head logo used with Cuban Cohiba cigars. Similarly, there is a page on *Cigar Aficionado*'s website dedicated to the Cuban Cohiba cigar but which links to forty (40) articles whose titles or short descriptions included the words "Dominican", "Nicaraguan" or "General Cigar" or showed an image of a cigar with a the Red Dot Design. 217 TTABVUE 21-22.

In any event, CT does not cite to this testimony in its Trial or Rebuttal Briefs.

40.

Declaration No. 3 of Annalisa Martini			
<u>GC's Description</u>	<u>GC's Citation to TTABVUE No.</u>	<u>GC's Objection</u>	<u>GC's Identification of Pages Where CT Cites to Evidence in its Trial Brief</u>
Paragraphs 16-17, Annexes 38-39	215 TTABVUE	FRE 602, 802, 901, 1006 – Lack of Foundation; Hearsay; Lack of Authenticity; Evidence Summarized Is Not Independently Admissible	365 TTABVUE 39

RESPONSE:

GC has waived these objections as it failed to cross-examine Ms. Martini or otherwise object promptly to the admissibility of her testimony. *See* CT's Response to GC's Evidentiary Objection No. 11.

In any event, Ms. Martini's testimony is admissible as her personal experience reviewing two Instagram accounts. Additionally, the underlying documents she reviewed and produced as an exhibit are

admissible as internet materials, 215 TTABVUE 647-66; they are not offered for the truth of the information contained therein, but what appears on their face.

This testimony merely shows that two Instagram accounts—“cohibahabana” and “cohiba_habana”—are dedicated to the Cuban Cohiba. Other evidence shows that Instagram users regularly tag images of the GC Cohiba to one or both of these two accounts. 218 TTABVUE 2, 4-5, 13-16.

If GC thought that her review was inaccurate or not representative, it could have cross-examined Ms. Martini or submitted contrary evidence, but it chose to do neither.

41.

Declaration No. 3 of Annalisa Martini			
<u>GC's Description</u>	<u>GC's Citation to TTABVUE No.</u>	<u>GC's Objection</u>	<u>GC's Identification of Pages Where CT Cites to Evidence in its Trial Brief</u>
Paragraphs 18-21, 25	215 TTABVUE 42-52	FRE 602, 802 – Lack of Foundation, Hearsay	N/A

RESPONSE:

GC has waived these objections as it failed to cross-examine Ms. Martini or otherwise object promptly to the admissibility of her testimony. *See* CT's Response to GC's Evidentiary Objection No. 11.

In addition, in Paragraph 18, Ms. Martini summarizes documents—Instagram, Twitter and Facebook Help Center publications—that are admissible under Fed. R. Evid. 803(17), as a commercial publication “generally relied on by the public or by persons in particular occupations.”

As for Paragraphs 19-21, GC falsely claims that “CT's own witness confirmed that CT does not have or maintain any reliable data and could not provide any reliable testimony that could support the summaries contained within these paragraphs.” *See* CT's Responses to GC Evidentiary Objections Nos. 12-13.

As for GC's objection related to Ms. Martini's testimony concerning the Google Analytics reports, GC has waived its lack of foundation objection as well as its objection that these reports were not kept in

the ordinary course of its business. In any event, CT has provided sufficient evidence that these reports are kept in the ordinary course of business. *See* CT’s Responses to GC Evidentiary Objections No. 11.

42.

Declaration No. 3 of Annalisa Martini			
<u>GC’s Description</u>	<u>GC’s Citation to TTABVUE No.</u>	<u>GC’s Objection</u>	<u>GC’s Identification of Pages Where CT Cites to Evidence in its Trial Brief</u>
Paragraph 24	215 TTABVUE 54-60	FRE 401, 403 – Relevancy; Prejudicial Evidence	365 TTABVUE 39

RESPONSE:

This testimony is relevant to show that even the current consumers of GC’s Cohiba cigars are not discerning, cautious or sophisticated, [REDACTED] which sell for as little as \$13.95 per tin of 10 (or 6) cigars, or less than the price of a pack of cigarettes. 215 TTABVUE 57-58 (uncontested testimony).¹¹

As Ms. Martini’s testimony makes clear, the data she analyzed showed sales “by units.” 215 TTABVUE 56. In its objections, GC now claims—without citation to evidence in the record—that Ms. Martini calculated the number of individual small cigars sold, not “units” sold, as she testified (based on documents produced by GC). GC claims that a “unit” of small cigars is a tin of 6-10 small cigars. 367 TTABVUE 108-09.

If GC believed Ms. Martini’s reference to “units” was incorrect or misleading, it could have cross-examined Ms. Martini, or submitted testimony or other evidence to contradict Ms. Martini’s testimony, but GC chose not to do either.

In any event, whether the data Ms. Martini analyzed was for individual GC Cohiba small cigars or tins of 6-10 GC Cohiba small cigars, it is clear that U.S. consumers [REDACTED]

¹¹ GC’s claim that its small Cohiba cigars sell for \$19-\$23 refers to GC’s “suggested retail price.” 367 TTABVUE 108.

Id.

43.

Declaration No. 3 of Annalisa Martini			
<u>GC's Description</u>	<u>GC's Citation to TTABVUE No.</u>	<u>GC's Objection</u>	<u>GC's Identification of Pages Where CT Cites to Evidence in its Trial Brief</u>
Paragraph 26	215 TTABVUE	FRE 401, 403 – Relevancy	365 TTABVUE 39

RESPONSE:

CT does not cite to this testimony in its Trial or Rebuttal Briefs. This testimony shows that many hundreds of thousands of U.S. persons travel to Cuba each year and this evidence, [REDACTED]

[REDACTED]), is relevant to show the recognition and renown of the Cuban Cohiba cigar in the U.S. and the extent of potential confusion (fifth and twelfth *du Pont* factors) and CT's Eighth Ground for Cancellation (section 14(3); 15 U.S.C. § 1604(3), misrepresentation of source, or permitting others to misrepresent source, as to which the renown and reputation of the mark in the U.S. is relevant, *see, e.g., The Coca-Cola Co. v. Meenaxi Enter., Inc.*, 2021 USPQ2d 709 (TTAB 2021)).

In any event, this objection should be overruled as it goes to the weight of the testimony and, in situations such as this, the Board admits the evidence and decides what weight it deserves. *See* CT's Response to GC's Evidentiary Objection No. 1.

44.

Declaration No. 2 of Annalisa Martini			
<u>GC's Description</u>	<u>GC's Citation to TTABVUE No.</u>	<u>GC's Objection</u>	<u>GC's Identification of Pages Where CT Cites to Evidence in its Trial Brief</u>
This evidence includes "calculations" comprising of a small number of social media posts on Facebook, Twitter, and Instagram selected by CT's attorney that include mistaken tags or add hashtags referencing "Cuba" or "Cuban" to photos of GC's Cohiba or "likes" to the selected	218-220 TTABVUE	FRE 401, 403, 802 – Relevancy; Prejudice, and Hearsay	365 TTABVUE 46

posts.			
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RESPONSE:

Ms. Martini’s testimony and evidence as to actual confusion and the engendering of confusion on social media is not hearsay, as GC asserts. These near one hundred (100) social media posts, and Ms. Martini’s analysis of same, do not contain any out of court statements by a third-party that CT *is offering for the truth of the matter stated* in the social media posts; rather, they are only offered for what they show on their face—namely, that scores of social media users with hundreds of thousands (100,000s) of followers on all three of the most popular social media platforms—Twitter, Instagram and Facebook—show images of only the Cuban Cohiba cigar and link those images to GC’s social media accounts for its Cohiba cigar, or show images of the GC Cohiba cigar with the hashtags #cuba, #cuban, #cubancigar or #cubancigars, or link to accounts dedicated to the Cuban Cohiba cigar. 218, 219 TTABVUE. Even these near 100 posts were “representative samples” of other social media posts, produced to GC, that demonstrate confusion and engendering confusion, which GC could have explored had it chose to cross-examine Ms. Martini—which it did not.

Moreover, many of these user posts of the Cuban Cohiba are shown on GC’s own Cohiba social media accounts, thus engendering confusion between the GC and Cuban Cohiba. *Id.* GC has not removed these posts from its Cohiba social media accounts, even though it can. 349 TTABVUE 1319-1325 (Maturen, Senior Brand Manager); 217 TTABVUE 42-43 (¶ 18, GC can remove posts).

Given the frequency of these posts by U.S. cigar consumers linking the GC and Cuban Cohiba, the logical inference the Board can and should draw from such posts is that there are U.S. cigar consumers that: are actually confused between the Cuban and GC Cohiba; and do not know that the U.S. embargo prohibits the sale of Cuban cigars in the United States. This is the only “common denominator” that can explain the frequency of such posts. *See* CT Response to GC Evidentiary Objection No. 19 (citing *The Finance Company of America*, 205 U.S.P.Q. at 1035). Even if the Board finds that they do not show actual confusion or a lack of awareness of the embargo, they clearly show how confusion is likely engendered among the hundreds of thousands of followers of these social media users as well as “how and why confusion is likely.”

The cases GC relies upon in its objection are inapposite. By stark contrast to the situation here, in *Ethika, Inc. v. Hage-Buotros*, petitioner’s social media evidence consisted of: (1) a single Facebook post showing someone wearing one party’s clothing but tagging to the other party’s social media account; and (2) a “few social media and web posts” that tag both party’s names. Canc. No. 9206368, 2020 WL 6306141, at *4-5 (TTAB Oct. 26, 2020) (Non-Precedential).

Similarly, in *Codename Enterprises, Inc. v. Fremantlemedia North America, Inc.*, the court held that, although a “closer call” than other evidence of actual confusion, plaintiff’s submission of “at best” five tweets referencing defendant’s television show but tagging plaintiff’s Twitter account was not actual confusion in part because of the “relatively low number” of miscommunications. No. 16-cv-1267, 2018 WL 3407709, at *10-11 (S.D.N.Y. Jan. 12, 2018). Even then, just as the Board, at a minimum, should do here, the court held that these instances “imply ‘how easily consumers might be confused.’” *Id.* at *11.

In *Reply All Corp. v. Gimlet Media, LLC*, the Second Circuit held that “several” instances of social media tagging—there were eight (8) in total, *id.* Case No. No. 20-952, ECF 66, at 180-93 (Joint Appendix Vol II) (2d Cir. July 27, 2020)—“without more” do not suggest confusion. Here there are more than “several”/eight instances, in addition to much “more” evidence of actual confusion. 843 Fed. Appx. 392, 397 (2d Cir. 2021); *see* 365 TTABVUE 43-47 (citing other evidence of actual confusion).

This testimony and evidence are also relevant to show the recognition and renown of the Cuban Cohiba in the United States and extent of potential confusion (fifth and twelfth *du Pont* factors) and CT’s Eighth Ground for Cancellation (section 14(3); 15 U.S.C. § 1604(3), misrepresentation of source, or permitting others to misrepresent source, as to which the renown and reputation of the mark in the U.S. is relevant, *see, e.g., The Coca-Cola Co. v. Meenaxi Enter., Inc.*, 2021 USPQ2d 709 (TTAB 2021)).

GC makes no specific argument concerning prejudice, nor is there any.

These objections also should be overruled as they go to the weight of the testimony and, in situations such as this, the Board admits the evidence and decides what weight it deserves. *See* CT’s Response to GC’s Evidentiary Objection No. 1.

45.

Declaration of Susan Bailey			
<u>GC's Description</u>	<u>GC's Citation to TTABVUE No.</u>	<u>GC's Objection</u>	<u>GC's Identification of Pages Where CT Cites to Evidence in its Trial Brief</u>
Paragraphs 2-31	221 TTABVUE	FRE 1006 – Best Evidence Rule	365 TTABVUE 44, 46, 53

RESPONSE:

The “best evidence rule” does not prohibit a witness from summarizing, under Fed. R. Evid. 1006, evidence already admitted. 31 Fed. Prac. & Proc. Evid. § 8043 (1st ed.) (“If the underlying evidence is already admitted, there is no concern that a summary is used in lieu of the ‘best evidence.’”); *Wealthmark Advisors Inc. v. Phoenix Life Ins. Co.*, 804 F. App'x 229, 233 (5th Cir. 2020) (“Rule 1006 operates as an exception to the best evidence rule”). GC cites to no authority to support its position.

Contrary to GC's unfounded assertion, 367 TTABVUE 110-11, Ms. Bailey's testimony does not include any “legal argument,” which is obvious on the face of her testimony; it consists of reproductions of descriptions of GC's Cohiba cigar on numerous different major U.S. cigar retailer websites. 221 TTABVUE 2-21, 28-29.

In addition, this objection should be overruled as it goes to the weight of the testimony and, in situations such as this, the Board admits the evidence and decides what weight it deserves. *See* CT's Response to GC's Evidentiary Objection No. 1.

46.

Declaration of Susan Bailey			
<u>GC's Description</u>	<u>GC's Citation to TTABVUE No.</u>	<u>GC's Objection</u>	<u>GC's Identification of Pages Where CT Cites to Evidence in its Trial Brief</u>
Paragraphs 33-45	221 TTABVUE 21-28	FRE 401, 602, 802 – Relevancy; Lack of Foundation; Hearsay	365 TTABVUE 41

RESPONSE:

GC has waived its objections as it failed to cross-examine Ms. Bailey or otherwise object promptly to the admissibility of her testimony. *See* CT’s Response to GC’s Evidentiary Objection No. 11.

Ms. Bailey’s testimony in these paragraphs is relevant to show the public recognition and renown of the Cuban Cohiba in the United States (the fifth *du Pont* factor), CT’s prior analogous use of the Cuban Cohiba in the United States (section 2(d), CT’s Sixth Ground for Cancellation), CT’s intention to sell the Cuban Cohiba cigar in the United States as soon as U.S. law permits, CT’s Eighth Ground for Cancellation (section 14(3); 15 U.S.C. § 1604(3), misrepresentation of source, or permitting others to misrepresent source, as to which the renown and reputation of the mark in the U.S. is relevant, *see, e.g., The Coca-Cola Co. v. Meenaxi Enter., Inc.*, 2021 USPQ2d 709 (TTAB 2021)), in addition to refuting GC’s claim that CT does not promote the Cuban Cohiba in the United States. *See, e.g.,* 367 TTABVUE 48 & n.30.

In them, Ms. Bailey is merely identifying the universe of news articles within an identified date range in identified Westlaw and Lexis databases of U.S. newspapers that included the terms “Cohiba” and “cigar.” All of these articles were produced to GC either during the Federal Action between the Parties or in this proceeding (which GC does not contest).

These articles were separately analyzed and summarized by Christina Licata in her declaration. *See* 226 TTABVUE 6-53. Both Ms. Bailey and Ms. Licata explain this in their respective declarations. Such articles (or an analysis under Fed. F. Evid. 1006 of same) are not inadmissible under the caselaw GC relies upon, which concerns the admissibility of Google search results without producing the resulting materials themselves.

These objections also should be overruled as they go to the weight of the testimony and, in situations such as this, the Board admits the evidence and decides what weight it deserves. *See* CT’s Response to GC’s Evidentiary Objection No. 1.

47.

Declaration of Susan Bailey			
<u>GC’s Description</u>	<u>GC’s Citation to</u>	<u>GC’s Objection</u>	<u>GC’s Identification of Pages Where CT</u>

	<u>TTABVUE No.</u>		<u>Cites to Evidence in its Trial Brief</u>
Paragraph 49 and Annex 30	221 TTABVUE 30-31, 129- 165	FRE 401 – Relevancy	365 TTABVUE 46

RESPONSE:

CT does not cite to this testimony or related evidence in its Trial or Rebuttal Briefs.

In any event, this testimony and related evidence are relevant to show GC’s bad faith intention of creating or enhancing confusion as to source, affiliation, association, business connection, authorization or approval and exploiting the renown of the Cuban COHIBA cigar among U.S. consumers by linking its cigar with the Cuban cigar (*du Pont* Factor 13) as well as GC’s misrepresentation of the source of GC’s Cohiba cigar, falsely connecting it to the Cuban Cohiba cigar. *See, e.g., Brookfield Communications, Inc. v. West Coast Entertainment Corp.*, 174 F.3d 1036, 1055 (9th Cir. 1999) (“The domain name is more than a mere address: like trademarks, second-level domain names [the part of the address before “.com” or “.net”] communicate information as to source”); *see also PACCAR Inc. v. TeleScan Technologies, L.L.C.*, 319 F.3d 243, 250, 254 (6th Cir. 2003) (“words in many domain names can and do communicate information as to the source or sponsor of the web site”; “the use of a contested mark with knowledge of the protected mark at issue can support a finding of intentional copying”) (internal citation omitted). It is also relevant to show the public recognition and renown of the Cuban Cohiba in the United States (the fifth *du Pont* factor). CT was not able to obtain additional documents concerning these domain name registrations because GC improperly did not disclose them during discovery and CT did not discover GC’s failure until after the testimonial period had opened.

This objection also should be overruled as it goes to the weight of the testimony and, in situations such as this, the Board admits the evidence and decides what weight it deserves. *See* CT’s Response to GC’s Evidentiary Objection No. 1.

Declaration of David B. Goldstein			
<u>GC's Description</u>	<u>GC's Citation to TTABVUE No.</u>	<u>GC's Objection</u>	<u>GC's Identification of Pages Where CT Cites to Evidence in its Trial Brief</u>
Annexes A-B Printouts from US cigar retailer websites	222 TTABVUE	FRE 401 – Relevancy	N/A

RESPONSE:

This testimony is relevant to show that *for many years* U.S. online cigar retailers, including the largest U.S. online cigar retailers, have misrepresented the source of the GC's Cohiba cigar, falsely connecting it to the Cuban Cohiba cigar. It is also relevant to show GC's bad faith in that it has refused to stop these internet retailers from falsely making this association even though GC recognized back in 2004 that this association was inappropriate and that it would "immediately communicat[e] to its customers that unless they cease advertising its COHIBA as having any association with the Cuban COHIBA, General Cigar will stop shipping them any more COHIBA cigars." 365 TTABVUE 49, *citing* 171 TTABVUE 680-82, 685.

This evidence is also relevant to show the public recognition and renown of the Cuban Cohiba in the United States and extent of potential confusion (the fifth and twelfth *du Pont* factors) and CT's Eighth Ground for Cancellation (section 14(3); 15 U.S.C. § 1604(3), misrepresentation of source, or permitting others to misrepresent source, as to which the renown and reputation of the mark in the U.S. is relevant, *see, e.g., The Coca-Cola Co. v. Meenaxi Enter., Inc.*, 2021 USPQ2d 709 (TTAB 2021)).

This objection also should be overruled as it goes to the weight of the testimony and, in situations such as this, the Board admits the evidence and decides what weight it deserves. *See* CT's Response to GC's Evidentiary Objection No. 1.

Declaration of Alan Willner			
<u>GC's Description</u>	<u>GC's Citation to TTABVUE No.</u>	<u>GC's Objection</u>	<u>GC's Identification of Pages Where CT Cites to Evidence in its Trial Brief</u>
Paragraph 11 Testimony related to statements Moosylvania made to Willner that "U.S. cigar customers were confused between the General Cigar and Cuban COHIBA cigars."	223 TTABVUE 5	FRE 802 – Hearsay	365 TTABVUE 41

RESPONSE:

This testimony is not hearsay, as GC asserts. 367 TTABVUE 113. He testified as to the content of reports that he and others at GC received from GC's agent, Moosylvania. His testimony as to his receipt of these reports is based on personal experience, and is not hearsay. The content of the reports themselves is not hearsay because they qualify as an opposing party's statements. *See* CT Response to GC Evidentiary Objection No. 29. (*citing* Fed. R. Evid. 801(d)(2)(D)).

Moreover, Moosylvania's statements are admissible under the business records, present sense and the state of mind hearsay exceptions. Fed. R. Evid. 803(1), (3), (6); *See* CT Response to GC Evidentiary Objection No. 29.

GC also is judicially estopped from presenting this objection as GC relied on similar testimony in obtaining a permanent injunction in a separate trademark infringement action concerning its COHIBA registrations it brought against a third party. 169 TTABVUE 12-13 (¶¶ 30-31) (evidence from *General Cigar Co., Inc. vs. Cohiba Caribbean's Finest, Inc., et al.*, Case No. 2006-cv-00575, U.S. District Court for the District of Nevada, in which GC asserted actual confusion based on testimony by a cigar store owner that his sales staff received questions from consumers about whether yellow band COHIBA cigars were related to General Cigar's COHIBA).

GC mischaracterizes the testimony it objects to. Mr. Willner [REDACTED]

[REDACTED]

GC also mischaracterizes Mr. Willner’s testimony that he only “sometimes” reviewed the Moosylvania reports. 367 TTABVUE 113. As GC is well aware, Mr. Willner corrected that testimony during his cross-examination to state that he *always* reviewed these reports (to which correction GC does not object). 361 TTABVUE 10-11 (7:17-8:16)

50.

Declaration of Alan Willner			
<u>GC’s Description</u>	<u>GC’s Citation to TTABVUE No.</u>	<u>GC’s Objection</u>	<u>GC’s Identification of Pages Where CT Cites to Evidence in its Trial Brief</u>
Paragraphs 13-15 Willner’s testimony that GC’s Cohiba brand “had the strongest Cuban brand association among General Cigar brands with Cuban brand associations”	223 TTABVUE 6	FRE 602 – Lack of Foundation	365 TTABVUE 44

RESPONSE:

Mr. Willner never “admitted” that his testimony that GC’s Cohiba brand “had the strongest Cuban brand association among General Cigar brands with Cuban brand associations” was an “exaggeration and not based on empirical data,” as GC alleges, either in the portion of his cross-examination cited by GC or otherwise. 367 TTABVUE 113-14. He testified that “every opinion that [he] expressed in [his] declaration [is] still [his] opinion” as of the date of his cross-examination and that he “maintain[ed] that everything that is stated as a fact in [his] declaration [wa]s true as of” the date of his cross-examination, other than the start date of another job (¶ 63) and that he always reviewed the quarterly reports that Moosylvania sent GC (¶ 37). 361 TTABVUE 9-11 (7:21-9:8).

This testimony is based on Mr. Willner’s more than five-years experience as GC’s Vice-President of Marketing as well as its President, including, without limitation, his “interact[ions] with many premium cigar consumers in the United States each year” “[d]uring [his] work at General Cigar over the course of five and a half years . . .” 223 TTABVUE 4, 7, as well as “the information the [GC] Marketing Department

had concerning consumers and the marketplace.” 223 TTABVUE 3, 6 (¶¶ 1, 13).

Furthermore, his opinion is supported by GC’s final 2017 brand plan for its Cohiba cigar, presented and approved by GC at the highest levels, including its parent corporation, that states that GC’s Cohiba has the “Strongest Cuban brand association.” 349 TTABVUE 89-90, 94, 375; 351 TTABVUE 68-70 (68:19-70:16)

That U.S. cigar consumers may also associate other cigar brands with Cuba is of no import. No doubt U.S. cigar consumers also confuse those other brands with their Cuban counterparts [REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED] However, the Board need not address that issue, as this proceeding is not about those other cigar brands.

GC’s argument that, because other cigar brands may be associated with Cuba, there is no likelihood of confusion between the GC and Cuban Cohiba cigar, also ignores the fact that both Mr. Willner [REDACTED] [REDACTED] state that GC’s Cohiba has the “*strongest*” Cuban association, *see supra* (emphasis added), meaning the connection in U.S. consumers’ minds between GC’s Cohiba cigar and Cuba *is stronger than* these consumers’ connections between other cigar brands and Cuba.

Moreover, GC’s argument flies in the face of [REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

Declaration of Alan Willner			
<u>GC's Description</u>	<u>GC's Citation to TTABVUE No.</u>	<u>GC's Objection</u>	<u>GC's Identification of Pages Where CT Cites to Evidence in its Trial Brief</u>
Paragraph 17 Testimony that “most cigar consumers in the U.S. believed that Cuban cigars were the highest quality and best cigars in the world.”	223 TTABVUE 6	FRE 701, 802 -- Lay Opinion on Legal Issues; Hearsay	365 TTABVUE 44

RESPONSE:

CT does not cite to Paragraph 17 of Mr. Willner's declaration, neither on page 44 of CT's Trial Brief, as GC indicates, or otherwise.

In any event, this testimony is admissible. It does not lack foundation. Mr. Willner is GC's former President and long-time Vice-President of Marketing. 223 TTABVUE 2. This testimony is lay opinion rationally based on his perceptions, namely his “interact[ions] with many premium cigar consumers in the United States each year” “[d]uring [his] work at General Cigar over the course of five and a half years . . .” 223 TTABVUE 4, 7.

He testified that he visited seventy (70) premium cigar stores each year, 361 TTABVUE 46-7 (44:18-45:19), and that [REDACTED]

[REDACTED] Mr. Willner also attended “25 to 30” “evening cigar events involving consumers,” some big ones like at the Big Smoke cigar convention and others “in the marketplace” at GC's tobacconists. 361 TTABVUE 47-48 (45:20-46:19).

It is also not hearsay, as there is no “statement” from a third party that Mr. Willner offers, let alone one that he offers to prove the truth of the matter asserted in the statement. 367 TTABVUE 114. He simply offers his opinion based on his extensive interactions with U.S. cigar consumers, including by asking them what their favorite cigars were.

GC never identifies what the “legal issues” are about which it purports Mr. Willner is improperly

opining. In any event, there are none.

52.

Declaration of Miguel Suarez Medina			
<u>GC's Description</u>	<u>GC's Citation to TTABVUE No.</u>	<u>GC's Objection</u>	<u>GC's Identification of Pages Where CT Cites to Evidence in its Trial Brief</u>
Paragraphs 20-23 and corresponding Annexes 19-26	225 TTABVUE 7-12, 376-419	FRE 701 – Unqualified Lay Opinion	365 TTABVUE 40, 42, 46, 47, 50

RESPONSE:

Mr. Suarez Medina's testimony is not unqualified lay opinion. He testifies as to *his actual experience* in: (1) going to several online articles *about the Cuban Cohiba cigar*; (2) clicking on the hyperlinked word "Cohiba" the author included in the article; and (3) identifying where that link sent him—to GC's website for its Cohiba cigar. 225 TTABVUE 7-12.

In addition, the source code for that article is available to the public and he downloaded it. It shows that the same sentence in the article he reviewed with the hyperlinked word "Cohiba" includes, in the source code, the website address for GC's Cohiba cigar, www.cohiba.com right after the hyperlinked word "Cohiba." This is consistent with Mr. Medina's testimony as to his personal experience of being sent to the GC's Cohiba website when he clicked on the hyperlinked word "Cohiba" in the article.

Moreover, GC has waived its objections as it failed to cross-examine Mr. Suarez Medina or otherwise object promptly to the admissibility of his testimony. *See* CT's Response to GC's Evidentiary Objection No. 11.

If GC thought his testimony was inaccurate, it could have cross-examined him or presented contrary evidence. It chose to do neither.

Declaration of Miguel Suarez Medina			
<u>GC's Description</u>	<u>GC's Citation to TTABVUE No.</u>	<u>GC's Objection</u>	<u>GC's Identification of Pages Where CT Cites to Evidence in its Trial Brief</u>
Paragraphs 26-27 and Annexes 29-30	225 TTABVUE 12-13	FRE 401, 802 – Relevancy; Hearsay	365 TTABVUE 40, 42, 46, 47, 50

RESPONSE:

Mr. Suarez Medina's testimony concerning the offering for sale of the Cuban and GC Cohiba cigars in various cities in the United States on Craigslist is relevant to show: that both cigars are offered for sale in the same channels within the United States; as well as the public recognition and renown of the Cuban Cohiba in the United States (the third and fifth *du Pont* factors); and CT's Eighth Ground for Cancellation (section 14(3); 15 U.S.C. § 1604(3), misrepresentation of source, or permitting others to misrepresent source, as to which the renown and reputation of the mark in the U.S. is relevant, *see, e.g., The Coca-Cola Co. v. Meenaxi Enter., Inc.*, 2021 USPQ2d 709 (TTAB 2021)).

It is also relevant to show that cigar consumers do not know whether it is illegal to sell Cuban cigars in the United States, as numerous individuals are openly selling Cuban cigars in the United States on a public and hugely popular online marketplace.

This testimony is not hearsay as it is not offered for the truth of the matter asserted—that these sales took place—but rather what the documents show on their face, that the Cuban Cohiba cigar is openly offered for sale across the United States.

In addition, Mr. Suarez Medina has provided GC with the “complete articles or supporting evidence,” contrary to GC's assertion otherwise. 367 TTABVUE 114-15. They are the bates numbered documents referenced in his testimony.

GC's registration of the term “Cohiba” on the U.S. Customs and Border Protection's Intellectual Property Rights Search database pursuant to 19 C.F.R. § 133.22(a), which bar the importation of products bearing a mark that so resembles the recorded mark “as to be likely to cause the public to associate [the

foreign mark] with the recorded mark,” without any exception for the Cuban Cohiba, is relevant to show that GC has conceded that there is a likelihood of confusion between the GC and Cuban Cohiba. 365 TTABVUE 42.

Even if Mr. Suarez Medina’s downloading of GC’s registration of “Cohiba” from the U.S. Customs and Border Protection’s Intellectual Property Rights Search database were hearsay, which it is not, it qualifies for the “public records” exception. Fed. R. Evid. 803(8).

There is no obligation that the witness provides his “search history,” as GC claims without citation to any authority holding same. 367 TTABVUE 114-15.

If GC thought his testimony was inaccurate, it could have cross-examined him or presented contrary evidence. It chose to do neither.

These objections also should be overruled as they go to the weight of the testimony and, in situations such as this, the Board admits the evidence and decides what weight it deserves. *See* CT’s Response to GC’s Evidentiary Objection No. 1.

54.

Declaration of Miguel Suarez Medina			
<u>GC’s Description</u>	<u>GC’s Citation to TTABVUE No.</u>	<u>GC’s Objection</u>	<u>GC’s Identification of Pages Where CT Cites to Evidence in its Trial Brief</u>
Paragraphs 37-43 and corresponding Annexes 40-42	225 TTABVUE 52-54, ¹² 514-791	FRE 401, 403 – Relevancy	365 TTABVUE 40, 42, 46, 47, 50 ¹³

RESPONSE:

CT does not cite to this testimony or evidence in its Trial or Rebuttal Briefs. In any event, this testimony shows that many hundreds of thousands of U.S. persons travel to Cuba each year. This evidence,

¹² GC erroneously cites to 225 TTABVUE 52-54; the cited paragraphs are on pages 53-55

¹³ GC erroneously indicates that CT cites to Paragraphs 37-43 or Annexes 40-42 on these pages of CT’s Trial Brief. CT does not rely on this testimony or evidence.

[REDACTED], is relevant to show the recognition and renown of the Cuban Cohiba cigar and the extent of potential confusion (fifth and twelfth *du Pont* factors) and CT's Eighth Ground for Cancellation (section 14(3); 15 U.S.C. § 1604(3), misrepresentation of source, or permitting others to misrepresent source, as to which the renown and reputation of the mark in the U.S. is relevant, *see, e.g., The Coca-Cola Co. v. Meenaxi Enter., Inc.*, 2021 USPQ2d 709 (TTAB 2021)).

This objection also should be overruled as it goes to the weight of the testimony and, in situations such as this, the Board admits the evidence and decides what weight it deserves. *See* CT's Response to GC's Evidentiary Objection No. 1.

55.

Declaration of Miguel Suarez Medina			
<u>GC's Description</u>	<u>GC's Citation to TTABVUE No.</u>	<u>GC's Objection</u>	<u>GC's Identification of Pages Where CT Cites to Evidence in its Trial Brief</u>
Paragraphs 50-51	225 TTABVUE 59-60	FRE 602; 802 – Lack of Foundation; Hearsay	365 TTABVUE 40, 42, 46, 47, 50

RESPONSE:

GC has waived its hearsay and lack of foundation objections as it failed to cross-examine Mr. Suarez Medina or otherwise object promptly to the admissibility of his testimony. *See* CT's Response to GC's Evidentiary Objection No. 11.

In any event, CT does not cite to this testimony or evidence in its Trial or Rebuttal Briefs, either on the pages GC indicates in its Evidentiary Objections or otherwise.

Declaration of Christina Licata			
<u>GC's Description</u>	<u>GC's Citation to TTABVUE No.</u>	<u>GC's Objection</u>	<u>GC's Identification of Pages Where CT Cites to Evidence in its Trial Brief</u>
Paragraphs 4-11	226 TTABVUE 10-42	FRE 602 Lack of Foundation; Best Evidence Rule	29, 31, 32, 33, 34, 46 ¹⁴

RESPONSE:

GC has waived its lack of foundation objection as it failed to cross-examine Mr. Licata or otherwise object promptly to the admissibility of her testimony. *See* CT's Response to GC's Evidentiary Objection No. 11.

This objection should also be overruled because Ms. Licata properly summarized the content of voluminous writings that CT had previously produced to GC. Specifically, Ms. Licata reviewed a voluminous universe of news articles (thousands of pages), article-by-article, and summarized the content of those news articles. Other witnesses—Ms. Bailey, 221 TTABVUE 21-28, and Ms. Martini, 215 TTABVUE 33-37—testified as to how that universe of news articles was identified and produced to GC.

Ms. Licata does not, as GC claims, “merely rel[y] on a summary made by someone else to resummarize the information;” nor does she present any “legal arguments on confusion.” Therefore, GC's argument that her testimony is “an evasion” on the Board's page limits makes no sense. Her testimony is a classic Fed. R. Evid. 1006 summary. 367 TTABVUE 116-17.

If GC wanted to challenge Ms. Licata—or Ms. Bailey or Ms. Martini—as to what actions they took, the selection of the universe of news articles or the accuracy of their testimony, it could have cross-examined them, or submitted contradictory evidence, but GC chose to do neither.

¹⁴ CT assumes GC neglected to include “365 TTABVUE” in its citation.

Second Declaration of Susan Bailey			
<u>GC's Description</u>	<u>GC's Citation to TTABVUE No.</u>	<u>GC's Objection</u>	<u>GC's Identification of Pages Where CT Cites to Evidence in its Trial Brief</u>
	308-311 TTABVUE	Improper Rebuttal FRE 401, 403, 602; 701(a) – Relevancy; Cumulative Evidence; Lack of Foundation; Speculative Opinion Testimony From Unqualified Lay Witness	365 TTABVUE 52

RESPONSE:

Ms. Bailey's testimony in her Second Declaration provides evidence to refute: (A) GC's novel argument for which *it* bear the burden that, because of the existence of the U.S. embargo, U.S. cigar consumers know that Cuban cigars cannot be sold in the United States and, therefore, contrary to CT's showing during its trial period, there is not a likelihood of confusion; (B) GC's attack on CT's evidence of actual confusion and that U.S. retailers misrepresented the source of GC's Cohiba cigar, falsely connecting it to the Cuban Cohiba cigar; (C) GC's allegation that its Cohiba cigars sell only for "\$10 or more"; and (D) GC's assertion that the trade dress and bands of the GC and Cuban Cohiba cigars are "clearly different" and each of GC's Cohiba "contain a clear statement of the country of manufacture." *See infra*.

A. Rebuttal Evidence Concerning GC's Embargo Argument

In its trial period, CT showed that there is a likelihood of confusion for: two identical, fanciful and arbitrary marks; one of which is the Cuban Cohiba mark, that indisputably is publicly recognized and renowned in the United States; for identical good, cigars, whose least sophisticated consumer buys at liquor or convenience stores or gas stations for a buck or less. 365 TTABVUE 37-50 (also analyzing the other *du Pont* factors).

Faced with this "open and shut" likelihood of confusion case, *id.* at 37, GC argues that this case is "unique" because U.S. consumers' purported knowledge of the U.S. embargo against Cuba distinguishes this case. 367 TTABVUE 45-48.

To the extent such purported knowledge is relevant at all to the likelihood of confusion analysis, it is GC's, not CT's, burden to come forward with evidence on this issue. *See, e.g., In re Jonathan Drew, Inc.*, 97 USPQ2d 1640 (TTAB 2011) (it is applicant's burden to come forward with evidence of impact of embargo on U.S. consumer perception in primarily geographically deceptively misdescriptive case); *Minnesota Mining and Manufacturing Co. v. Stryker Corp.*, 179 USPQ 433, 434 (TTAB Aug. 23, 1973) ("Opposer was under no obligation to refute a claim of secondary meaning until and when it was offered by applicant. Thus, it is our opinion that, in this case, this testimony constitutes proper rebuttal"). This is especially true since GC's Vice-President admitted in another proceeding in 2006 that, despite more than forty-five (45) years of the embargo at that point, U.S. consumers did *not* know about the U.S. embargo against Cuban cigars or that Cuban Cohiba cigars could not legally be sold in the United States. *See* CT's Response to GC's Evidentiary Objection No. 28. GC's testimony concerning U.S. consumers' knowledge of the U.S. embargo is, in essence, an unpleaded defense.

This is just the kind of evidence that CT is entitled "to explain, repel, counteract, or disprove" during its rebuttal period. *Belden Inc. v. Berk-Tek LLC*, 805 F.3d 1064, 116 USPQ2d 1869, 1883 (Fed. Cir. 2015). Here, CT came forward with evidence that, contrary to GC's self-serving statements about U.S. consumers' purported knowledge of the embargo, numerous U.S. consumers do not know whether it is legal or illegal to purchase Cuban cigars in the United States, even if others may. 308 TTABVUE 29-37 (Second Bailey Declaration and exhibits cited therein). It introduced:

- A page from GC's own website for U.S. cigar consumers on which one of only nine (9) "Frequently Asked Questions" is "Are Cuban cigars legal in the United States?" 308 TTABVUE 31. This Frequently Asked Question was added to GC's cigar consumer website *after* CT's trial period. *Id.* (published in December 2019);
- Numerous U.S. consumers on Reddit asking whether it is legal or illegal to purchase Cuban cigars in the United States. 308 TTABVUE 31-37; and
- Evidence that there are frequent searches on the internet in the United States to try to find out whether it is legal or illegal to purchase Cuban cigars in the United

States. 308 TTABVUE 29-31.

It is of no consequence that some (but not all) of this evidence was available to CT prior to its rebuttal period. CT was under no obligation to present evidence during its trial period to rebut evidence that GC was under an obligation to come forward with.

Moreover, some of this evidence post-dates CT's trial period. 308 TTABVUE 11 (¶7), 18 (¶10), 19 (¶11), 22 (¶16), 24-25 (¶20), 25 (¶21), 26 (¶22), 31 (¶27), 34 (¶31), 35 (¶32), and 35 (¶33) and exhibits cited therein (Second Bailey Declaration).

B. Rebuttal Evidence Concerning Actual Confusion

Under Board precedent, when, as here, (i) a petitioner has come forward with evidence establishing a *prima facie* case of likelihood of confusion and (ii) the respondent has chosen to attack one or more portions of that evidence, the petitioner may come forward with evidence that rebuts, denies, explains, or discredits that attack, even if that rebuttal evidence could have been presented in petitioner's case-in-chief. *See Sprague Elec. Co., Inc. v. Elec. Utilities Co.*, 209 USPQ 88, 93 (TTAB 1980); *accord Nationwide Consumer Testing Inst., Inc. v. Consumer Testing Lab'ys, Inc.*, 159 USPQ 304, 310 (TTAB 1968) ("applicant by choosing ... [to present testimony] to establish, notwithstanding, opposer's evidence-in-chief, exclusivity of the term ... and the absence of knowledge by the witness and thereby of applicant of use of this or a similar term by anyone else reopened this entire question thereby entitling [opposer] to reply to or rebut any implication or assumption that might be drawn from such testimony"); *Finance Co. v. BankAmerica Corp.*, 205 USPQ 1016, 1022 (TTAB 1980); *see also Data Packaging Corp. v. Morning Star, Inc.*, 212 USPQ 109, 113 (TTAB 1981) ("The fact that evidence might have been offered in chief does not preclude its admission as rebuttal. In such cases the trier of the facts has discretion to admit rebuttal testimony in the interest of fairness ... [including] in *inter partes* trademark proceedings before the Patent and Trademark Office").

In this proceeding, CT came forward in its Trial Brief with much more than a *prima facie* case of likelihood of confusion based on, *inter alia*, actual confusion, and that retailers misrepresent the source of the GC's Cohiba cigar, falsely connecting it to Cuba and the Cuban Cohiba cigar. 365 TTABVUE 42-47

(actual confusion), 44, 46 (retailers false association).

Nonetheless, GC chose to attack CT's evidence of actual confusion and retailers' association, claiming CT has "fail[ed] to present any current probative evidence of actual confusion," 367 TTABVUE 54, and mischaracterizing CT's evidence of retailer association as a "rare occurrence" from only a "handful" of retailers and alleging that "Most cigar catalogues and online retail offers make no reference at all to the CT Cohiba . . ." *see id.* at 50-54; 56.

In these circumstances, CT is entitled to rebut this attack, which it did through the still additional evidence of actual confusion and retailers' false association. 308 TTABVUE 5-18 (actual confusion) and 23-29 (retailer association) (and exhibits cited therein).

C. Rebuttal Evidence to Show that GC's Cohiba Cigars Do Not Only Sell for \$10 Or More

CT came forward in its Trial Brief with much more than a *prima facie* case that the only relevant metric is the least sophisticated potential cigar consumer who, because both GC's registrations and CT's application are for "cigars" without qualification as to category of cigar, is a purchaser of the least expensive cigars which are sold for a buck or less at liquor or convenience stores or at gas stations. 365 TTABVUE 40-42.

To the extent that GC addresses this showing at all in its Trial Brief, it appears to maintain that the relevant metric are purchasers: *not* of the least expensive cigars, which GC concedes sells for a buck or less; *not* even of premium cigars generally, which GC's Senior Brand Manager testifies the "vast majority of these [premium cigars sold at cigar shops] are less expensive than the least expensive [GC] COHIBA cigar," 283 TTABVUE 18 (¶ 33); but rather purchasers of *its* premium cigars which cost "\$10 or more." 367 TTABVUE 12-13, 49; 283 TTABVUE 5-6, 9, 17-18 (Abbot Dec. ¶¶ 8(e), 16, 31).

Not only should GC's argument be rejected because its registrations are not limited to premium cigars, let alone *its* premium cigars, but CT is also entitled to rebut GC's claim that GC's premium cigars only sell of \$10 or more, which CT did by presenting evidence in its rebuttal period to show that even GC's premium cigars are sold individually and for as little as \$2 to \$3 a cigar, significantly less than the \$10 minimum per cigar that GC claims. 308 TTABVUE 55-58 (Second Bailey Declaration).

D. Rebuttal Evidence Concerning GC's Trade Dress Argument

During its testimonial period, GC presented evidence, and subsequently argued, that “[p]otential and actual smokers of premium cigars know that the COHIBA cigar sold in the U.S. is ‘completely different and unconnected to the Cuban cigar,’ [because]. . . . the trade dress and bands of the COHIBA cigar sold in the U.S. have a clearly different appearance from those of the Cuban Cohiba,” 367 TTABVUE 46 (citing Hacker’s testimony), and that “the cigar band of each COHIBA cigar contain a clear statement of the country of manufacture.” 367 TTABVUE 17.

CT was under no obligation to address the trade dress of the GC and Cuban Cohiba cigars or GC’s country of origin evidence during its case-in-chief, *as this case is not a trade dress case*. GC does not contest that the marks at issue here are word marks and, as such, it is free to change its trade dress at any time. 365 TTABVUE 37 n.38; *see also, e.g.*, 355 TTABVUE 54 (52:17-23) (discussing one such change in trade dress).

Nonetheless, because GC has presented this trade dress argument, CT is entitled to refute same, which it did by Ms. Bailey’s extracting several iterations of the GC and Cuban Cohiba marks for comparison, as well as COHIBA marks used by third parties for which GC has claimed trademark infringement. 308 TTABVUE 59-61.

Ms. Bailey also testifies as to the extremely small size of the country of origin identification on several of GC’s Cohiba cigars—lettering that is 1/32 of an inch, which evidence GC does not contest—which she “could not find” “on any of these cigars” at first; she only found “[a]fter reviewing all parts of the bands very closely several times and in different lighting”; and she “would not have seen that the COHIBA Black, Blue, Red Dot and Connecticut cigars stated ‘Republica Dominicana’ on their bands had [she] not deliberately looked for these words” 308 TTABVUE 58. These GC Cohiba cigars are sold individually by U.S. retailers. 355 TTABVUE 53-54, 57-59, 61, 64 (51:24-52:16; 55:2-5; 56:23-57:1; 59:11-14; 62:8-11).

GC’s objection that Ms. Bailey’s testimony should not be admitted because she did not write every word of her declaration or that this testimony includes conclusions of law is unfounded. 367 TTABVUE

119-20. Prior to signing her declaration, Ms. Bailey reviewed each and every statement in her declaration and confirmed that they were true and correct. 364 TTABVUE 379-80 (165:8-166:6).

GC's objections also should be overruled as they go to the weight of the testimony and, in situations such as this, the Board admits the evidence and decides what weight it deserves. *See* CT's Response to GC's Evidentiary Objection No. 1.

58.

Alvin Ossip			
<u>GC's Description</u>	<u>GC's Citation to TTABVUE No.</u>	<u>GC's Objection</u>	<u>GC's Identification of Pages Where CT Cites to Evidence in its Trial Brief</u>
Designated Federal Action Plaintiff's Written Direct Testimony and Appendices of Alvin Ossip, CT market research expert	340 TTABVUE 002-305; 347 TTABVUE 296-1010	FRE 401, 703 – Relevancy; Inadmissible Expert Testimony	365 TTABVUE 13, 28, 29 ¹⁵

RESPONSE:

Alvin Ossip testified as a marketing research expert in the Federal Action in 2003, 340 TTABVUE 1- 56 (Direct Written Testimony), on two topics: (i) the extent of the Cuban Cohiba's reputation and renown in the United States prior to the first use date claimed in GC's application for its second registration of COHIBA (Dec. 31, 1992), and prior to GC's first shipment of Cohiba from the Dominican Republic on November 22, 1992, including as a result of *Cigar Aficionado's* premier issue, *id.* 6-31; and (ii) likelihood of confusion, *id.* 32-171. Ossip, who had 45 years of experience in market research and had testified in 18 cases as an expert by the time of his Federal Action testimony, 340 TTABVUE 4, was qualified to be an expert on both topics, as the District Court found, 338 TTABVUE 374 and GC conceded, *id.* 376, and the Court admitted his reports on both topics. 338 TTABVUE 374-76. In the current proceeding, GC took an extensive deposition of Ossip in June 2017. 347 TTABVUE 296-1010 (with exhibits). Just as it did in the Federal Action, GC does not challenge Ossip's qualifications to have given his Federal Action testimony

¹⁵ CT does not cite to Ossip's testimony or appendices on any of these pages.

as an expert.

CT has offered Ossip's Federal Action testimony on the Cuban COHIBA's pre-Dec. 31, 1992 and pre-Nov. 22, 1992 reputation and renown in the U.S., including as a result of *Cigar Aficionado's* premier issue (along with other evidence). P. Br. 28-29, P. Reply Br. 15. GC has *not* challenged the relevance and admissibility of Ossip's Federal Action testimony on that issue, which was extensive. 340 TTABVUE 6-31.

With respect to likelihood of confusion, Ossip testified in the Federal Action in part on the basis of the national survey he had conducted toward the end of 2000, which found 21% confusion among premium cigar smokers who had heard of Cohiba, and 15% (gender balanced)/16% (male) confusion among premium cigar consumers whether or not they had heard of Cohiba. 340 TTABVUE 40. The survey measured whether and the extent to which premium cigar consumers thought "the two products are made by the same company or that the companies have an affiliation, association or business connection with each other plus those who thought one company gave the other authorization or approval to use the name Cohiba" (association confusion). *Id.* 41-42.

CT offers Ossip's Federal Action testimony on likelihood of confusion, including his testimony based on this survey, for several reasons, each of which makes the Ossip testimony admissible.

First, GC argues that the embargo and knowledge of it "sharply minimize[s]" likelihood of confusion, R. Br. 43, and, indeed, this is the major thrust of GC's argument and the testimony of its expert, Hacker. R. Br. 43-4. CT argues in response, *inter alia*, that under the Board's precedents (and logically), GC cannot simply rely on the embargo, or the knowledge of same, on the assumption that it dispels confusion, but must prove with evidence that it dispels confusion. P. Br. 51-52; P. Reply Br. 17-18. In that connection, CT argues that the Ossip testimony and survey reinforces and heightens that burden, as they show that there was a likelihood of confusion *despite more than 40 years of the embargo*. P. Br. 48.

Further, CT argues that the testimony and survey show that the embargo is not in fact the cure that GC claims it to be. CT further argues that, although faced with this proof, GC has not come forward with sufficient proof to the contrary, including sufficient evidence to establish or reason to conclude that 60 years

of the embargo dispels confusion when 40 years did not. P. Br. 48.

Second, GC relies heavily on the cigar market being characterized by the presence of “parallel brands,” R. Br. 9-10; 45-47, which GC asserts “also minimizes the likelihood of confusion among cigar smokers.” *Id.*, at 45, as does Hacker. *Id.* at 45. GC asserts, in support of this position, that there has been this “‘parallel brands’ situation” “for a number of decades.” R. Br. 9. Hacker, GC’s expert, testified that parallel brands have been on the market since the early to mid- 1990’s in “great quantities” and that it was a situation “going on for 25 years.” 347 TTABVUE 133. CT offers Ossip’s testimony and survey to rebut this argument and testimony. His survey shows appreciable confusion despite the presence of parallel brands on the market in “great quantities,” and he testified specifically about “parallel brands” contributing to, rather than minimizing, confusion. 340 TTABUE 43-44. This challenges and disproves GC’s position that parallel brands on the market necessarily dispels confusion, and, further, addresses the effect of parallel brands on confusion for a time period on which GC specifically relies.

Third, GC rests its embargo argument principally on the testimony of its expert, Hacker, and principally relies on Hacker with respect to likelihood of confusion generally. P. Reply Br. 21-22. Hacker, in turn, expressly rests his 2020 opinion that there is no confusion on his “personal encounters with cigar consumers *over the last three decades*” – that is, 1970-2000 – and testifies that “he cannot recall a single instance in the *last fifteen years* “ – that is, in 2005 and thereafter – of a consumer indicating that he or she “was confusing the Cohiba cigar made by General Cigar with the Cohiba cigar made in Cuba” in his numerous encounters with them. 273 TTABVUE 8 (emphasis added). Ossip’s testimony in 2003, and his survey in late 2000, is contemporaneous with the experience upon which Hacker relies, and squarely rebuts and contradicts what Hacker claims. GC cannot have it both ways: it cannot rely on Hacker and object to Ossip.

Fourth, GC relies on the testimony of witnesses in the Federal Action in arguing there is no likelihood of confusion. R. Br. 44 (citing witness testimony in 342 TTAVUE and 343 TTABVUE). It has thus acknowledged that testimony from the period of the Federal Action is relevant and admissible, including, necessarily, Ossip’s. And, as with Hacker, GC cannot have it both ways.

Fifth, Ossip, at his deposition taken by GC in this proceeding, testified at length and with specificity that the same factors that engendered and reinforced consumer confusion when he testified in the Federal Action remain at work today, including the way retailers promote the GC Cohiba. He cited supporting evidence from the current marketplace. 347 TTABVUE 353-55, 711-34. Contrary to GC’s false suggestion in its Objections, Ossip testified that, for that as well as other reasons, it was his opinion that his Federal Action testimony and survey were relevant to the question of likelihood of confusion today. *Id.* 743 – 46; *see also id.* 346-355.

For each of these reasons, Ossip’s Federal Action testimony and survey is relevant and admissible. GC’s objections go to weight, which the Board can evaluate, not relevance or admissibility. There is no prejudice to GC in admitting the offered evidence, as GC had and took full opportunity to depose Ossip, and thus is fully able to argue weight.

59.

Alan Siegel			
<u>GC’s Description</u>	<u>GC’s Citation to TTABVUE No.</u>	<u>GC’s Objection</u>	<u>GC’s Identification of Pages Where CT Cites to Evidence in its Trial Brief</u>
Designated Federal Action Plaintiff’s Written Direct Testimony and Appendices of Alan Siegel, CT market research expert	340 TTABUE 306-745	FRE 401 – Relevancy	365 TTABVUE 28, 29

RESPONSE:

Alan Siegel testified as a branding and marketing expert in the Federal Action in 2003, 340 TTABVUE 306-753 (Direct Written Testimony and Appendices), on several topics, including: (i) the extent of the Cuban Cohiba’s reputation and renown in the United States prior to the first use date claimed in GC’s application for its second registration of COHIBA (Dec. 31, 1992), and prior to GC’s first shipment of Cohiba from the Dominican Republic on Nov. 22, 1992, including as a result of *Cigar Aficionado*’s premier issue; (ii) whether the 1982-1987 GC Cohiba retained any goodwill as of 1992; and (iii) the resemblance of GC’s design and trade dress for its 1992-1996 Cohiba product and its post-1997 product with the Cuban Cohiba’s; GC’s deriving its Cohiba’s design and trade dress from the Cuban Cohiba’s as revealed by, *inter*

alia, the documents produced by GC and its designers as to the steps taken in the design process; and whether the resemblance of design and trade dress was likely to cause confusion.

Siegel, pre-eminent in the field of branding and marketing with 35 years of experience, 340 TTABVUE 306-14, was qualified to testify on these topics as an expert, as the District Court found without objection by GC, 338 TTABVUE 608, and his report was admitted. *Id.* at 611. In the current proceeding, GC took an extensive deposition of Siegel, R. Br. 51, n.3. Just as it did in the Federal Action, GC does not challenge Siegel’s qualifications to have given his Federal Action testimony as an expert on the above topics.

CT has offered Siegel’s Federal Action testimony only on the above three topics. P. Br. 28-29; P. Reply Br. 15, 22-23. His testimony on those three topics is relevant to CT’s argument that cancellation of GC’s second registration is warranted on its claim of analogous use under section 2(d) of the Act and on its claim of misrepresentation of source under section 14 of the Act.

GC does *not* object to CT’s offer of Siegel’s Federal Action testimony on these three topics. It only objects to his testimony to the extent, if any, that his testimony about likelihood of confusion under section 2(d) is based on “the digital media research performed by Siegel over 20 years ago.” However, Siegel’s testimony is offered with respect to likelihood of confusion under section 2(d) on the basis of his comparative analysis of GC’s and the Cuban Cohiba’s design and trade dress and GC’s development of its design and trade dress, not his “digital media research.” The same comparative analysis of design and trade dress and the development of GC’s design and trade dress is also offered for its relevance to CT’s misrepresentation of source claim.

60.

Rene Labor			
<u>GC’s Description</u>	<u>GC’s Citation to TTABVUE No.</u>	<u>GC’s Objection</u>	<u>GC’s Identification of Pages Where CT Cites to Evidence in its Trial Brief</u>
Designated TTAB Discovery Deposition Transcript and Exhibits of Rene Labor, taken on July 25, 2018	348 TTABVUE 1724-1847	FRE 602, 701(a), 802 – Lack of Foundation,	365 TTABVUE 39, 42, 49

		Inadmissible Speculation; Hearsay	
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RESPONSE:

GC’s lack of foundation objection has no basis. Mr. Labor, a salesperson turned assistant manager at a major Florida premium cigar retailer, Neptune Cigar,¹⁶ testified in July 2018 that “*often*” inexperienced cigar consumers asked him “whether or not the Cohiba that [he was] showing them in the store is from Cuba.” He also testified 20%-30% of the consumers that came into his store were inexperienced smokers. 348 TTABVUE 1725, 1775-76 (55:16-56:21) (Labor) (emphasis added); *see also id.* at 1738-40 (14:7-16:18) (work history).

Mr. Labor was a salesman at Neptune Cigar in Miami, Florida from September 2013 to early 2016, during which time his “main duty was assisting customers”; in early 2016 he was promoted to assistant manager at the same retail location, where he stayed until December 2017 when “he wanted to do something different” with “a more consistent schedule” and so became a copywriter for Neptune Cigar. *Id.* at 1738-41 (14:7-15:5, 15:17-16:3, 17:8-24). As a salesperson and assistant manager, Mr. Labor interacted with “easily hundreds” of cigar consumers each week. *Id.* at 1773-74 (53:15-54:14).

Clearly, given Mr. Labor’s extensive experience assisting many thousands of cigar consumers, including many thousands of inexperienced cigar consumers, for over four (4) years immediately before trial, there is a foundation for Mr. Labor to testify as to what such inexperienced cigar consumers asked him about GC’s Cohiba cigar. Such testimony also is not speculation.

GC places much emphasis on Mr. Labor’s testimony that he was going by an “exaggerated sense of feel . . . because . . . it seems that way sometimes to me” when he posted to Neptune’s website back in 2016 that “Whenever I’m asked at the store if we carry Cohiba, 9 times out of 10 the person is referring to the Cuban variant.” 367 TTABVUE 121-22. However, as shown above, Mr. Labor, upon reflection and

¹⁶ Neptune Cigar is one of only sixteen cigar retailers to which GC links its Cohiba website, www.cohiba.com. 200 TTABVUE 8, 563-74.

further questioning, later re-affirmed that *when limited to inexperienced smokers* not only do these inexperienced consumers ask him “whether or not the Cohiba that [he was] showing them in the store is from Cuba,” they do so “*often*”—he testified “9 out of 10 times.” *Supra*.

This testimony is also not inadmissible hearsay, as GC argues, 367 TTABVUE 121-22. Mr. Labor’s testimony concerning cigar consumers’ questions of him is not being offered for the truth of the matter questioned—that is, whether the GC Cohiba cigar Mr. Labor was showing them was from Cuba—but rather for the fact that these cigar consumers asked this question at all. In addition, this testimony is also admissible under either the state of mind or the present sense impression exceptions to the hearsay rule. *See* CT’s Response to GC’s Evidentiary Objection No. 19; Fed. R. Evid. 803(1), (3).

GC is also judicially estopped from presenting this objection as GC relied on similar testimony in obtaining a permanent injunction in a separate trademark infringement action concerning its COHIBA registrations that it brought against a third party. *See* CT Response to GC Evidentiary Objection No. 19.

61.

Michael Cullen			
<u>GC’s Description</u>	<u>GC’s Citation to TTABVUE No.</u>	<u>GC’s Objection</u>	<u>GC’s Identification of Pages Where CT Cites to Evidence in its Trial Brief</u>
Designated TTAB Discovery Deposition Transcript and Exhibits of Michael Cullen Cullen performed market research for GC’s parent company between 2003-2013, including a 2008 segmentation study	350 TTABVUE 809-976 (public); 351 TTABVUE 810-977 (conf.)	FRE 401 – Relevancy	N/A

RESPONSE:

This evidence is relevant to, *inter alia*, the seventh (nature and extent of any actual confusion), twelfth (extent of potential confusion) and thirteenth (bad faith) *du Pont* factor, the public recognition and renown of the Cuban Cohiba in the United States (the fifth *du Pont* factor), and CT’s Eighth Ground for Cancellation (section 14(3); 15 U.S.C. § 1604(3), misrepresentation of source, or permitting others to

misrepresent source, as to which the renown and reputation of the mark in the U.S. is relevant, *see, e.g., The Coca-Cola Co. v. Meenaxi Enter., Inc.*, 2021 USPQ2d 709 (TTAB 2021)).

It shows that even within the U.S. *premium* cigar market, [REDACTED]

[REDACTED]. *See infra.*

In addition, GC's own commissioned qualitative research showed that [REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED] As CT has shown, the Cuban Cohiba has extensive recognition and renown in the United States. 365 TTABVUE 28-37, 40 (reviewing extensive evidence, including, *inter alia*, GC’s expert recognizing that the “Cuban COHIBA [is] well known in the United States among premium cigar smokers” and “Yes, this is the cigar”). Additionally, *Cigar Aficionado*, “the market leader in the [cigar] industry,” has described the Cuban Cohiba for many years as the “best of the best,” “blockbuster,” the “best-known brand,” “iconic,” and “no cigar is more famous than Cohiba.” *Id.* at 55 (articles from 2003-16), 349 TTABVUE 297 (Abbot: 333:12-15) (*Cigar Aficionado* is the market leader). For the last thirty-five years, the U.S. press from all over the country has consistently echoed this praise describing the Cuban Cohiba cigar as “best cigar in the world” (*N.Y. Times*, 1986) “world renowned” (*N.Y. Times* and *Newsday*, 1997), “the Rolls-Royces of cigars,” (*Chicago Tribune*, 2005) “the gold standard, the highly coveted,” (*NPR*, 2004), “Mercedes Benz of the Cigar world” (*Denver Post*, 2010), “the most recognizable name in cigars” (*SF Weekly*, 1999) “famous” (*Washington Post*, 1992, *Miami Herald*, 1997 & 1998, *Dallas Morning News*, 2000) and the “Holy Grail” of cigars (*Pensacola News Journal*, 2015). 226 TTABVUE 67-68, 13, 18-19, 23-24, 29, 32-33, 36, 39, 50, 59-60; 217 TTABVUE 107-08, 111-13.

By contrast, GC’s Cohiba cigar *is never described by the U.S. press, Cigar Aficionado or any other U.S. cigar publication as renowned. See id.*

Other U.S. cigar journals and U.S. cigar and other books similarly praise the Cuban Cohiba cigar. 217 TTABVUE 104-09 (*Halfwheel* 2009-19); *Id.* at 27-29 (books 2005-12); 169 TTABVUE 15-17 (*Cigar Journal* 2012-17); 226 TTABVUE 58-61 (*Smoke* magazine 2003-16).

The Cuban Cohiba cigar has consistently received significantly higher ratings and has been rated more frequently by *Cigar Aficionado*. 217 TTABVUE 52-55 (Cuban Cohiba top 25 cigars in 9 of 14 years between 2004 and 2017).

Moreover, the overwhelming focus of the media is on the Cuban Cohiba instead of the GC Cohiba cigar. 226 TTABVUE 53-54 (*Cigar Aficionado*—between Jan./Feb. 2003 and Nov./Dec. 2016, the Cuban Cohiba appeared in over 100 articles in *Cigar Aficionado*, whereas GC’s Cohiba cigar was mentioned by itself in only four (4) articles); *Id.* at 61-67 & 169 TTABVUE 17-18 (review of newspapers articles of general circulation 2002 to 2016). It is regularly featured in major U.S. television shows and movies, 217 TTABVUE 3-16, and well-known personalities and social media influencers, such as Kim Kardashian West, expressed their like of the Cuban Cohiba on social media, 217 TTABVUE 3-7.

By contrast, GC itself recognized as late as 2013 that [REDACTED]

[REDACTED] Nor has it provided *any* evidence of “public recognition and renown” of its Cohiba cigar, including no testimony from its expert that it is well-known.

This objection also should be overruled as it goes to the weight of the testimony and, in situations such as this, the Board admits the evidence and decides what weight it deserves. *See* CT’s Response to GC’s Evidentiary Objection No. 1.

62.

Charles Linehan and Dean J. Gluth			
<u>GC’s Description</u>	<u>GC’s Citation to TTABVUE No.</u>	<u>GC’s Objection</u>	<u>GC’s Identification of Pages Where CT Cites to Evidence in its Trial Brief</u>
Declaration of Charles Linehan; Declaration of Dean J. Gluth; Testimony of Linehan and Gluth.	307 TTABVUE; 326 TTABVUE 364 TTABVUE 2-205	Improper Rebuttal Failure to Disclose Witnesses FRE 401 – Relevancy	N/A

RESPONSE:

CT does not cite to this testimony in its Trial or Rebuttal Briefs.

63.

Enrique Babot Espinosa			
<u>GC's Description</u>	<u>GC's Citation to TTABVUE No.</u>	<u>GC's Objection</u>	<u>GC's Identification of Pages Where CT Cites to Evidence in its Trial Brief</u>
Trial Cross Examination of Enrique Babot Espinosa General Cigar moves to strike the testimony of Enrique Babot Espinosa on 359 TTABVUE at 75:12-77:6	359 TTABVUE at 75:12-77:6	Improper correction of Enrique Babot Espinosa testimony concerning the exact amount of sales the Cuban Cohiba cigar inside and outside of Cuba	N/A

RESPONSE:

CT does not cite to this testimony in its Trial or Rebuttal Briefs.

In any event, it is proper for a witness to correct, during cross-examination, an inadvertent inaccuracy in his written declaration—in this case, the exact amount of sales of the Cuban Cohiba cigar inside and outside of Cuba.

On October 20, 2019, three days prior to Mr. Babot's cross-examination on October 23, 2019, CT's counsel: advised GC's counsel in writing of Mr. Babot Espinosa's discovery of the "inaccuracies" in his testimony in Paragraphs 16 and 17 of his declaration; described in detail to GC's counsel what the "inaccuracies" were and his intention to correct his testimony; provided GC's counsel with business records demonstrating the correct sales statistics; and informed GC's counsel that CT did "not object if [they] would like to add questions concerning" this inaccuracy.

GC's counsel chose not to add any questions, but rather objection as indicated in the transcript of Mr. Babot's cross-examination and in GC's Evidentiary Objections.

CERTIFICATE OF SERVICE

The undersigned certifies that a true and correct copy of the foregoing Petitioner's Reply Trial Brief and Appendices A and B were served on Respondent by electronic mail on October 18, 2021 to:

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